2020 EDITION

HANDBOOK ON

PATENT LAW

The Patents Act, 1970

Includes amendments from the
Patents (Amendment) Rules, 2019

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April 4, 2020

Dear Reader,

Desperate times need desperate measures.

At a time, when the entire world is faced with the Covid-19 outbreak, and is forced to stay indoors; apart from changing our lives abruptly, it also creates new opportunities for us.

Years ago at LexCampus, we took a call to make our learning and training an exclusively online process. We cannot tell you how critical that decision has now turned out to be. All our courses are online, (video lectures, webinars, classes) all our materials are online (pdf, reading material, revision and mock tests, podcasts), and all our interactions are also online (LexCampus forum). It is in this fitness of things that we also came up with an online version of our bestselling handbook. This version that is in your hands now covers the Patents Act and Patents Rules including the latest 2019 amendment to the Patents Rules.

This may not be a replacement to our book, which has cross references, and amendment footnotes, but this will go a long way in helping you to prepare for the Patent Agent Exam as this is the only available source which compiles all the amendments in the acts and the rules, in a single searchable document.

And we are giving this to you for FREE.

We wish you our best in preparing and clearing the patent agent exam this year.

Your feedback on corrections and errors on this document is most welcome, please write to us at contact@lexcampus.in and ensure that you **check our website for the most updated version of this document.**

Yours sincerely,
—The LexCampus Team

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Version 1.0 dated April 4, 2020

We have spent a lot of time and effort to come up with this comprehensive handbook on Patent Laws. Although we have taken utmost care in preparing this handbook, it is possible that some mistake, error, omission or discrepancy might have crept it. We urge our readers to provide their feedback on the handbook that can improve the overall quality, style and presentation of the handbook in our forthcoming editions to enhance the learning experience.

This handbook is prepared for the purpose of quick reference for students and professionals. It is suggested that to avoid any doubt, the reader should cross-check all the facts, law and contents of this book with the original Government publication or notification, etc. or visit Indian Patent Office website for more information.

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INTRODUCTION

We re-invented the Bare Act and the sweet co-incidence is that our first offering is on Patents. Traditionally printed in black and white, the Bare Act depicts the law in a hard to navigate format. We have made it better this time. We present the most comprehensive handbook for understanding the Indian Patent Laws. The handbook contains distinct colour-coded headings with relevant cross-references. The legislative history of all the preceding amendments are provided, which are helpful to understand the evolution of the law. The handbook also features relevant case laws under appropriate provisions.

This handbook on Patent Law, comprises the Patents Act, 1970, as amended by the Patents (Amendment) Act, 2005, along with, Patents Rules, 2003, as amended by the Patents (Amendment) Rules, 2019.

Each provision is presented with a colour-coded heading for easy identification. Every provision of the Act and the Rules, which has a cross-reference to another section, rule, form or a schedule has been mentioned in the margin. Cross-reference to sections, rules, forms and schedules are mentioned as 'S.', 'R.', 'F.' and 'Sch.', respectively.

—The LexCampus Team

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THE PATENTS ACT, 1970

(Act No. 39 of 1970)

[As Amended by the Patents (Amendment) Act, 2005 (15 of 2005)]

An Act to amend and consolidate the law relating to patents.

BE it enacted by Parliament in the Twenty-first year of the Republic of India as follows:-

CHAPTER I

PRELIMINARY

1. Short title, extent and commencement

(1) This Act may be called the Patents Act, 1970.

(2) It extends to the whole of India.

(3) It shall come into force on such date[1] as the Central Government may, by notification in the Official Gazette, appoint:

PROVIDED that different dates may be appointed for different provisions of this Act, and any reference in any such provision to the commencement of this Act shall be construed as a reference to the coming into force of that provision.

2. Definition and interpretation

(1) In this Act, unless the context otherwise requires, -

[2][(a) "Appellate Board" means the Appellate Board referred to in section 116;] — S. 113, 116, 117A-117H

[3][(ab) "assignee" includes an assignee of the assignee and the legal representative of a deceased assignee and references to the assignee of any person include references to the assignee of the legal representative or assignee of that person;] — F. 1, 3, 12, 25; S. 6(c), 50(6)

[4][(aba) "Budapest Treaty" means the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure done at Budapest on 28th day of April, 1977, as amended and modified from time to time;] — S. 10

[5][(ac) "Capable of industrial application", in relation to an invention, means that the invention is capable of being made or used in an industry;] — S. 2(1)(j)

(b) "Controller" means the Controller General of Patents, Designs and Trade Marks referred to in section 73; — S. 2(2)(a), 73(1)

(c) "Convention application" means an application for a patent made by virtue of section 135; — S. 135

[6][(d) "Convention country" means a country or a country which is member of a group of countries or a union of countries or an Inter- — S. 133, 135; F. 1, 5, 25

governmental organization [1][referred to as a convention country in section 133];

S. 104

(e) "District court" has the meaning assigned to that expression by the Code of Civil Procedure, 1908(5 of 1908);

(f) "exclusive licence" means a licence from a patentee which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention, and "exclusive licensee" shall be construed accordingly;

S. 109(1)

(g) [2][Clause (g) omitted by the Patents (Amendment) Act, 2005 (w.r.e.f 01.01.2005)]

(h) "Government undertaking" means any industrial undertaking carried on –

(i) by a department of the Government, or

(ii) by a corporation established by a Central, Provincial or State Act, which is owned or controlled by the Government, or

(iii) by a Government company as defined in section 617 of the Companies Act, 1956(1 of 1956) [3][or],

[4][(iv) by an institution wholly or substantially financed by the Government]

S. 64(3)(b), 100(2)

[5][***]

S. 104, 158

[6][(i) "High Court", in relation to a State or Union territory, means the High Court having territorial jurisdiction in that State or Union territory, as the case may be;]

S. 138(4); R. 17-23

[7][(ia) "International application" means an application for patent made in accordance with the Patent Cooperation Treaty;]

S. 3, 4

[8][(j) "invention" means a new product or process involving an inventive step and capable of industrial application;]

[9][(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;]

S. 6(1)(c)

(k) "legal representative" means a person who in law represents the estate of a deceased person;

S. 13, 29-34

[10][(l) "new invention" means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art;

S. 25(3)(b), R. 56

(la) "Opposition Board" means an Opposition Board constituted under sub-section (3) of section 25;]

S. 43; R.74

(m) "patent" means a patent for any invention granted under this Act;]

S. 125; R. 111; F.22, 26

(n) "patent agent" means a person for the time being registered under this Act as a patent agent;

S. 82

(o) "patented article" and "patented process" mean respectively an article or process in respect of which a patent is in force;

S. 135(3), 2(ia)

[11][(oa) "Patent Cooperation Treaty" means the Patent Cooperation Treaty done at Washington on the 19th day of June, 1970 as amended and modified from time to time;]

S. 48, 82

(p) "patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent;

S. 54; R. 13(3); F. 1

(q) "patent of addition" means a patent granted in accordance with section 54;

S. 74; R. 4

(r) "patent office" means the patent office referred to in section 74;

(s) "person" includes the Government;

S. 25(2), 64(1)

(t) "person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;

S. 3(d)

[12][(ta) "pharmaceutical substance" means any new entity involving one or more inventive steps;]

S. 158

S. 117H

[13][(u) "prescribed" means,-

(A) in relation to proceedings before a High Court, prescribed by rules made by the High Court;

(B) in relation to proceedings before the Appellate Board, prescribed by rules made by the Appellate Board; and

(C) in other cases, prescribed by rules made under this Act;]

R. 7

(v) "prescribed manner" includes the payment of the prescribed fee;

S. 11

(w) "priority date" has the meaning assigned to it by section 11;

S. 67; R. 88

(x) "register" means the register of patents referred to in section 67;

S. 6(1)(a)

(y) "true and first inventor" does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India.

(2) In this Act, unless the context otherwise requires, any reference –

S. 73(1)

(a) to the Controller shall be construed as including a reference to any officer discharging the functions of the Controller in pursuance of section 73;

S. 74

(b) to the patent office shall be construed as including a reference to any branch office of the patent office.

CASE LAW

Patent is granted only for an invention which is new and useful, that is, it must have novelty and utility. **Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC 1444 (1448): 1979 All LJ 290: PTC (Suppl) (1) 731 (SC).**

Novelty and an inventive step is a mixed question of law and fact.

If the allegedly invention stated to be publicly known either by word of mouth or by publication through books or other media, then patent can't be granted**. Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC 1444 (1449): 1979 All LJ 290: PTC (Suppl) (1) 731 (SC).**

Invention can be claimed either in Product or Process. In case of an article, the patent is in the end product and in the case of process, lies in the process by which it is arrived at. **Raj Parkash v. Mangat Ram Chowdhry and Ors, AIR 1987 Delhi 1(8) 1977: Rajdhani LR 440 (DB).**

Along with technical advancement, the allegedly invention should also not be obvious to the person skilled in the art. **F. Hoffmann-La Roche Ltd v. Cipla Ltd, 2012 (195) DLT 641 (674).**

Merely change of material in a traditional product "Kilta" from bamboo to plastic and development of nylon straps with buckles can't be said to be an innovative step. **Dhanpat Seth & Others v. Nil Kamal Plastic Crates, AIR 2008 HP 23 (25): 2008 AIHC (NOC) 212 (DB): 2006 (33) PTC 339(HP).**

CHAPTER II

INVENTIONS NOT PATENTABLE

3. What are not inventions

The following are not inventions within the meaning of this Act, -

(a) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;

[14][(b) an invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;]

(c) the mere discovery of a scientific principle or the formulation of an abstract theory [15][or discovery of any living thing or non-living substance occurring in nature;]

[16][(d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Explanation.—For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;]

(e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;

(f) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;

[17][(g) [Omitted by the Patents (Amendment) Act, 2002]

(h) a method of agriculture or horticulture;

(i) any process for the medicinal, surgical, curative, prophylactic, [18][diagnostic, therapeutic] or other treatment of human beings or any process for a similar treatment of animals [19][***] to render them free of disease or to increase their economic value or that of their products. S. 10(4)(d)(ii)

[20][(j) Plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;

(k) a mathematical method or a business method or a computer program *per se* or algorithms; S. 25(1)(k), 64(1)(q)

(l) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;

(m) a mere scheme or rule or method of performing mental act or method of playing game;

(n) a presentation of information;

(o) topography of integrated circuits;

(p) an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.]

CASE LAW

Patent cannot be granted unless the alleged invention demonstrates enhanced efficacy as mandated by section 3(d). **F. Hoffmann-La Roche Ltd. & Anr. v. Cipla Ltd, 2009 (159) DLT 243 (266) (DB).**

Explanation to Section 3 (d) appears to prevent derivatives or other forms of the already patented pharmaceutical products. It makes sure that the derivatives or other forms "differ significantly in properties in regard to efficacy". **F. Hoffmann-La Roche Ltd. & Anr. v. Cipla Ltd, 2009 (159) DLT 243 (266) (DB).**

A method of doing advertisement business electronically is only an improvement in the method of doing business and is an excluded subject matter under Section 3(k) of the Patents Act, 1970. **Yahoo! Inc (formerly 'Overture Services Inc.') v. The Assistant Controller of Patents & Designs. [2011] IPAB 106.**

4. Inventions relating to atomic energy not patentable

No patent shall be granted in respect of an invention relating to atomic energy S. 65

falling within sub-section (1) of Section 20 of the Atomic Energy Act, 1962 (33 of 1962).

5. [21][Omitted by the Patents (Amendment) Act, 2005]

CHAPTER III

APPLICATIONS FOR PATENTS

6. Persons entitled to apply for patents

S. 7, 134, 135

(1) Subject to the provisions contained in section 134, an application for a patent for an invention may be made by any of the following persons, that is to say, -

S. 2(1)(y)
S. 2(1)(ab)

(a) by any person claiming to be the true and first inventor of the invention;
(b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;
(c) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.

S. 2(1)(k)

(2) An application under sub-section (1) may be made by any of the persons referred to therein either alone or jointly with any other person.

7. Form of application

S. 10(5), F.1

(1) Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office.

S. 53(1), 135(3); R. 17-23; F. 1

[22][(1A) Every international application under the Patent Cooperation Treaty for a patent, as may be filed designating India, shall be deemed to be an application under this Act, if a corresponding application has also been filed before the Controller in India.]

S. 45(1), 138(5)

[23][(1B) The filing date of an application referred to in sub-section (1A) and its complete specification processed by the patent office as designated office or elected office shall be the international filing date accorded under the Patent Cooperation Treaty.]

R. 10

(2) Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application, or within such period as may be prescribed after the filing of the application, proof of the right to make the application.

F. 1, 4, 5

(3) Every application under this section shall state that the applicant is in possession of the invention and shall name the [24][person] claiming to be the true and first inventor; and where the person so claiming is not the applicant or one of the applicants, the application shall contain a declaration that the applicant believes the person so named to be the true and first inventor.

S. 10, 136(1)(a); R. 13; F.2

[25][(4) Every such application (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) shall be accompanied by a provisional or a complete specification.]

8. Information and undertaking regarding foreign applications.

R. 12(2); S. 25(1)(h), 25(2)(h); F.3

(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application [26][or subsequently [27][within the prescribed period as the Controller may allow]] –

[28][(a) a statement setting out detailed particulars of such application; and]

(b) an undertaking that, [29][up to the date of grant of patent in India], he would keep the Controller informed in writing, from time to time, of [30][detailed particulars as required under] clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

[31][(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed.]

CASE LAW

Under section 8, an applicant has to make full disclosures to the Controller about all information relating to applications for patents which are same or substantially the same invention and also information related to title of the said patents owned by the applicant and other persons in foreign countries. **F. Hoffmann-La Roche Ltd v. Cipla Ltd, 2012 (195) DLT 641 (715).**

9. Provisional and complete specifications.

S. 136, 138(4); R. 13; F. 2

[32][(1) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.]

(2) Where two or more applications in the name of the same applicant are accompanied by provisional specifications in respect of inventions which are cognate or of which one is a modification of another and the Controller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow

S. 10(5)

one complete specification to be filed in respect of all such provisional specifications:

[33][Provided that the period of time specified under sub-section (1) shall be reckoned from the date of filing of the earliest provisional specification.]

[34][(3) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time within twelve months from the date of filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.]

S. 17(1)

(4) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before [35][grant of patent], cancel the provisional specification and post-date the application to the date of filing of the complete specification.

CASE LAW

Post-dating of patent can be done only to the date of filing of the complete specifications. **Standipack Pvt. Ltd. v. Oswal Trading Co. Ltd., AIR 2000 Del. 23; 1999 (19) PTC 479 (Del).**

10. Contents of specifications

R. 13(7)(a), 14, 15; F. 2

(1) Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.

R. 13(4), 15

(2) Subject to any rules that may be made in this behalf under this Act, drawings may, and shall, if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

R. 16

(3) If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished [36][before the application is found in order for grant of a patent], but such model or sample shall not be deemed to form part of the specification.

R. 13(7)

(4) Every complete specification shall-

(a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and

(c) end with a claim or claims defining the scope of the invention for

which protection is claimed;

[37][(d) be accompanied by an abstract to provide technical information on the invention:

Provided that-

(i) the Controller may amend the abstract for providing better information to third parties; and — S. 2(aba)

(ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing [38][the material to an international depository authority under the Budapest Treaty] and by fulfilling the following conditions, namely:-

[39][(A) the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;] — R. 13(8)

(B) all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;

(C) access to the material is available in the depository institution only after the date of the application for patent in India or if a priority is claimed after the date of the priority;

(D) disclose the source and geographical origin of the biological material in the specification, when used in an invention.] — S. 7

[40][(4A) In case of an international application designating India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act.]

[41][(5) The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.]

(6) A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification. — S. 7(3); R. 13(6); F. 5

(7) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification may include claims in respect of developments of, or additions to, the invention which was described in the provisional specification, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent. — S. 6, 54

CASE LAW

The proper way to understand a specification would be first to read the

description of invention so that the mind may be prepared for what it is, than that the invention is to be claimed. However, the specification and claim must be looked at and construed together. **Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC 1444 (1452): 1797 All L J 290: PTC (Suppl) (1) 731 (SC).**

11. Priority dates of claims of a complete specification.

S. 9(3)

(1) There shall be a priority date for each claim of a complete specification.

(2) Where a complete specification is filed in pursuance of a single application accompanied by -

(a) a provisional specification; or

(b) a specification which is treated by virtue of a direction under sub-section (3) of section 9 as a provisional specification,

and the claim is fairly based on the matter disclosed in the specification referred to in clause (a) or clause (b), the priority date of that claim shall be the date of the filing of the relevant specification.

S. 9(2)

(3) Where the complete specification is filed or proceeded with in pursuance of two or more applications accompanied by such specifications as are mentioned in sub-section(2) and the claim is fairly based on the matter disclosed -

(a) in one of those specifications, the priority date of that claim shall be the date of the filing of the application accompanied by that specification;

(b) partly in one and partly in another, the priority date of that claim shall be the date of the filing of the application accompanied by the specification of the later date.

[42][(3A) Where a complete specification based on a previously filed application in India has been filed within twelve months from the date of that application and the claim is fairly based on the matter disclosed in the previously filed application, the priority date of that claim shall be the date of the previously filed application in which the matter was first disclosed.]

S. 16(1)

(4) Where the complete specification has been filed in pursuance of a further application made by virtue of sub-section (1) of section 16 and the claim is fairly based on the matter disclosed in any of the earlier specifications, provisional or complete, as the case may be, the priority date of that claim shall be the date of the filing of that specification in which the matter was first disclosed.

(5) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for the provisions of this sub-section, have two or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.

S. 137

(6) In any case to which sub-sections (2), (3),[43][(3A)], (4) and (5) do not apply, the priority date of a claim shall, subject to the provisions of section 137, be the date of filing of the complete specification.

S. 9, 17

(7) The reference to the date of the filing of the application or of the complete specification in this section shall, in cases where there has been a post-dating under section 9 or section 17 or, as the case may be, an ante-dating under section 16, be a reference to the date as so post-dated or ante-dated.

(8) A claim in a complete specification of a patent shall not be invalid by reason only of -

(a) the publication or use of the invention so far as claimed in that claim on or after the priority date of such claim; or

(b) the grant of another patent which claims the invention, so far as claimed in the first-mentioned claim, in a claim of the same or a later priority date.

CHAPTER IV

[44][PUBLICATION AND EXAMINATION OF APPLICATIONS]

[45][11A. Publication of applications

[46][(1) Save as otherwise provided, no application for patent shall ordinarily be open to the public for such period as may be prescribed.

(2) The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period prescribed under sub-section (1) and subject to the provisions of sub-section (3), the Controller shall publish such application as soon as possible.

(3) Every application for a patent shall, on the expiry of the period specified under sub-section (1), be published, except in cases where the application–

(a) in which secrecy direction is imposed under section 35; or

(b) has been abandoned under sub-section (1) of section 9; or

(c) has been withdrawn three months prior to the period specified under sub-section (1)]

(4) In case a secrecy direction has been given in respect of an application under section 35, then it shall be published after the expiry of the period [47][prescribed under sub-section (1)] or when the secrecy direction has ceased to operate, whichever is later.

(5) The publication of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.

(6) Upon publication of an application for a patent under this section-

(a) the depository institution shall make the biological material mentioned in the specification available to the public;

(b) the patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.

[48][(7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application:

Provided that the applicant shall not be entitled to institute any

proceedings for infringement until the patent has been granted:

Provided further that the rights of a patentee in respect of applications made under sub-section (2) of section 5 before the 1st day of January, 2005 shall accrue from the date of grant of the patent:

Provided also that after a patent is granted in respect of applications made under sub-section (2) of section 5, the patent-holder shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1-1-2005 and which continue to manufacture the product covered by patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises.]

11B. Request for examination

[49][(1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.]

[50][(2) Omitted by the Patents (Amendment) Act, 2005.]

[51][(3) In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1st day of January, 2005 a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.]

(4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) [52][***] or sub-section (3), the application shall be treated as withdrawn by the applicant:

[53][Provided that–

(i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and

(ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction.]

12. Examination of application

[54][(1) When a request for examination has been made in respect of an application for a patent in the prescribed manner [55][under sub-section (1) or sub-section (3) of section 11B, the application and specification and other documents related thereto shall be referred, at the earliest by the Controller]] to an examiner for making a report to him in respect of the following matters, namely:-

(a) whether the application and [56][for specification and other documents relating thereto] are in accordance with the requirements of this Act and of any rules made thereunder;

(b) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;

(c) the result of investigations made under section 13; and

(d) any other matter which may be prescribed.

(2) The examiner to whom the application and the [57][specification and other documents relating thereto] are referred under sub-section (1) shall ordinarily make the report to the Controller within [58][such period as may be prescribed.]

13. Search for anticipation by previous publication and by prior claim

(1) The examiner to whom an application for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification -

(a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st day of January, 1912;

(b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

(2) The examiner shall, in addition, make such investigation [59][***] for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section (1) before the date of filing of the applicant's complete specification.

(3) Where a complete specification is amended under the provisions of this Act before [60][the grant of a patent], the amended specification shall be examined and investigated in like manner as the original specification.

(4) The examination and investigations required under section 12 and this section shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.

CASE LAW

The grant of patent by the Controller can be challenged before the High Court on various grounds in revocation or infringement proceedings. Merely grant of patent does not guarantee the validity of a patent under section 13(4). **Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC 1444 (1448): 1979 All LJ 290: PTC (Suppl) (1) 731 (SC).**

The burden to prove that the patent is valid lies upon the patentee in cases of application for Injunction. **Mariappan v. A.R. Safiullah, 2008 (5)**

CTC 97 (102): 2008 (3) Mad LW 775 (DB): 2008 (38) PTC 341 (Mad).

[61][14. Consideration of report of examiner by Controller

Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made there under, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate as expeditiously as possible the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed period, give him an opportunity of being heard.

15. Power of Controller to refuse or require amendment of applications, etc., in certain cases

Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.]

16. Power of Controller to make orders respecting division of application

(1) A person who has made an application for a patent under this Act may, at any time [62][before the grant of the patent], if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

(2) The further application under sub-section (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.

(3) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

[63][*Explanation*– For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the first mentioned application had been filed, and the further application shall be proceeded with as a substantive application and be examined when the request for examination is filed within the prescribed period.]

17. Power of Controller to make order respecting dating of application

(1) Subject to the provisions of section 9, at any time after the filing of an application and [64][before the grant of the patent] under this Act, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly: Provided that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for the provisions of this sub-section, be deemed to have been made.

[65][(2) Where an application or specification (including drawings) or any other document is required to be amended under section 15, the application or specification or other document shall, if the Controller so directs, be deemed to have been made on the date on which the requirement is complied with or where the application or specification or other document is returned to the applicant, on the date on which it is re-filed after complying with the requirement.]

18. Power of Controller in cases of anticipation

(1) Where it appears to the Controller that the invention so far as claimed in any claim of the complete specification has been anticipated in the manner referred to in clause (a) of sub-section (1) or sub-section (2) of section 13, he may refuse [66][the application] unless the applicant -

(a) shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or

(b) amends his complete specification to the satisfaction of the Controller.

(2) If it appears to the Controller that the invention is claimed in a claim of any other complete specification referred to in clause (b) of sub-section (1) of section 13, he may, subject to the provisions hereinafter contained, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed, -

(a) the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim of the said other specification; or

(b) the complete specification is amended to the satisfaction of the Controller.

(3) If it appears to the Controller, as a result of an investigation under section 13 or otherwise, -

(a) that the invention so far as claimed in any claim of the applicant's complete specification has been claimed in any other complete specification referred to in clause (a) of sub-section (1) of section 13; and

(b) that such other complete specification was published on or after

the priority date of the applicant's claim,
then, unless it is shown to the satisfaction of the Controller that the priority date of the applicant's claim is not later than the priority date of the claim of that specification, the provisions of sub-section (2) shall apply thereto in the same manner as they apply to a specification published on or after the date of filing of the applicant's complete specification.

[67][(4) [Omitted by the Patents (Amendment) Act, 2005.]

19. Powers of Controller in case of potential infringement

(1) If, in consequence of the investigations required [68][under this Act], it appears to the Controller that an invention in respect of which an application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed –

(a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or

(b) the complete specification is amended to the satisfaction of the Controller.

(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1) –

(a) that other patent is revoked or otherwise ceases to be in force; or

(b) the specification of that other patent is amended by the deletion of the relevant claim; or

(c) it is found, in proceedings before the court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention,

the Controller may, on the application of the applicant, delete the reference to that other patent.

20. Powers of Controller to make orders regarding substitution of applicants, etc

(1) If the Controller is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants, accordingly as the case may require.

(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

(3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless -

(a) the invention is identified therein by reference to the number of the application for the patent; or

(b) there is produced to the Controller an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or

(c) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or

(d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under sub-section (5).

(4) Where one of two or more joint applicants for a patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.

(5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Controller, may upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may require.

[69][21. Time for putting application in order for grant

(1) An application for a patent shall be deemed to have been abandoned unless, within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller.

Explanation.–Where the application for a patent or any specification or, in the case of a convention application or an application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has refiled it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed.

(2) If at the expiration of the period as prescribed under sub-section (1),–

(a) an appeal to the High Court is pending in respect of the application for the patent for the main invention; or

(b) in the case of an application for a patent of addition, an appeal to

the High Court is pending in respect of either that application or the application for the main invention, the time within which the requirements of the Controller shall be complied with shall, on an application made by the applicant before the expiration of the period as prescribed under sub-section (1), be extended until such date as the High Court may determine.

(3) If the time within which the appeal mentioned in sub-section (2) may be instituted has not expired, the Controller may extend the period as prescribed under sub-section (1), to such further period as he may determine:

Provided that if an appeal has been filed during the said further period, and the High Court has granted any extension of time for complying with the requirements of the Controller, then the requirements may be complied with within the time granted by the Court.]

[70][22. [Omitted by the Patents (Amendment) Act, 2005]

23. [Omitted by the Patents (Amendment) Act, 2005]

24. [Omitted by the Patents (Amendment) Act, 2005]

CHAPTER V

[71][OPPOSITION PROCEEDINGS TO GRANT OF PATENTS]

[72][25. Opposition to the patent

(1) Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground –

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim-

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document;

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-Section (3) of Section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim.

(d) That the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation:— For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the applicant has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere,

but on no other ground and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.

(2) At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely;-

(a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim-

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

Provided that the ground specified in sub-clause (ii) shall not

be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation.—For the purposes of this clause, an invention relating to a process for which a patent is granted shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the patentee has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of a patent granted on convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere,

but on no other ground.

(3) (a) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.

(b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.

(c) Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed.

(4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent.

(5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (d) or clause (e) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use.

(6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly.

CASE LAW

An order cannot be passed without giving hearing to objector on amended claim or application in a pre-grant proceeding. **Neon Laboratories Private Ltd v. Troikaa Pharma Ltd, 2011 (1) AIR Bom R 557: 2011(2) Bom CR 54 (DB).**

The moment, the pre-grant opposition is rejected, the Controller is empowered to pass the order on the grant of patent and there is no question of stating the grant is conditional**. Dr. Snehlata C Gupte v. Union of India & Ors, 189 (2012) DLT 342: 2012 (50) PTC 327 (Del).**

The date on which the patent is granted cannot be the date of issuance of certificate but has to be the date on which orders are passed by the Controller. **Dr. Snehlata C Gupte v. Union of India & Ors, 189 (2012) DLT 342: 2012 (50) PTC 327 (Del).**

26. In cases of "obtaining" Controller may treat the patent as the patent of opponent

(1) Where in any opposition proceeding under this Act the Controller finds that—

(a) the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent in the manner set out in clause (a) of sub-section (2) of section 25 and revokes the patent on that ground, he may, on request by such opponent made in the prescribed manner, direct that the patent shall stand amended in the name of the opponent;

(b) a part of an invention described in the complete specification was so obtained from the opponent, he may pass an order requiring that the specification be amended by the exclusion of that part of the invention.

(2) Where an opponent has, before the date of the order of the Controller requiring the amendment of a complete specification referred to in clause (b) of sub-section (1), filed an application for a patent for an invention which included the whole or a part of the invention held to have been obtained from him and such application is pending, the Controller may

treat such application and specification in so far as they relate to the invention held to have been obtained from him, as having been filed, for the purposes of this Act relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the patentee in the earlier application but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act.

[73]27. [Omitted by the Patents (Amendment) Act, 2005]

28. Mention of inventor as such in patent

(1) If the Controller is satisfied, upon a request or claim made in accordance with the provisions of this section, -

(a) that the person in respect of or by whom the request or claim is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and

(b) that the application for the patent is a direct consequence of his being the inventor, the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application in the complete specification and in the register of patents:

Provided that the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.

(2) A request that any person shall be mentioned as aforesaid may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person.

(3) If any person [other than a person in respect of whom a request in relation to the application in question has been made under sub-section (2),] desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf.

[74][(4) A request or claim under the foregoing provisions of this section shall be made before the grant of patent.]

[75][(5) [Omitted by the Patents (Amendment) Act, 2005]]

(6) [76][where] a claim is made under sub-section (3), the Controller shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested; and before deciding upon any request or claim made under sub-section (2) or sub-section (3), the Controller shall, if required, hear the person in respect of or by whom the request or claim is made, and, in the case of a claim under sub-section (3), any person to whom notice of the claim has been given as aforesaid.

(7) Where any person has been mentioned as inventor in pursuance of this section, any other person who alleges that he ought not to have been so mentioned may at any time apply to the Controller for a certificate to that effect, and the Controller may, after hearing, if required, any person whom

he may consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.

CHAPTER VI

ANTICIPATION

29. Anticipation by previous publication

(1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published in a specification filed in pursuance of an application for a patent made in India and dated before the 1st day of January, 1912.

(2) Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published before the priority date of the relevant claim of the specification, if the patentee or the applicant for the patent proves -

(a) that the matter published was obtained from him, or (where he is not himself the true and first inventor) from any person from whom he derives title, and was published without his consent or the consent of any such person; and

(b) where the patentee or the applicant for the patent or any person from whom he derives title learned of the publication before the date of the application for the patent, or, in the case of a convention application, before the date of the application for protection in a convention country, that the application or the application in the convention country, as the case may be, was made as soon as reasonably practicable thereafter:

Provided that this sub-section shall not apply if the invention was before the priority date of the claim commercially worked in India, otherwise than for the purpose of reasonable trial, either by the patentee or the applicant for the patent or any person from whom he derives title or by any other person with the consent of the patentee or the applicant for the patent or any person from whom he derives title.

(3) Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of any invention by that applicant.

30. Anticipation by previous communication to Government

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to the Government or to any person authorised by the Government to investigate the invention or its merits, or of anything done, in consequence of such a communication, for the purpose of the investigation.

31. Anticipation by public display, etc

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of -

(a) the display of the invention with the consent of the true and first inventor or a person deriving title from him at an industrial or other exhibition to which the provisions of this section have been extended by the Central Government by notification in the Official Gazette, or the use thereof with his consent for the purpose of such an exhibition in the place where it is held; or

(b) the publication of any description of the invention in consequence of the display or use of the invention at any such exhibition as aforesaid; or

(c) the use of the invention, after it has been displayed or used at any such exhibition as aforesaid and during the period of the exhibition, by any person without the consent of the true and first inventor or a person deriving title from him; or

(d) the description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society,

if the application for the patent is made by the true and first inventor or a person deriving title from him [77][not later than twelve months] after the opening of the exhibition or the reading or publication of the paper, as the case may be.

32. Anticipation by public working

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that at any time within one year before the priority date of the relevant claim of the specification, the invention was publicly worked in India -

(a) by the patentee or applicant for the patent or any person from whom he derives title; or

(b) by any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title,

if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public.

33. Anticipation by use and publication after provisional specification

(1) Where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional specification or where a complete specification filed along with an application is treated by virtue of a direction under sub-section (3) of section 9 as a provisional specification, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated, by reason only that any matter described in the provisional specification or in the specification treated as aforesaid as a provisional specification was used in India or published in India or elsewhere at any time after the date of the filing of that specification.

(2) Where a complete specification is filed in pursuance of a convention application, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated, by reason only that any matter disclosed in any application for protection in a convention country upon which the convention application is founded was used in India or published in India or elsewhere at any time after the date of that application for protection.

34. No anticipation if circumstances are only as described in sections 29, 30, 31 and 32

Notwithstanding anything contained in this Act, the Controller shall not refuse [78][***] to grant a patent, and a patent shall not be revoked or invalidated by reason only of any circumstances which, by virtue of section 29 or section 30 or section 31 or section 32, do not constitute an anticipation of the invention claimed in the specification.

CHAPTER VII

PROVISIONS FOR SECRECY OF CERTAIN INVENTIONS

35. Secrecy directions relating to inventions relevant for defence purposes

(1) Where, in respect of an application made before or after the commencement of this Act for a patent, it appears to the Controller that the invention is one of a class notified to him by the Central Government as relevant for defence purposes, or, where otherwise the invention appears to him to be so relevant, he may give directions for prohibiting or restricting the publication of information with respect to the invention or the communication of such information [79][***].

(2) Where the Controller gives any such directions as are referred to in sub-section (1), he shall give notice of the application and of the directions to the Central Government, and the Central Government shall, upon receipt of such notice, consider whether the publication of the invention would be prejudicial to the defence of India, and if upon such consideration, it appears to it that the publication of the invention would not so prejudice, give notice to the Controller to that effect, who shall thereupon revoke the directions and notify the applicant accordingly.

(3) Without prejudice to the provisions contained in sub-section (1), where the Central Government is of opinion that an invention in respect of which the Controller has not given any directions under sub-section (1), is relevant for defence purposes, it may at any time before [80][grant of patent] notify the Controller to that effect, and thereupon the provisions of that sub-section shall apply as if the invention were one of the class notified by the Central Government, and accordingly the Controller shall give notice to the Central Government of the directions issued by him.

36. Secrecy directions to be periodically reviewed

[81][(1) The question whether an invention in respect of which directions have been given under section 35 continues to be relevant for defence purposes shall be reconsidered by the Central Government at intervals of [82][six months] or on a request made by the applicant which is found to be reasonable by the Controller and if, on such reconsideration it appears to the Central Government that the publication of the invention would no longer be prejudicial to the defence of India or in case of an application filed by a foreign applicant it is found that the invention is published outside India, it shall forthwith give notice to the Controller to revoke the direction and the Controller shall thereupon revoke the directions previously given by him.]

(2) The result of every re-consideration under sub-section (1), shall be communicated to the applicant within such time and in such manner as may be prescribed.

37. Consequences of secrecy directions

(1) So long as any directions under section 35 are in force in respect of an application -

(a) the Controller shall not pass an order refusing [83][to grant] the same; and

(b) notwithstanding anything contained in this Act, no appeal shall lie from any order of the Controller passed in respect thereof:

[84][Provided that the application may, subject to the directions, proceed up to the stage of grant of the patent, but the application and the specification found to be in order for grant of the patent shall not be published, and no patent shall be granted in pursuance of that application.]

(2) Where a complete specification filed in pursuance of an application for a patent for an invention in respect of which directions have been given under section 35 [85][is found to be in order for grant of the patent] during the continuance in force of the directions, then -

(a) if, during the continuance in force of the directions, any use of the invention is made by or on behalf of, or to the order of the Government, the provisions of sections 100, 101 and 103 shall apply in relation to that use as if the patent had been granted for the invention; and

(b) if it appears to the Central Government that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Central Government may make to him such payment (if any) by way of solatium as appears to the Central Government to be reasonable having regard to the novelty and utility of the invention and the purpose for which it is designed, and to any other relevant circumstances.

(3) Where a patent is granted in pursuance of an application in respect of which directions have been given under section 35, no renewal fee shall be payable in respect of any period during which those directions were in force.

38. Revocation of secrecy directions and extension of time

When any direction given under section 35 is revoked by the Controller, then, notwithstanding any provision of this Act specifying the time within which any step should be taken or any act done in connection with an application for the patent, the Controller may, subject to such conditions, if any, as he thinks fit to impose, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time has previously expired.

[86][39. Residents not to apply for patents outside India without prior permission

(1) No person resident in India shall, except under the authority of a written permit sought in the manner prescribed and granted by or on behalf of the Controller, make or cause to be made any application outside India for the grant of a patent for an invention unless–

(a) an application for a patent for the same invention has been made in India, not less than six weeks before the application outside India; and

(b) either no direction has been given under sub-section (1) of section 35 in relation to the application in India, or all such directions have been revoked.

(2) The Controller shall dispose of every such application within such period as may be prescribed:

Provided that if the invention is relevant for defence purpose or atomic energy, the Controller shall not grant permit without the prior consent of the Central Government.

(3) This section shall not apply in relation to an invention for which an application for protection has first been filed in a country outside India by a person resident outside India.]

40. Liability for contravention of section 35 or section 39

Without prejudice to the provisions contained in Chapter XX, if in respect of an application for a patent any person contravenes any direction as to secrecy given by the Controller under section 35 [87][or makes or causes to be made an application for grant of a patent outside India in contravention of section 39], the application for patent under this Act shall be deemed to have been abandoned and the patent granted, if any, shall be liable to be revoked under section 64.

41. Finality of orders of Controller and Central Government

All orders of the Controller giving directions as to secrecy as well as all orders of the Central Government under this Chapter shall be final and shall not be called in question in any court on any ground whatsoever.

42. Savings respecting disclosure of Government

Nothing in this Act shall be held to prevent the disclosure by the Controller of information concerning an application for a patent or a specification filed in pursuance thereof to the Central Government for the purpose of the application or specification being examined for considering whether an order under this Chapter should be made or whether an order so made should be revoked.

CHAPTER VIII

[88][GRANT OF PATENTS AND RIGHTS CONFERRED THEREBY]

[89][43. Grant of patents

(1) Where an application for a patent has been found to be in order for grant of the patent and either–

(a) the application has not been refused by the Controller by virtue of any power vested in him by this Act; or

(b) the application has not been found to be in contravention of any of the provisions of this Act,

the patent shall be granted as expeditiously as possible to the applicant or, in the case of a joint application, to the applicants jointly, with the seal of the patent office and the date on which the patent is granted shall be entered in the register.

(2) On the grant of patent, the Controller shall publish the fact that the patent has been granted and thereupon the application, specification and other documents related thereto shall be open for public inspection.]

CASE LAW

The grant and sealing of the patent, or the decision rendered by the Controller in the case of opposition, does not guarantee the validity of the patent as it is expressly provided in section 13(4) of the Patents Act, 1970. **Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC 1444 (1448): 1979 All LJ 290: PTC (Suppl) (1) 731 (SC)**

44. Amendment of patent granted to deceased applicant

Where at any time after a patent has been [90][granted] in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was granted, the Controller may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

45. Date of patent

[91][(1) Subject to the other provisions contained in this Act, every patent shall be dated as of the date on which the application for patent was filed.]

(2) The date of every patent shall be entered in the register.

(3) Notwithstanding anything contained in this section, no suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before [92][the date of publication of the application.]

46. Form, extent and effect of patent

(1) Every patent shall be in the prescribed form and shall have effect throughout India.

(2) A patent shall be granted for one invention only:

Provided that it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

47. Grant of patents subject to certain conditions

The grant of a patent under this Act shall be subject to the condition that -

(1) any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which the patent is granted, may be imported or made by or on behalf of the Government for the purpose merely of its own use;

(2) any process in respect of which the patent is granted may be used by or on behalf of the Government for the purpose merely of its own use;

(3) any machine, apparatus or other article in respect of which the patent is granted or any article made by the use of the process in respect of which the patent is granted, may be made or used, and any process in respect of which the patent is granted or may be used, by any person, for the purpose merely of experiment or research including the imparting of instructions to pupils; and

(4) in the case of a patent in respect of any medicine or drug, the medicine or drug may be imported by the Government for the purpose merely of its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.

CASE LAW

The effect of grant of patent is quid pro quo. Quid is the knowledge disclosed to the public through the invention and quo is the monopoly granted for the term of the patent. **Raj Prakash v. Mangat Ram, AIR 1978 Del. 1 (DB).**

[93][48. Rights of patentees

Subject to the other provisions contained in this Act and the conditions specified in section 47, a patent granted under this Act shall confer upon the patentee-

(a) where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from

the act of making, using, offering for sale, selling or importing for those purposes that product in India;

(b) where the subject matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India.

[94][***]

CASE LAW

In a suit for permanent injunction restraining the defendants from infringing any manner, the patentee had to make prima facie case about the existence of his monopoly right and its infringement by the defendant. **Surendra Lal Mahendra v. Jain Glazers & Ors., ILR (1981) 1 Delhi 257 (263,265): 1981(1) PTC112 (Del).**

The statutory and monopoly rights cannot be reduced to a nullity as by virtue of section 48 of the Act till the term of validity of the suit patents, the plaintiff is entitled to prevent any third party from infringing his patent rights. **Novartis AG v. Cipla Ltd., (2015) 216 DLT 689.**

A Patentee has cause of action to restrain the infringement of patent only during the continuance of the patent. **Indian Hume Pipe Co. Ltd v. Vendra Venkanna, AIR 1963 AP 58 (61) (DB).**

49. Patents rights not infringed when used on foreign vessels, etc., temporarily or accidentally in India

(1) Where a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such country comes into India (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention -

(a) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or

(b) in the construction or working of the aircraft or land vehicle or of the accessories thereof, as the case may be.

(2) This section shall not extend to vessels, aircraft or land vehicles owned by persons ordinarily resident in a foreign country the laws of which do not confer corresponding rights with respect to the use of inventions in vessels, aircrafts or land vehicles owned by persons ordinarily resident in India while in the ports or within the territorial waters of that foreign country or otherwise within the jurisdiction of its courts.

50. Rights of co-owners of patents

(1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions contained in this section and in section 51, where

two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to [95][the rights conferred by section 48] for his own benefit without accounting to the other person or persons.

(3) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a licence under the patent shall not be granted and a share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons.

(4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions contained in this section, the rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents; and nothing contained in sub-section (1) or sub-section (2) shall affect the mutual rights or obligations of trustees or of the representatives of a deceased person or their rights or obligations as such.

(6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.

51. Power of Controller to give directions to co-owners

(1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licence under the patent, or the exercise of any right under section 50 in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of a patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard -

(a) in the case of an application under sub-section (1), to the other person or persons registered as grantee or proprietor of the patent;

(b) in the case of an application under sub-section (2), to the person in default.

(4) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent

with the terms of any agreement between persons registered as grantee or proprietor of the patent.

52. Grant of patent to true and first inventor where it has been obtained by another in fraud of him

(1) [96][Where the patent has been revoked under section 64] on the ground that the patent was obtained wrongfully and in contravention of the rights of the petitioner or any person under or through whom he claims, or, where in a petition for revocation, the [97][Appellate Board or Court], instead of revoking the patent, directs the complete specification to be amended by the exclusion of a claim or claims in consequence of a finding that the invention covered by such claim or claims had been obtained from the petitioner, the [98][Appellate Board or Court] may, by order passed in the same proceeding, permit the grant to the petitioner of the whole or such part of the invention which the [99][Appellate Board or court] finds has been wrongfully obtained by the patentee, in lieu of the patent so revoked or is excluded by amendment.

(2) Where any such order is passed, the Controller shall, on request by the petitioner made in the prescribed manner grant to him -

(i) in cases where the [100][Appellate Board or Court] permits the whole of the patent to be granted, a new patent bearing the same date and number as the patent revoked;

(ii) in cases where the [101][Appellate Board or Court] permits a part only of the patent to be granted, a new patent for such part bearing the same date as the patent revoked and numbered in such manner as may be prescribed:

Provided that the Controller may, as a condition of such grant, require the petitioner to file a new and complete specification to the satisfaction of the Controller describing and claiming that part of the invention for which the patent is to be granted.

(3) No suit shall be brought for any infringement of a patent granted under this section committed before the actual date on which such patent was granted.

53. Term of patent

[102][(1) Subject to the provisions of this Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of every patent which has not expired and has not ceased to have effect, on the date of such commencement, under this Act, shall be twenty years from the date of filing of the application for the patent.]

[103][*Explanation*.–For the purposes of this sub-section, the term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty.]

(2) A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period [104][or within such extended period as may be prescribed.]

(3) [105][Omitted by the Patents (Amendment) Act, 2005.]

(4) [106][Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on the expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.]

CASE LAW

An order of delivery for destruction is not intended as a punishment to the infringer, rather it is made with a view to assist the plaintiff and to assure the order of injunction is effective and to prevent the defendant from the temptation of carrying on further breach. Therefore, upon the lapse of patent, an order of injunction cannot be continued. **C. Siddeswaran v. R. Shanmugham Pillai, (1977) 2 MLJ 242.**

Court can ask the patentee to make complete disclosure about the profits earned by the inventor or his assignees in his country and all countries where the invention was registered or exploited during the term of the patent. If the court believes that there has not been a full or bonafide disclosure, then the court may summarily reject the application. **The Indian Casablancas High Draft Company v. The Millowners Association, AIR 1935 Bom 195 (196).**

CHAPTER IX

PATENTS OF ADDITION

54. Patents of addition

(1) Subject to the provisions contained in this section, where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the "main invention") and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions contained in this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order, revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of

filing of the [107][application] was the same as or later than the date of filing of the [108][application] in respect of the main invention.

(4) [109][A patent of addition shall not be granted before grant of the patent for the main invention.]

55. Term of patents of addition

(1) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as has not expired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:
Provided that if the patent for the main invention is revoked under this Act, the court, or, as the case may be, the Controller, on request made to him by the patentee in the prescribed manner, may order that the patent of addition shall become an independent patent for the remainder of the term for the patent for the main invention and thereupon the patent shall continue in force as an independent patent accordingly.

(2) No renewal fee shall be payable in respect of a patent of addition, but, if any such patent becomes an independent patent under sub-section (1), the same fee shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

56. Validity of patents of addition

(1) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of -
(a) the main invention described in the complete specification relating thereto; or
(b) any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition,
and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

(2) For the removal of doubts it is hereby declared that in determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for a patent of addition regard shall be had also to the complete specification in which the main invention is described.

CHAPTER X

AMENDMENT OF APPLICATIONS AND SPECIFICATIONS

57. Amendment of application and specification or any document related thereto before Controller

(1) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification [110][or any document related thereto] to be amended subject to such conditions, if any, as the Controller thinks fit:
Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification [111][or any document related thereto] under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.

(2) Every application for leave to amend an application for a patent [112][or a complete specification or any document related thereto] under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made.

(3) [113][Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published;]

(4) Where an application is [114][published] under sub-section (3), any person interested may, within the prescribed period after the [115][publication] thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.

(6) [116][The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to comply with the directions of the Controller issued before the grant of a patent.]

[117][58. Amendment of specification before Appellate Board or High Court

(1) In any proceeding before the Appellate Board or the High Court for the revocation of a patent, the Appellate Board or the High Court, as the case may be, may, subject to the provisions contained in section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the Appellate Board or the High Court may think fit, and if in any proceedings for revocation the Appellate Board or the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the Appellate Board or the High Court, the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed by the Appellate Board or the High Court.

(3) Copies of all orders of the Appellate Board or the High Court allowing the patentee to amend the specification shall be transmitted by the Appellate Board or the High Court to the Controller who shall, on receipt thereof, cause an entry thereof and reference thereto to be made in the register.]

59. Supplementary provisions as to amendment of application or specification

[118][(1) No amendment of an application for a patent or a complete specification or any document related thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.]

[119][(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or the High Court, as the case may be,—

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;

(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.]

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.

CHAPTER XI

RESTORATION OF LAPSED PATENTS

60. Applications for restorations of lapsed patents

(1) Where a patent has ceased to have effect by reason of failure to pay any renewal fee within the [120][period prescribed under section 53 or within such period as may be allowed under sub-section (4) of section 142] the patentee or his legal representative, and where the patent was held by two or more persons jointly, then, with the leave of the Controller, one or more of them without joining the others, may, within [121][eighteen months] from the date on which the patent ceased to have effect, make an application for the restoration of the patent.

(2) [122][Omitted by the Patents (Amendment) Act, 2002].

(3) An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary.

61. Procedure for disposal of applications for restoration of lapsed patents

(1) If, after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is prima facie satisfied that the failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, he shall [123][publish the application] in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say, -

(a) that the failure to pay the renewal fee was not unintentional; or

(b) that there has been undue delay in the making of the application.

(2) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(3) If no notice of opposition is given within the period aforesaid or if in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser, of that patent.

(4) The Controller may, if he thinks fit, as a condition of restoring the patent, require that an entry shall be made in the register of any document or matter which, under the provisions of this Act, has to be entered in the

register but which has not been so entered.

62. Rights of Patentees of lapsed patents which have been restored

(1) Where a patent is restored, the rights of the patentee shall be subject to such provisions as may be prescribed and to such other provisions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of the patented invention between the date when the patent ceased to have effect and the date of the [124][publication] of the application for restoration of the patent under this Chapter.

(2) No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a patent committed between the date on which the patent ceased to have effect and the [125][date of publication] of the application for restoration of the patent.

CHAPTER XII

SURRENDER AND REVOCATION OF PATENTS

63. Surrender of patents

(1) A patentee may, at any time by giving notice in the prescribed manner to the Controller, offer to surrender his patent.

(2) Where such an offer is made, the Controller shall [126][publish] the offer in the prescribed manner, and also notify every person other than the patentee whose names appears in the register as having an interest in the patent.

(3) Any person interested may, within the prescribed period after [127][such publication], give notice to the Controller of opposition to the surrender, and where any such notice is given the Controller shall notify the patentee.

(4) If the Controller is satisfied after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and, by order, revoke the patent.

64. Revocation of patents

(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may [128][be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter-claim in a suit for infringement of the patent by the High Court] on any of the following grounds, that is to say -

(a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;

(b). that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefore:

[129][***]

(c) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;

(d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;

(e) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in section 13;

[130][***]

(f) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim;

[131][***]

(g) that the invention, so far as claimed in any claim of the complete specification, is not useful;

(h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;

(i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

(j) that the patent was obtained on a false suggestion or representation;

(k) that the subject of any claim of the complete specification is not patentable under this Act;

(l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (3), before the priority date of the claim;

(m) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished

information which in any material particular was false to his knowledge;

(n) that the applicant contravened any direction for secrecy passed under section 35 [132][or made or caused to be made an application for the grant of a patent outside India in contravention of section 39;]

(o) that leave to amend the complete specification under section 57 or section 58 was obtained by fraud;

[133][(p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(q). that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.]

(2) For the purposes of clauses (e) and (f) of sub-section (1), -

(a) no account shall be taken of [134][personal document or secret trial or secret use;] and

(b) where the patent is for a process or for a product as made by a process described or claimed, the importation into India of the product made abroad by that process shall constitute knowledge or use in India of the invention on the date of the importation, except where such importation has been for the purpose of reasonable trial or experiment only.

(3) For the purpose of clause (l) of sub-section (1), no account shall be taken of any use of the invention -

(a) for the purpose of reasonable trial or experiment only; or

(b) by the Government or by any person authorised by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to the Government or person authorised as aforesaid or to the Government undertakings; or

(c) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title.

(4) Without prejudice to the provisions contained in sub-section (1), a patent may be revoked by the High Court on the petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of Government within the meaning of section 99 upon reasonable terms.

(5) A notice of any petition for revocation of a patent under this section shall

be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein and it shall not be necessary to serve a notice on any other person.

CASE LAW

If the patent is new and its validity has not been established in judicial proceeding till then, and doubts have been raised to show that the paten ought not to have been granted, the court will not interfere by issuing a temporary injunction. **V Manioka Thevar v. Star Plough Works, Melur, AIR 1965 Mad 327: (1965) 1 MLJ 406.**

The application for a revocation of a patent under section 64 can only be filed by "a person who is interested". **UCB Farchim SA v. Cipla Ltd & Ors., 2010 (167) DLT 459 (464).**

Under section 64, "a person interested" means a person who has a direct, present and tangible commercial interest or public interest which is affected by continuance of the patent in question. **Ajay Industrial Corporation v. Shiro Kanao of Ibaraki City, AIR 1983 Delhi: 496 (507) (DB): 1983 (3) PTC 245 (Del).**

One cannot claim revocation of patent by making allegation that patent embodies no discovery or invention without submitting any technical or expert evidence to support the allegation. **Ajay Industrial Corporation Vs. Shiro Kanao of Ibaraki City. AIR 1983 Delhi: 496 (507) (DB): 1983 (3) PTC 245 (Del).**

When damages are claimed for infringement the defendant can resist the suit on the ground that he was not aware of existence of such patent or had not reasonable means of knowing existence of the patent. And question over the validity of the patent can also be raised as a defence. **Indian Hume Pipe Co. Ltd v. Vendra Venkanna, AIR 1963 AP 58 (61) (DB).**

Even if a particular defendant did not raise opposition during pre-grant and post-grant stages, even then also, the legislature permits such defendant to question the validity of the patent during an infringement suit stage. **F. Hoffmann-LA Roche Ltd. and Anr. v. Cipla Ltd., 2009 (154) DLT 243 (267) (DB).**

Once the defendant already sought revocation of patent in an infringement suit through a counter-claim, then he cannot thereafter in his capacity as "any person interested" assail the concerned patent, by a way of revocation. **Dr. Aloys Wobben v. Yogesh Mehra, (2014) 15 SCC 360: AIR 2014 SC 2210.**

Section 64 provides two remedies for interested person. He can file a revocation petition or raise a counter-claim in infringement suit. **Dr. Aloys Wobben v. Yogesh Mehra, (2014) 15 SCC 360: AIR 2014 SC 2210.**

[135][65. Revocation of patent or amendment of complete specification on directions from Government in cases relating to atomic energy

(1) Where at any time after grant of a patent, the Central Government is satisfied that a patent is for an invention relating to atomic energy for which no patent can be granted under sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962), it may direct the Controller to revoke the patent, and thereupon the Controller, after giving notice, to the patentee and every other person whose name has been entered in the register as having an interest in the patent, and after giving them an opportunity of being heard, may revoke the patent.

(2) In any proceedings under sub-section (1), the Controller may allow the patentee to amend the complete specification in such manner as he considers necessary instead of revoking the patent.]

66. Revocation of patent in public interest

Where the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.

CHAPTER XIII

REGISTER OF PATENTS

67. Register of patents and particulars to be entered therein

(1) There shall be kept at the patent office a register of patents, wherein shall be entered-

(a) the names and addresses of grantees of patents;

(b) notifications of assignments and of transmission of patents, of licences under patents and of amendments, extensions, and revocations of patents; and

(c) particulars of such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) No notice of any trust, whether express, implied or constructive, shall be entered in the register, and the Controller shall not be affected by any such notice.

(3) Subject to the superintendence and directions of the Central Government, the register shall be kept under the control and management of the Controller.

[136][(4) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Controller to keep the register of patents or any part thereof in computer floppies, diskettes or any other electronic form subject to such safeguards as may be prescribed.

(5) Notwithstanding anything contained in the Indian Evidence Act, 1872 (1 of 1872), a copy of, or extracts from, the register of patents, certified to be a true copy under the hand of the Controller or any officer duly authorised by the Controller in this behalf shall, in all legal proceedings, be admissible in evidence.

(6) In the event the register is kept wholly or partly in computer floppies, diskettes or any other electronic form,-

(a) reference in this Act to an entry in the register shall be deemed to include reference to a record of particulars kept in computer floppies, diskettes or any other electronic form and comprising the register or part of the register;

(b) references in this Act to particulars being registered or entered in the register shall be deemed to include references to the keeping of record of those particulars comprising the register or part of the register in computer floppies, diskettes or any other electronic form; and

(c) references in this Act to the rectification of the register are to be read as including references to the rectification of the record of particulars kept in computer floppies, diskettes or any other electronic form and comprising the register or part of the register.]

[137][68. Assignments, etc., not to be valid unless in writing and duly executed

An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and duly executed.]

69. Registration of assignments, transmissions, etc.

(1) Where any person becomes entitled by assignment, transmission or operation of law to a patent or to a share in a patent or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, he shall apply in writing in the prescribed manner to the Controller for the registration of his title or, as the case may be, of notice of his interest in the register.

(2) Without prejudice to the provisions of sub-section (1), an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a patent may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where an application is made under this section for the registration of the title of any person the Controller shall, upon proof of title to his satisfaction, -

(a) where that person is entitled to a patent or a share in a patent, register him in the register as proprietor or co-proprietor of the patent, and enter in the register particulars of the instrument or event by which he derives title; or

(b) where that person is entitled to any other interest in the patent,

enter in the register notice of his interest, with particulars of the instrument, if any, creating it:

Provided that if there is any dispute between the parties whether the assignment, mortgage, licence, transmission, operation of law or any other such transaction has validly vested in such person a title to the patent or any share or interest therein, the Controller may refuse to take any action under clause (a) or, as the case may be, under clause (b), until the rights of the parties have been determined by a competent court.

(4) There shall be supplied to the Controller in the prescribed manner for being filed in the patent office copies of all agreements, licences and other documents affecting the title to any patent or any licence thereunder authenticated in the prescribed manner and also such other documents as may be prescribed relevant to the subject matter:

Provided that in the case of a licence granted under a patent, the Controller shall, if so requested by the patentee or licensee, take steps for securing that the terms of the licence are not disclosed to any person except under the order of a court.

(5) Except for the purposes of an application under sub-section (1) or of an application to rectify the register, a document in respect of which no entry has been made in the register under sub-section (3) shall not be admitted by the Controller or by any court as evidence of the title of any person to a patent or to a share or interest therein unless the Controller or the court, for reasons to be recorded in writing, otherwise directs.

70. Power of registered grantee or proprietor to deal with patent

Subject to the provisions contained in this Act relating to co-ownership of patents and subject also to any rights vested in any other person of which notice is entered in the register, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with, the patent and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other movable property.

71. Rectification of register by Appellate Board

(1) The [138][Appellate Board] may, on the application of any person aggrieved -

(a) by the absence or omission from the register of any entry; or

(b) by any entry made in the register without sufficient cause; or

(c) by any entry wrongly remaining on the register; or

(d) by any error or defect in any entry in the register,

make such order for the making, variation or deletion, of any entry therein as it may think fit.

(2) In any proceeding under this section the [139][Appellate Board] may decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(3) Notice of any application to the [140][Appellate Board] under this section shall be given in the prescribed manner to the Controller who shall be entitled to appear and be heard on the application, and shall appear if so directed by the [141][Board].

(4) Any order of the [142][Appellate Board] under this section rectifying the register shall direct that notice of the rectification shall be served upon the Controller in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

72. Register to be open for inspection

(1) Subject to the provisions contained in this Act and any rules made thereunder, the register shall at all convenient times be open to inspection by the public; and certified copies, sealed with the seal of the patent office, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.

(2) The register shall be *prima facie* evidence of any matters required or authorised by or under this Act to be entered therein.

[143][(3) If the record of particulars is kept in computer floppies or diskettes or in any other electronic form, sub-sections (1) and (2) shall be deemed to have been complied with if the public is given access to such computer floppies, diskettes or any other electronic form or printouts of such record of particulars for inspection.]

CHAPTER XIV

PATENT OFFICE AND ITS ESTABLISHMENT

73. Controller and other officers

(1) The Controller General of Patents, Designs and Trade Marks appointed under sub-section (1) of [144][section 3 of the Trade Marks Act, 1999 (47 of 1999)], shall be the Controller of Patents for the purposes of this Act.

(2) For the purposes of this Act, the Central Government may appoint as many Examiners and other officers and with such designations as it thinks fit.

(3) Subject to the provisions of this Act, the officers appointed under sub-section (2) shall discharge under the superintendence and directions of the Controller such functions of the Controller under this Act as he may, from time to time by general or special order in writing, authorise them to discharge.

(4) Without prejudice to the generality of the provisions of sub-section (3), the Controller may, by order in writing and for reasons to be recorded therein withdraw any matter pending before an officer appointed under sub-section (2) and deal with such matter himself either *de novo* or from the stage it was so withdrawn or transfer the same to another officer appointed under sub-section (2) who may, subject to special directions in the order of transfer, proceed with the matter either *de novo* or from the stage it was so transferred.

74. Patent office and its branches

(1) For the purposes of this Act, there shall be an office which shall be known as the patent office.

[145][(2) The Central Government may, by notification in the Official Gazette, specify the name of the Patent Office.]

(3) The head office of the patent office shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration of patents there may be established, at such other places as the Central Government may think fit, branch offices of the patent office.

(4) There shall be a seal of the patent office.

75. Restriction on employees of patent office as to right or interest in patents

All officers and employees of the patent office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by that office.

76. Officers and employees not to furnish information, etc.

An officer or employee in the patent office shall not, except when required or authorized by this Act or under a direction in writing of the [146][Central Government or Appellate Board] or the Controller or by order of a court,

(a) furnish information on a matter which is being, or has been, dealt with under this Act [147][***]; or

(b) prepare or assist in the preparation of a document required or permitted by or under this Act [148][***] to be lodged in the patent office; or

(c) conduct a search in the records of the patent office.

CHAPTER XV

POWERS OF CONTROLLER GENERALLY

77. Controller to have certain powers of civil court

(1) Subject to any rules made in this behalf, the Controller in any proceedings before him under this Act shall have the powers of a civil court while trying a suit under the Code of Civil Procedure, 1908 (5 of 1908), in respect of the following matters, namely:-

(a) summoning and enforcing the attendance of any person and examining him on oath;

(b) requiring the discovery and production of any document;

(c) receiving evidence on affidavits;

(d) issuing commissions for the examination of witnesses or documents;

(e) awarding costs;

(f) reviewing his own decision on application made within the prescribed time and in the prescribed manner;

(g) setting aside an order passed *ex-parte* on application made within the prescribed time and in the prescribed manner; and

(h) any other matter which may be prescribed.

(2) Any order for costs awarded by the Controller in exercise of the powers conferred upon him under sub-section (1) shall be executable as a decree of a civil court.

78. Power of Controller to correct clerical errors, etc.

(1) Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of applications for patents or complete specifications [149][or other documents related thereto] and subject to the provisions of section 44, the Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(4) Where a request is made under this section for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be [150][published] in the prescribed manner.

(5) Within the prescribed time after any [151][such publication] as aforesaid any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

CASE LAW

Controller has no power to make any amendment suo moto. **AIA Engineering Ltd. v. Controller of Patents and Anr, 2007 (34) PTC 457.**

79. Evidence how to be given and power of Controller in respect thereof

Subject to any rules made in this behalf, in any proceeding under this Act before the Controller, evidence shall be given by affidavit in the absence of direction by the Controller to the contrary, but in any case in which the Controller thinks it right so to do, he may take oral evidence in lieu of or in addition to, evidence by affidavit, or may allow any party to be cross-examined on the contents of his affidavit.

80. Exercise of discretionary powers by Controller

Without prejudice to any provision contained in this Act requiring the Controller to hear any party to the proceedings thereunder or to give any such party an opportunity to be heard, the Controller shall give to any applicant for a patent, or for amendment of a specification (if within the prescribed time the applicant so requires) an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Controller by or under this Act:

[152][Provided that the party desiring a hearing makes the request for such hearing to the Controller at least ten days in advance of the expiry of the time-limit specified in respect of the proceeding.]

81. Disposal by Controller of applications for extension of time

Where under the provisions of this Act or the rules made thereunder the Controller may extend the time for doing any act, nothing in this Act shall be deemed to require him to give notice to or hear the party interested in opposing the extension, nor shall any appeal lie from any order of the Controller granting such extension.

[153][CHAPTER XVI

WORKING OF PATENTS, COMPULSORY LICENCES AND REVOCATION

82. Definitions of "patented articles" and "patentee"

In this Chapter, unless the context otherwise requires,-

(a) "patented article" includes any article made by a patented process; and

(b) "patentee" includes an exclusive licensee.

83. General principles applicable to working of patented inventions

Without prejudice to the other provisions contained in this Act, in exercising the powers conferred by this Chapter, regard shall be had to the following general considerations, namely:

(a) that patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay;

(b) that they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article;

(c) that the protection and enforcement of patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations;

(d) that patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest specially in sectors of vital importance for socio-economic and technological development of India;

(e) that patents granted do not in any way prohibit Central Government in taking measures to protect public health;

(f) that the patent right is not abused by the patentee or person deriving title or interest on patent from the patentee, and the patentee or a person deriving title or interest on patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology; and

(g) that patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.

84. Compulsory licences

(1) At any time after the expiration of three years from the date of the [154][grant] of a patent, any person interested may make an application to the Controller for grant of compulsory licence on patent on any of the following grounds, namely:-

(a) that the reasonable requirements of the public with respect to the patented invention have not been satisfied, or

(b) that the patented invention is not available to the public at a reasonably affordable price, or

(c) that the patented invention is not worked in the territory of India.

(2) An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent and no person shall be estopped from alleging that the reasonable requirements of the public with respect to the patented invention are not satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price by reason of any admission made by him, whether in such a licence or otherwise or by reason of his having accepted such a licence.

(3) Every application under sub-section (1) shall contain a statement setting out the nature of the applicant's interest together with such particulars as may be prescribed and the facts upon which the application is based.

(4) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable

price, may grant a licence upon such terms as he may deem fit.

(5) Where the Controller directs the patentee to grant a licence he may, as incidental thereto, exercise the powers set out in section 88.

(6) In considering the application filed under this section, the Controller shall take into account,-

(i) the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;

(ii) the ability of the applicant to work the invention to the public advantage;

(iii) the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted;

(iv) as to whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period as the Controller may deem fit:

Provided that this clause shall not be applicable in case of national emergency or other circumstances of extreme urgency or in case of public non-commercial use or on establishment of a ground of anti-competitive practices adopted by the patentee,

but shall not be required to take into account matters subsequent to the making of the application.

[155][*Explanation*.—For the purposes of clause (iv), "reasonable period" shall be construed as a period not ordinarily exceeding a period of six months.]

(7) For the purposes of this Chapter, the reasonable requirements of the public shall be deemed not to have been satisfied-

(a) if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,-

(i) an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced; or

(ii) the demand for the patented article has not been met to an adequate extent or on reasonable terms; or

(iii) a market for export of the patented article manufactured in India is not being supplied or developed; or

(iv) the establishment or development of commercial activities in India is prejudiced; or

(b) if, by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or

(c) if the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of patent or coercive package licensing, or

(d) if the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable, or

(e) if the working of the patented invention in the territory of India on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by-

(i) the patentee or persons claiming under him; or

(ii) persons directly or indirectly purchasing from him; or

(iii) other persons against whom the patentee is not taking or has not taken proceedings for infringement.

85. Revocation of patents by the Controller for non-working

(1) Where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, after the expiration of two years from the date of the order granting the first compulsory licence, apply to the Controller for an order revoking the patent on the ground that the patented invention has not been worked in the territory of India or that reasonable requirements of the public with respect to the patented invention has not been satisfied or that the patented invention is not available to the public at a reasonably affordable price.

(2) Every application under sub-section (1) shall contain such particulars as may be prescribed, the facts upon which the application is based, and, in the case of an application other than by the Central Government, shall also set out the nature of the applicant's interest.

(3) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that patented invention has not been worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may make an order revoking the patent.

(4) Every application under sub-section (1) shall ordinarily be decided within one year of its being presented to the Controller.

86. Power of Controller to adjourn applications for compulsory licences, etc., in certain cases

(1) Where an application under section 84 or section 85, as the case may be, is made on the grounds that the patented invention has not been worked in the territory of India or on the ground mentioned in clause (d) of sub-section (7) of section 84 and the Controller is satisfied that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable, he may, by order, adjourn the further hearing of the application for such period not exceeding twelve months in the aggregate as appears to him to be sufficient for the invention to be so worked:

Provided that in any case where the patentee establishes that the reason why a patented invention could not be worked as aforesaid before the date of the application was due to any State or Central Act or any rule or regulation made thereunder or any order of the Government imposed otherwise than by way of a condition for the working of the invention in the

territory of India or for the disposal of the patented articles or of the articles made by the process or by the use of the patented plant, machinery, or apparatus, then, the period of adjournment ordered under this sub-section shall be reckoned from the date on which the period during which the working of the invention was prevented by such Act, rule or regulation or order of Government as computed from the date of the application, expires.

(2) No adjournment under sub-section (1) shall be ordered unless the Controller is satisfied that the patentee has taken with promptitude adequate or reasonable steps to start the working of the invention in the territory of India on a commercial scale and to an adequate extent.

87. Procedure for dealing with applications under sections 84 and 85

(1) Where the Controller is satisfied, upon consideration of an application under section 84, or section 85, that a prima facie case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and [156][shall publish the application in the official journal.]

(2) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.

(3) Any such notice of opposition shall contain a statement setting out the grounds on which the application is opposed.

(4) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

88. Powers of Controller in granting compulsory licences

(1) Where the Controller is satisfied on an application made under section 84 that the manufacture, use or sale of materials not protected by the patent is prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 84 is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.

(3) Where two or more patents are held by the same patentee and an applicant for a compulsory licence establishes that the reasonable requirements of the public have not been satisfied with respect to some only of the said patents, then, if the Controller is satisfied that the applicant cannot

efficiently or satisfactorily work the licence granted to him under those patents without infringing the other patents held by the patentee and if those patents involve important technical advancement of considerable economic significance in relation to the other patents, he may, by order, direct the grant of a licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84.

(4) Where the terms and conditions of a licence have been settled by the Controller, the licensee may, at any time after he has worked the invention on a commercial scale for a period of not less than twelve months, make an application to the Controller for the revision of the terms and conditions on the ground that the terms and conditions settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss:
Provided that no such application shall be entertained a second time.

89. General purposes for granting compulsory licences

The powers of the Controller upon an application made under section 84 shall be exercised with a view to securing the following general purposes, that is to say,-

(a) that patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable;

(b) that the interests of any person for the time being working or developing an invention in the territory of India under the protection of a patent are not unfairly prejudiced.

90. Terms and conditions of compulsory licences

(1) In settling the terms and conditions of a licence under section 84, the Controller shall endeavour to secure-

(i) that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;

(ii) that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;

(iii) that the patented articles are made available to the public at reasonably affordable prices;

(iv) that the licence granted is a non-exclusive licence;

(v) that the right of the licensee is non-assignable;

(vi) that the licence is for the balance term of the patent unless a shorter term is consistent with public interest;

[157][(vii) that the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product, if need be in accordance with the provisions of

sub-clause (iii) of clause (a) of sub-section (7) of section 84;

(viii) that in the case of semi-conductor technology, the licence granted is to work the invention for public non-commercial use;

(ix) that in case the licence is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be.]

(2) No licence granted by the Controller shall authorise the licensee to import the patented article or an article or substance made by a patented process from abroad where such importation would, but for such authorisation, constitute an infringement of the rights of the patentee.

(3) Notwithstanding anything contained in sub-section (2), the Central Government may, if in its opinion it is necessary so to do, in the public interest, direct the Controller at any time to authorise any licensee in respect of a patent to import the patented article or an article or substance made by a patented process from abroad (subject to such conditions as it considers necessary to impose relating among other matters to the royalty and other remuneration, if any, payable to the patentee, the quantum of import, the sale price of the imported article and the period of importation), and thereupon the Controller shall give effect to the directions.

91. Licensing of related patents

(1) Notwithstanding anything contained in the other provisions of this Chapter, at any time after the sealing of a patent, any person who has the right to work any other patented invention either as patentee or as license thereof, exclusive or otherwise, may apply to the Controller for the grant of a licence of the first-mentioned patent on the ground that he is prevented or hindered without such licence from working the other invention efficiently or to the best advantage possible.

(2) No order under sub-section (1) shall be made unless the Controller is satisfied-

(i) that the applicant is able and willing to grant, or procure the grant to the patentee and his licensees if they so desire, of a licence in respect of the other invention on reasonable terms; and

(ii) that the other invention has made a substantial contribution to the establishment or development of commercial or industrial activities in the territory of India.

(3) When the Controller is satisfied that the conditions mentioned in sub-section (1) have been established by the applicant, he may make an order on such terms as he thinks fit granting a licence under the first-mentioned patent and a similar order under the other patent if so requested by the proprietor of the first-mentioned patent or his licensee:
Provided that the licence granted by the Controller shall be non-assignable except with the assignment of the respective patents.

(4) The provisions of sections 87, 88, 89 and 90 shall apply to licences granted under this section as they apply to licences granted under section 84.

92. Special provision for compulsory licences on notifications by Central Government

(1) If the Central Government is satisfied, in respect of any patent in force in circumstances of national emergency or in circumstances of extreme urgency or in case of public non-commercial use, that it is necessary that compulsory licences should be granted at any time after the sealing thereof to work the invention, it may make a declaration to that effect, by notification in the Official Gazette, and thereupon the following provisions shall have effect, that is to say,-

(i) the Controller shall, on application made at any time after the notification by any person interested, grant to the applicant a licence under the patent on such terms and conditions as he thinks fit;

(ii) in settling the terms and conditions of a licence granted under this section, the Controller shall endeavour to secure that the articles manufactured under the patent shall be available to the public at the lowest prices consistent with the patentee deriving a reasonable advantage from their patent rights.

(2) The provisions of sections 83, 87, 88, 89 and 90 shall apply in relation to the grant of licences under this section as they apply in relation to the grant of licences under section 84.

(3) Notwithstanding anything contained in sub-section (2), where the Controller is satisfied on consideration of the application referred to in clause (i) of sub-section (1) that it is necessary in-

(i) a circumstance of national emergency; or

(ii) a circumstance of extreme urgency; or

(iii) a case of public non-commercial use,

which may arise or is required, as the case may be, including public health crises, relating to Acquired Immuno Deficiency Syndrome, human immunodeficiency virus, tuberculosis, malaria or other epidemics, he shall not apply any procedure specified in section 87 in relation to that application for grant of licence under this section:
Provided that the Controller shall, as soon as may be practicable, inform the patentee of the patent relating to the application for such non-application of section 87.

[158][92-A. Compulsory licence for export of patented pharmaceutical products in certain exceptional circumstances

(1) Compulsory licence shall be available for manufacture and export of patented pharmaceutical products to any country having insufficient or no manufacturing capacity in the pharmaceutical sector for the concerned product to address public health problems, provided compulsory licence has been granted by such country or such country has, by notification or otherwise, allowed importation of the patented pharmaceutical products from India.

(2) The Controller shall, on receipt of an application in the prescribed manner, grant a compulsory licence solely for manufacture and export of the concerned pharmaceutical product to such country under such terms

and conditions as may be specified and published by him.

(3) The provisions of sub-sections (1) and (2) shall be without prejudice to the extent to which pharmaceutical products produced under a compulsory licence can be exported under any other provision of this Act.

Explanation.—For the purposes of this section, "pharmaceutical products" means any patented product, or product manufactured through a patented process, of the pharmaceutical sector needed to address public health problems and shall be inclusive of ingredients necessary for their manufacture and diagnostic kits required for their use.]

93. Order for licence to operate as a deed between parties concerned

Any order for the grant of a licence under this Chapter shall operate as if it were a deed granting a licence executed by the patentee and all other necessary parties embodying the terms and conditions, if any, settled by the Controller.

94. Termination of compulsory licence

(1) On an application made by the patentee or any other person deriving title or interest in the patent, a compulsory licence granted under section 84 may be terminated by the Controller, if and when the circumstances that gave rise to the grant thereof no longer exist and such circumstances are unlikely to recur:

Provided that the holder of the compulsory licence shall have the right to object to such termination.

(2) While considering an application under sub-section (1), the Controller shall take into account that the interest of the person who had previously been granted the licence is not unduly prejudiced.]

95. to 98. [Repealed by the Patent (Amendment) Act, 2002 (38 of 2002), w.e.f. 20.05.2005

CHAPTER XVII

USE OF INVENTIONS FOR PURPOSES OF GOVERNMENT AND ACQUISITION OF INVENTIONS BY CENTRAL GOVERNMENT

99. Meaning of use of inventions for purposes of Government

(1) For the purposes of this Chapter, an invention is said to be used for the purposes of Government if it is made, used, exercised or vended for the purposes of the Central Government, a State Government or a Government undertaking.

(2) [159][Omitted by the Patents (Amendment) Act, 2002]

(3) Nothing contained in this Chapter shall apply in respect of any such importation making or using of any machine, apparatus or other article

or of any such using of any process or of any such importation, using or distribution of any medicine or drug, as may be made by virtue of one or more of the conditions specified in section 47.

100. Power of Central Government to use inventions for purposes of Government

(1) Notwithstanding anything contained in this Act, at any time after an application for a patent has been filed at the patent office or a patent has been granted, the Central Government and any person authorised in writing by it, may use the invention for the purposes of Government in accordance with the provisions of this Chapter.

(2) Where an invention has, before the priority date of the relevant claim of the complete specification, been duly recorded in a document, or tested or tried, by or on behalf of the Government or a Government undertaking, otherwise than in consequence of the communication of the invention directly or indirectly by the patentee or by a person from whom he derives title, any use of the invention by the Central Government or any person authorised in writing by it for the purposes of Government may be made free of any royalty or other remuneration to the patentee.

(3) If and so far as the invention has not been so recorded or tried or tested as aforesaid, any use of the invention made by the Central Government or any person authorised by it under sub-section (1), at any time after [160][grant of the patent] or in consequence of any such communication as aforesaid, shall be made upon terms as may be agreed upon either before or after the use, between the Central Government or any person authorised under sub-section (1) and the patentee, or, as may in default of agreement be determined by the High Court on a reference under section 103:

[161][Provided that in case of any such use of any patent, the patentee shall be paid not more than adequate remuneration in the circumstances of each case, taking into account the economic value of the use of the patent.]

(4) The authorisation by the Central Government in respect of an invention may be given under this section, either before or after the patent is granted and either before or after the acts in respect of which such authorisation is given or done, and may be given to any person, whether or not he is authorised directly or indirectly by the applicant or the patentee to make, use, exercise or vend the invention or import the machine, apparatus or other article or medicine or drug covered by such patent.

(5) Where an invention has been used by or with the authority of the Central Government for the purposes of Government under this section, then, [162][except in case of national emergency or other circumstances of extreme urgency or for non-commercial use], the Government shall notify the patentee as soon as practicable of the fact and furnish him with such information as to the extent of the use of the invention as he may, from time to time, reasonably require; and where the invention has been used for the purposes of a Government undertaking, the Central Government

may call for such information as may be necessary for this purpose from such undertaking.

(6) The right to make, use, exercise and vend an invention for the purposes of Government under sub-section (1) shall include the [163][right to sell, on non-commercial basis, the goods] which have been made in exercise of that right, and a purchaser of goods so sold, and a person claiming through him, shall have the power to deal with the goods as if the Central Government or the person authorised under sub-section (1) were the patentee of the invention.

(7) Where in respect of a patent which has been the subject matter of an authorisation under this section, there is an exclusive licensee as is referred to in sub-section (3) of section 101, or where such patent has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention (including payments by way of minimum royalty), the notice directed to be given under sub-section (5) shall also be given to such exclusive licensee or assignor, as the case may be, and the reference to the patentee in sub-section (3) shall be deemed to include a reference to such assignor or exclusive licensee.

CASE LAW

Under section 100 of the patent act, the Central Government or its department can authorize task to somebody else. That is an agreement in the name of President of India signed by the officers of Railways can be a good substitute for authorization. **Garware Wall Ropes Ltd v. A.I. Chopra, 2009(4) AIR Bom R 441.**

101. Rights of third parties in respect of use of invention for purposes of Government

(1) In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the purposes of Government -

(a) by the Central Government or any person authorised by the Central Government under section 100; or

(b) by the patentee or applicant for the patent to the order made by the Central Government,

the provisions of any licence, assignment or agreement granted or made, [164][***] between the patentee or applicant for the patent (or any person who derives title from him or from whom he derives title) and any person other than the Central Government shall be of no effect so far as those provisions-

(i) restrict or regulate the use for the purposes of Government of the invention, or of any model, document or information relating thereto, or

(ii) provide for the making of payments in respect of any use of the invention or of the model, document or information relating thereto for the purposes of Government, [165][***]

and the reproduction or publication of any model or document in connection with the said use for the purposes of Government shall not be deemed to be an infringement of any copyright subsisting in the model or document.

(2) Where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention [166][***], then, in relation to any use of the invention made for the purposes of Government by the patentee to the order of the Central Government, sub-section (3) of section 100 shall have effect as if that use were made by virtue of an authority given under that section; and any use of the invention for the purposes of Government by virtue of sub-section (3) of that section shall have effect as if the reference to the patentee included a reference to the assignor of the patent, and any sum payable by virtue of that sub-section shall be divided between the patentee and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103.

(3) Where by virtue of sub-section (3) of section 100, payments are required to be made by the Central Government or persons authorised under sub-section (1) of that section in respect of the use of an invention for the purposes of Government and where in respect of such patent there is an exclusive licensee authorised under his licence to use the invention for the purposes of Government, such sum shall be shared by the patentee and such licensee in such proportions, if any, as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103 to be just, having regard to any expenditure incurred by the licensee -

(a) in developing the said invention; or

(b) in making payments to the patentees other than royalties or other benefits determined by reference to the use of the invention [167][***] in consideration of the licence.

102. Acquisition of inventions and patents by the Central Government

(1) The Central Government may, if satisfied that it is necessary that an invention which is the subject of an application for a patent or a patent should be acquired from the applicant or the patentee for a public purpose, publish a notification to that effect in the Official Gazette, and thereupon the invention or patent and all rights in respect of the invention or patent shall, by force of this section, stand transferred to and be vested in the Central Government.

(2) Notice of the acquisition shall be given to the applicant, and, where a patent has been granted, to the patentee and other persons, if any, appearing in the register as having an interest in the patent.

(3) The Central Government shall pay to the applicant, or, as the case may

be, the patentee and other persons appearing on the register as having an interest in the patent such compensation as may be agreed upon between the Central Government and the applicant, or the patentee and other persons; or, as may, in default of agreement, be determined by the High Court on a reference under section 103 to be just having regard to the expenditure incurred in connection with the invention and, in the case of a patent, the term thereof, the period during which and the manner in which it has already been worked (including the profits made during such period by the patentee or by his licensee whether exclusive or otherwise) and other relevant factors.

103. Reference to High Court of disputes as to use for purposes of Government

(1) Any dispute as to the exercise by the Central Government or a person authorised by it of the powers conferred by section 100, or as to terms for the use of an invention for the purposes of Government thereunder or as to the right of any person to receive any part of a payment made in pursuance of sub-section (3) of that section or as to the amount of compensation payable for the acquisition of an invention or a patent under section 102, may be referred to the High Court by either party to the dispute in such manner as may be prescribed by the rules of the High Court.

(2) In any proceedings under this section to which the Central Government is a party, the Central Government may, -

(a) if the patentee is a party to the proceedings, petition by way of counter-claim for revocation of the patent on any ground upon which a patent may be revoked under section 64; and

(b) whether a patentee is or is not a party to the proceedings, put in issue the validity of the patent without petitioning for its revocation.

(3) If in such proceedings as aforesaid any question arises whether an invention has been recorded, tested or tried as is mentioned in section 100, and the disclosure of any document regarding the invention, or of any evidence of the test or trial thereof, would, in the opinion of the Central Government, be prejudicial to the public interest, the disclosure may be made confidentially to the advocate of the other party or to an independent expert mutually agreed upon.

(4) In determining under this section any dispute between the Central Government and any person as to terms for the use of an invention for the purposes of Government, the High Court shall have regard to any benefit or compensation which that person or any person from whom he derives title, may have received, or may be entitled to receive, directly or indirectly in respect of the use of the invention in question for the purposes of Government.

(5) In any proceedings under this section, the High Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, commissioner or an arbitrator, on such terms as the High Court may direct, and references to the High Court in the foregoing provisions of this section shall be construed accordingly.

(6) Where the invention claimed in a patent was made by a person who at the time it was made was in the service of the Central Government or of

a State Government or was an employee of a Government undertaking and the subject-matter of the invention is certified by the relevant Government or the principal officer of the Government undertaking to be connected with the work done in the course of the normal duties of the Government servant or employee of the Government undertaking, then, notwithstanding anything contained in this section, any dispute of the nature referred to in sub-section (1) relating to the invention shall be disposed of by the Central Government conformably to the provisions of this section so far as may be applicable, but before doing so the Central Government shall give an opportunity to the patentee and such other parties as it considers have an interest in the matter to be heard.

CHAPTER XVIII

SUITS CONCERNING INFRINGEMENT OF PATENTS

104. Jurisdiction

No suit for a declaration under section 105 or for any relief under section 106 or for infringement of a patent shall be instituted in any court inferior to a district court having jurisdiction to try to suit:

Provided that where a counter-claim for revocation of the patent is made by the defendant, the suit, along with the counter-claim, shall be transferred to the High Court for decision.

CASE LAW

When a person infringes a patent by making the article himself or by his agent or servant, then action can be taken against the servants and agents individually or collectively along with their employer and principal. **Rohtas Industries Ltd. and Ors v. Indian Hume Pipe Co. Ltd., AIR 1954 Pat 492 (497) (DB).**

Delay in filing infringement suit can disentitle plaintiffs' to relief of perpetual injunction, if it has capacity to create considerable loss or prejudice to defendants. **Farbewerke Hoechst Aktiengesellschaft v. Unichem Laboratories, AIR 1969 Bom 255 (260).**

The proviso to section 104 is an exception to the general rule, it needs to be construed strictly. Jurisdiction of District Court is ousted only when there is a counter claim seeking renovation of patent. **Fabcon v Industrial Engineering Corporation, AIR 1987 All 338 (339): 1986 All WC 420.**

In a suit for infringement of patent, the plaintiff has to prove that his process has been counterfeited or imitated by the defendants. He must give the particulars of the breaches constituting the alleged infringement of his patent rights. **Lallubhai Chakubhai Jariwala v. Chimanlal Chunilal and Co, AIR 1936 Bom 99 (100,101).**

In a suit for infringement of patent, the plaintiff must prove that the patent is being infringed by resorting to a process patented by him. He need to make it clear that the article is the same which was seized and to have

been produced by defendant is of Plaintiff's. **The Bombay Agarwal Co. v. Ramchand Diwanchand and Anr., AIR 1953 Nag 154 (157, 158) (DB).**

Where a counter claim for revocation of patent is made by the defendant, the suit along with counter claim would be transferred to the High Court. **SERGI Transformers Explosion Prevention Technologies Pvt. Ltd. v. CTR Manufacturing Industries Ltd., 2011 (47) PTC 521.**

[168][104A. Burden of proof in case of suits concerning infringement

(1) In any suit for infringement of a patent, where the subject matter of patent is a process for obtaining a product, the court may direct the defendant to prove that the process used by him to obtain the product, identical to the product of the patented process, is different from the patented process if,-
   (a) the subject matter of the patent is a process for obtaining a new product; or
   (b) there is a substantial likelihood that the identical product is made by the process, and the patentee or a person deriving title or interest in the patent from him, has been unable through reasonable efforts to determine the process actually used:

   Provided that the patentee or a person deriving title or interest in the patent from him, first proves that the product is identical to the product directly obtained by the patented process.

(2) In considering whether a party has discharged the burden imposed upon him by sub-section (1), the court shall not require him to disclose any manufacturing or commercial secrets, if it appears to the court that it would be unreasonable to do so.]

105. Power of Court to make declaration as to non-infringement

(1) Notwithstanding anything contained in section 34 of the Specific Relief Act, 1963(47 of 1963), any person may institute a suit for a declaration that the use by him of any process, or the making, use or sale of any article by him does not, or would not, constitute an infringement of a claim of a patent against the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or the licensee, if it is shown -
   (a) that the plaintiff has applied in writing to the patentee or exclusive licensee for a written acknowledgement to the effect of the declaration claimed and has furnished him with full particulars in writing of the process or article in question; and
   (b) that the patentee or licensee has refused or neglected to give such an acknowledgement.

(2) The costs of all parties in a suit for a declaration brought by virtue of this section shall, unless for special reasons the court thinks fit to order otherwise, be paid by the plaintiff.

(3) The validity of a claim of the specification of a patent shall not be called in question in a suit for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid or invalid.

(4) A suit for a declaration may be brought by virtue of this section at any time [169][after the publication of grant of a patent], and references in this section to the patentee shall be construed accordingly.

106. Power of Court to grant relief in cases of groundless threat of infringement proceedings

(1) Where any person (whether entitled to or interested in a patent or an application for a patent or not) threatens any other person by circulars or advertisements or by communications, oral or in writing addressed to that or any other person, with proceedings for infringement of a patent, any person aggrieved thereby may bring a suit against him praying for the following reliefs, that is to say -
   (a) a declaration to the effect that the threats are unjustifiable;
   (b) an injunction against the continuance of the threats; and
   (c) such damages, if any, as he has sustained thereby.

(2) Unless in such suit the defendant proves that the acts in respect of which the proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the court may grant to the plaintiff all or any of the reliefs prayed for.

Explanation. – A mere notification of the existence of a patent does not constitute a threat of proceeding within the meaning of this section.

CASE LAW

Suppression of material facts can be a reason to refuse Injunction. **Standipack Pvt. Ltd v. Oswal Trading Co. Ltd, AIR 2000 Del 23: 1999(19) PTC 479 (Del).**

Injunction cannot be granted if the validity of patent is questioned at the time of moving revocation application. **Standipack Pvt. Ltd v. Oswal Trading Co. Ltd, AIR 2000 Del 23: 1999 (19) PTC 479 (Del).**

107. Defences, etc., in suits for infringement

(1) In any suit for infringement of a patent, every ground on which it may be revoked under section 64 shall be available as a ground for defence.

(2) In any suit for infringement of a patent by the making, using or importation of any machine, apparatus or other article or by the using of any process or by the importation, use or distribution of any medicine or drug, it shall be a ground for defence that such making, using importation or distribution is in accordance with any or more of the conditions specified in section 47.

CASE LAW

If a foreigner who got his patents registered in India does not keep them in use in India and thereby seriously affected market and economy of India, cannot seek temporary injunction for restraining others from using the patented devices. **Franz Xaver Huemer v. New Yash Engineers, AIR 1997 (Del) 79(85): ILR (1996) 2 Delhi 791 (DB).**

The defendant cannot plead that the plaintiff has no locus standi to institute proceeding for infringement of patent without claiming to be the owner of the patent or without filing any petition or counter-claim. By merely raising the plea that the plaintiff's registration is improper. **Schnieder Electric Industries SA v Telemecanique and Controls (I) Ltd., 2000(20) PTC 620 (Del).**

[170][107A. Certain acts not to be considered as infringement

For the purposes of this Act,-

(a) any act of making, constructing, [171][using, selling or importing] a patented invention solely for uses reasonably relating to the development and submission of information required under any law for the time being in force, in India, or in a country other than India that regulates the manufacture, construction, [172][use, sale or import] of any product;

(b) importation of patented products by any person from a person [173][who is duly authorised under the law to produce and sell or distribute the product],

shall not be considered as an infringement of patent rights.]

CASE LAW

There is no outer limit in respect of the period for which the Appellate Board may condone the delay. The delay can be condoned upon being satisfied that sufficient cause for extending the time for preferring an appeal has been disclosed. **Gilead Sciences v. IPAB, 2012 (188) DLT 437 (445).**

108. Reliefs in suits for infringement

[174][(1) The reliefs which a court may grant in any suit for infringement include an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.]

[175][(2) The court may also order that the goods which are found to be infringing and materials and implement, the predominant use of which is in the creation of infringing goods shall be seized, forfeited or destroyed, as the court deems fit under the circumstances of the case without payment of any compensation.]

CASE LAW

When the Plaintiff suppressed factum of earlier application before Delhi High Court and its rejection, then it means he is not coming to Court with clean hands. Therefore, not entitled to discretionary relief of Injunction. **Ravi Kamal Bali v Kala Tech and Ors., (2008) 5 Bom CR 138.**

Injunction cannot be granted as a matter of course. It can be refused, where the plaintiff can be adequately compensated in terms of money or the court can sufficiently protect the interest of the plaintiffs by passing certain

other directions. **Vringo Infrastructure v. Indiamart Intermesh, (60) PTC 437 (Del).**

Where the allegedly infringement was not novel at the date of patent and it is not exploited by the patentee, then the damages, if any suffered could be provisionally quantified, hence temporary injunction rejected. **Hindustan Lever Limited v Godrej Soaps Limited and others, AIR 1996 Cal 367 (383).**

109. Rights of exclusive licensee to take proceedings against infringement

(1) The holder of an exclusive licence shall have the like right as the patentee to institute a suit in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or an account of profits or granting any other relief in any such suit the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits carried by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(2) In any suit for infringement of a patent by the holder of an exclusive licence under sub-section (1), the patentee shall, unless he has joined as a plaintiff in the suit, be added as a defendant, but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

110. Right of licensee under section 84 to take proceedings against infringement

Any person to whom a licence has been granted under section 84 shall be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent, and, if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were the patentee, making the patentee a defendant; but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

111. Restriction on power of Courts to grant damages or account of profits for infringement

(1) In a suit for infringement of a patent, damages or an account of profits shall not be granted against the defendant who proves that at the date of the infringement he was not aware and had no reasonable grounds for believing that the patent existed.

Explanation – A person shall not be deemed to have been aware or to have had reasonable grounds for believing that a patent exists by reason only of the application to an article of the word "patent", "patented" or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanies the word or words in question.

(2) In any suit for infringement of a patent the court may, if it thinks fit, refuse to grant any damages or an account of profits in respect of any

infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period.

(3) Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages or account of profits shall be granted in any proceeding in respect of the use of the invention before the date of the decision allowing the amendment, unless the court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.

(4) Nothing in this section shall affect the power of the court to grant an injunction in any suit for infringement of a patent.

112. [176][Omitted by the Patents (Amendment) Act, 2002].

113. Certificate of validity of specification and costs of subsequent suits for infringement thereof

[177][(1) If in any proceedings before the Appellate Board or a High Court for the revocation of a patent under section 64 and section 104, as the case may be, the validity of any claim of a specification is contested and that claim is found by the Appellate Board or the High Court to be valid, the Appellate Board or the High Court may certify that the validity of that claim was contested in those proceedings and was upheld.]

(2) Where any such certificate has been granted, then, if in any subsequent suit before a court for infringement of that claim of the patent or in any subsequent proceeding for revocation of the patent in so far as it relates to that claim, the patentee or other person relying on the validity of the claim obtains a final order or judgement in his favour, he shall be entitled to an order for the payment of his full costs, charges and expenses of and incidental to any such suit or proceeding properly incurred so far as they concern the claim in respect of which the certificate was granted, unless the court trying the suit or proceeding otherwise directs:

Provided that the costs as specified in this sub-section shall not be ordered when the party disputing the validity of the claim satisfies the court that he was not aware of the grant of the certificate when he raised the dispute and withdrew forthwith such defence when he became aware of such a certificate.

[178][(3) Nothing contained in this section shall be construed as authorising the courts or the Appellate Board hearing appeals from decrees or orders in suits for infringement or petitions for revocation, as the case may be, to pass orders for costs on the scale referred to therein.]

114. Relief for infringement of partially valid specification

(1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the court may grant relief in respect of any valid claim which is infringed:

Provided that the court shall not grant relief except by way of injunction save in the circumstances mentioned in sub-section (2).

(2) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages or an account of profits should be reckoned, and in exercising such discretion the court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

115. Scientific advisers

(1) In any suit for infringement or in any proceeding before a court under this Act, the court may at any time, and whether or not an application has been made by any party for that purpose, appoint an independent scientific adviser to assist the court or to inquire and report upon any such question of fact or of opinion (not involving a question of interpretation of law) as it may formulate for the purpose.

(2) The remuneration of the scientific adviser shall be fixed by the court and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser may be required to attend before the court, and such remuneration shall be defrayed out of moneys provided by Parliament by law for the purpose.

[179][CHAPTER XIX

APPEALS TO THE APPELLATE BOARD

116. Appellate Board

(1) Subject to the provisions of this Act, the Appellate Board established under section 83 of the Trade Marks Act, 1999 (47 of 1999) shall be the Appellate Board for the purposes of this Act and the said Appellate Board shall exercise the jurisdiction, power and authority conferred on it by or under this Act:

Provided that the Technical Member of the Appellate Board for the purposes of this Act shall have the qualifications specified in sub-section (2).

(2) A person shall not be qualified for appointment as a Technical Member for the purposes of this Act unless he-

(a) has, at least five years, held the post of Controller under this Act or has exercised the functions of the Controller under this Act for at least five years; or

(b) has, for at least ten years, functioned as a Registered Patent Agent and possesses a degree in engineering or technology or a masters degree in science from any University established under law for the time being in force or equivalent; or

(c) [180][Omitted by the Patents (Amendment) Act 2005.]

117. Staff of Appellate Board

(1) The Central Government shall determine the nature and categories of the officers and other employees required to assist the Appellate Board in the discharge of its functions under this Act and provide the Appellate Board with such officers and other employees as it may think fit.

(2) The salaries and allowances and conditions of service of the officers and other employees of the Appellate Board shall be such as may be prescribed.

(3) The officers and other employees of the Appellate Board shall discharge their functions under the general superintendence of the Chairman of the Appellate Board in the manner as may be prescribed.

117A. Appeals to Appellate Board

(1) Save as otherwise expressly provided in sub-section (2), no appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of the Controller for the purpose of giving effect to any such decision, order or direction.

(2) An appeal shall lie to the Appellate Board from any decision, order or direction of the Controller or Central Government under section 15, section 16, section 17, section 18, section 19, [181][section 20, sub-sections (4) of section 25, section 28], section 51, section 54, section 57, section 60, section 61, section 63, section 66, sub-section (3) of section 69, section 78, sub-sections (1) to (5) of section 84, section 85, section 88, section 91, section 92 and section 94.

(3) Every appeal under this section shall be in the prescribed form and shall be verified in such manner as may be prescribed and shall be accompanied by a copy of the decision, order or direction appealed against and by such fees as may be prescribed.

(4) Every appeal shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller or the Central Government or within such further time as the Appellate Board may, in accordance with the rules made by it, allow.

117B. Procedure and powers of Appellate Board

The provisions of sub-sections (2) to (6) of section 84, section 87, section 92, section 95 and section 96 of the Trade Marks Act, 1999 (47 of 1999) shall apply to the Appellate Board in the discharge of its functions under this Act as they apply to it in the discharge of its functions under the Trade Marks Act, 1999.

117C. Bar of jurisdiction of courts, etc.

No court or other authority shall have or, be entitled to, exercise any jurisdiction, powers or authority in relation to the matters referred to in sub-section (2) of section 117A or section 117D.

117D. Procedure for application for rectification, etc., before Appellate Board

(1) An application [182][for revocation of a patent before the Appellate Board under section 64 and an application for rectification of the register] made to the Appellate Board under Section 71 shall be in such form as may be prescribed.

(2) A certified copy of every order or judgment of the Appellate Board relating to a patent under this Act shall be communicated to the Controller by the Board and the Controller shall give effect to the order of the Board and shall, when so directed, amend the entries in, or rectify, the register in accordance with such order.

117E. Appearance of Controller in legal proceedings

(1) The Controller shall have the right to appear and be heard-

(a) in any legal proceedings before the Appellate Board in which the relief sought includes alteration or rectification of the register or in which any question relating to the practice of the patent office is raised;

(b) in any appeal to the Appellate Board from an order of the Controller on an application for grant of a patent-

(i) which is not opposed, and the application is either refused by the Controller or is accepted by him subject to any amendments, modifications, conditions or limitations, or

(ii) which has been opposed and the Controller considers that his appearance is necessary in the public interest,

and the Controller shall appear in any case if so directed by the Appellate Board.

(2) Unless the Appellate Board otherwise directs, the Controller may, in lieu of appearing, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him or of the practice of the patent office in like cases, or of other matters relevant to the issues and within his knowledge as the Controller may deem it necessary, and such statement shall be evidence in the proceeding.

117F. Costs of Controller in proceedings before Appellate Board

In all proceedings under this Act before the Appellate Board, the costs of the Controller shall be in the discretion of the Board, but the Controller shall not be ordered to pay the costs of any of the parties.

[183][117G. Transfer of pending proceedings to Appellate Board

All cases of appeals against any order or decision of the Controller and all cases pertaining to revocation of patent other than on a counter-claim in a suit for infringement and rectification of register pending before any High Court, shall be transferred to the Appellate Board from such date as may be notified by the Central Government in the Official Gazette and the Appellate Board may proceed with the matter either *de novo* or from the stage it was so transferred.]

117H. Power of Appellate Board to make rules

The Appellate Board may make rules consistent with this Act as to the conduct and procedure in respect of all proceedings before it under this Act.]

CHAPTER XX
PENALTIES

118. Contravention of secrecy provisions relating to certain inventions

If any person fails to comply with any direction given under section 35 [184][or makes or causes to be made an application for the grant of a patent in contravention of section 39], he shall be punishable with imprisonment for a term which may extended to two years, or with fine or with both.

119. Falsification of entries in register, etc.

If any person makes, or causes to be made, a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in such a register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

120. Unauthorized claim of patents rights

If any person falsely represents that any article sold by him is patented in India or is the subject of an application for a patent in India, he shall be punishable with fine which may extend to [185][one lakh rupees.]

Explanation 1– For the purposes of this section, a person shall be deemed to represent -

(a) that an article is patented in India if there is stamped, engraved or impressed on, or otherwise applied to, the article the word "patent" or "patented" or some other word expressing or implying that a patent for the article has been obtained in India;

(b that an article is the subject of an application for a patent in India, if there are stamped, engraved or impressed on, or otherwise applied to, the article the words "patent applied for", "patent pending", or some other words implying that an application for a patent for the article has been made in India.

Explanation 2 – The use of words "patent", "patented", "patent applied for", "patent pending" or other words expressing or implying that an article is patented or that a patent has been applied for shall be deemed to refer to a patent in force in India, or to a pending application for a patent in India, as the case may be, unless there is an accompanying indication that the patent has been obtained or applied for in any country outside India.

121. Wrongful use of words "patent office"

If any person uses on his place of business or any document issued by him or otherwise the words "patent office" or any other words which would reasonably lead to the belief that his place of business is, or is officially connected with, the patent office, he shall be punishable with imprisonment for a term which may extend to six months, or with fine, or with both.

122. Refusal or failure to supply information

(1) If any person refuses or fails to furnish -

(a) to the Central Government any information which he is required to furnish under sub-section (5) of section 100,

(b) to the Controller any information or statement which he is required to furnish by or under section 146,

he shall be punishable with fine which may extend to [186][ten lakh rupees.]

(2) If any person, being required to furnish any such information as is referred to in sub-section (1), furnishes information or statement which is false, and which he either knows or has reason to believe to be false or does not believe to be true, he shall be punishable with imprisonment which may extend to six months, or with fine, or with both.

123. Practice by non-registered patent agents

If any person contravenes the provisions of section 129, he shall be punishable with fine which may extend to [187][one lakh rupees in the case of a first offence and five lakh rupees] in the case of a second or subsequent offence.

124. Offences by companies

(1) If the person committing an offence under this Act is a company, the company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly:

Provided that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence.

(2) Notwithstanding anything contained in sub-section (1), where an offence under this Act has been committed by a company and it is proved that the offence has been committed with the consent or connivance of, or that the commission of the offence is attributable to any neglect on the part of any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation – For the purposes of this section, -

(a) "company" means any body corporate and includes a firm or other association of individuals; and

(b) "director", in relation to a firm, means a partner in the firm.

CHAPTER XXI
PATENT AGENTS

[188][125. Register of patent agents

(1) The Controller shall maintain a register to be called the register of patent agents in which shall be entered the names, addresses and other relevant particulars, as may be prescribed, of all persons qualified to have their names so entered under section 126.

(2) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Controller to keep the register of patent agents in computer floppies, diskettes or any other electronic form subject to such safeguards as may be prescribed.]

126. Qualifications for registration as patent agents

(1) A person shall be qualified to have his name entered in the register of patent agents if he fulfils the following conditions, namely: -

(a) he is a citizen of India;

(b) he has completed the age of 21 years;

(c) he has obtained a [189][degree in science, engineering or technology from any University established under law for the time being in force] in the territory of India or possesses such other equivalent qualifications as the Central Government may specify in this behalf, and, in addition,-

(i) [190][Omitted by the Patents (Amendment) Act, 2005]

(ii) has passed the qualifying examination prescribed for the purpose; [191][or]

[192][(iii) has, for a total period of not less than ten years, functioned either as an examiner or discharged the functions of the Controller under section 73 or both, but ceased to hold any such capacity at the time of making the application for registration;]

(d) he has paid such fee as may be prescribed.

[193][(2) Notwithstanding anything contained in sub-section (1), a person who has been registered as a patent agent before the commencement of [194][the Patents (Amendment) Act, 2005] shall be entitled to continue to be, or when required to be re-registered, as a patent agent, on payment of the fees as may be prescribed.]

127. Rights of patent agents

Subject to the provisions contained in this Act and in any rules made thereunder, every patent agent whose name is entered in the register shall be entitled -

(a) to practise before the Controller; and

(b) to prepare all documents, transact all business and discharge such other functions as may be prescribed in connection with any proceeding before the Controller under this Act.

128. Subscription and verification of certain documents by patent agents

(1) [195]**[***]** All applications and communications to the Controller under this Act may be signed by a patent agent authorised in writing in this behalf by the person concerned.

(2) [196][Omitted by the Patents (Amendment) Act, 2002]

129. Restrictions on practice as patent agents

(1) No person, either alone or in partnership with any other person, shall practise, describe or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent or, as the case may be, unless he and all his partners are so registered.

(2) No company or other body corporate shall practice, describe itself or hold itself out as patent agents or permit itself to be so described or held out.

Explanation – For the purposes of this section, practice as a patent agent includes any of the following acts, namely: -

(a) applying for or obtaining patents in India or elsewhere;

(b) preparing specifications or other documents for the purposes of this Act or of the patent law of any other country;

(c) giving advice other than of a scientific or technical nature as to the validity of patents or their infringement.

130. Removal from register patent agents and restoration

(1) The [197][Controller] may remove the name of any person from the register when [198][he] is satisfied, after giving that person a reasonable opportunity of being heard and after such further inquiry, if any, as [199][he] thinks fit to make -

(i) that his name has been entered in the register by error or on account of misrepresentation or suppression of material fact;

(ii) that he has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the [200][Controller] renders him unfit to be kept in the register.

(2) The [201][Controller] may, on application and on sufficient cause being shown, restore to the register the name of any person removed therefrom.

131. Power of Controller to refuse to deal with certain agents

(1) Subject to any rules made in this behalf, the Controller may refuse to recognise as agent in respect of any business under this Act -

(a) any individual whose name has been removed from, and not restored to, the register;

(b) any person who has been convicted of an offence under section 123;

(c) any person, not being registered as a patent agent, who in the opinion of the Controller is engaged wholly in acting as agent in applying for patents in India or elsewhere in the name or for the benefit of the person by whom he is employed; and

(d) any company or firm, if any person whom the Controller could refuse to recognise as agent in respect of any business under this Act, is acting as a director or manager of the company or is a partner in the firm.

(2) The Controller shall refuse to recognize as agent in respect of any business under this Act any person who neither resides nor has a place of business in India.

132. Savings in respect of other persons authorized to act as agent

Nothing in this Chapter shall be deemed to prohibit -

(a) the applicant for a patent [202][***] from drafting any specification or appearing or acting before the Controller; or

(b) an advocate, not being a patent agent, from taking part in any [203][hearing before the Controller on behalf of a party who is taking part in any proceeding under this Act.]

CHAPTER XXII

INTERNATIONAL ARRANGEMENTS

[204][133. Convention countries

Any country, which is a signatory or party or a group of countries, union of countries or inter-governmental organisations which are signatories or parties to an international, regional or bi-lateral treaty, convention or arrangement to which India is also a signatory or party and which affords to the applicants for patents in India or to citizens of India similar privileges as are granted to their own citizens or citizens to their member countries in respect of the grant of patents and protection of patent rights shall be a convention country or convention countries for the purposes of this Act.]

134. Notification as to countries not providing for reciprocity

Where any country specified by the Central Government in this behalf by notification in the Official Gazette does not accord to citizens of India the same rights in respect of the grant of patents and the protection of patent rights as it accords to its own nationals, no national of such country shall be entitled, either solely or jointly with any other person, -

(a) to apply for the grant of a patent or be registered as the proprietor of a patent;

(b) to be registered as the assignee of the proprietor of a patent; or

(c) to apply for a licence or hold any licence under a patent granted under this Act.

135. Convention applications

(1) Without prejudice to the provisions contained in section 6, where a person has made an application for a patent in respect of an invention in a convention country (hereinafter referred to as the "basic application"), and that person or the legal representative or assignee of that person makes an application under this Act for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim based on matter disclosed in the basic application, is the date of making of the basic application.

Explanation. – Where applications have been made for similar protection in respect of an invention in two or more convention countries, the period of twelve months referred to in this sub-section shall be reckoned from the date on which the earlier or earliest of the said applications was made.

(2) Where applications for protection have been made in one or more convention countries in respect of two or more inventions which are cognate or of which one is a modification of another, a single convention application may, subject to the provisions contained in section 10, be made in respect of those inventions at any time within twelve months from the date of the earliest of the said applications for protection:

Provided that the fee payable on the making of any such application shall be the same as if separate applications have been made in respect of each of the said inventions, and the requirements of clause (b) of sub-section (1) of section 136 shall, in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.

[205][(3) In case of an application filed under the Patent Cooperation Treaty designating India and claiming priority from a previously filed application in India, the provisions of sub-sections (1) and (2) shall apply as if the previously filed application were the basic application:

Provided that a request for examination under section 11B shall be made only for one of the applications filed in India.]

136. Special provisions relating to convention applications

(1) Every convention application shall -

(a) be accompanies by a complete specification; and

(b) specify the date on which and the convention country in which the application for protection, or as the case may be, the first of such applications was made; and

(c) state that no application for protection in respect of the invention had been made in a convention country before that date by the applicant or by any person from whom he derives title.

(2) Subject to the provisions contained in section 10, a complete specification filed with a convention application may include claims in respect of developments

or, or additions to, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

(3) A convention application shall not be post-dated under sub-section (1) of section 17 to a date later than the date on which under the provisions of this Act the application could have been made.

137. Multiple priorities

(1) Where two or more applications for patents in respect of inventions have been made in one or more convention countries and those inventions are so related as to constitute one invention, one application may be made by any or all of the persons referred to in sub-section (1) of section 135 within twelve months from the date on which the earlier or earliest of those applications was made, in respect of the inventions disclosed in the specifications which accompanied the basic application.

(2) The priority date of a claim of the complete specification, being a claim based on matters disclosed in one or more of the basic applications, is the date on which that matter was first so disclosed.

(3) For the purposes of this Act, a matter shall be deemed to have been disclosed in a basic application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgement of a prior art) in that application, or any documents submitted by the applicant for protection in support of and at the same time as that application, but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the patent office with the convention application or within such period as may be prescribed after the filing of that application.

138. Supplementary provisions as to convention applications

[206][(1) Where a convention application is made in accordance with the provisions of this Chapter, the applicant shall furnish, when required by the Controller, in addition to the complete specification, copies of the specifications or corresponding documents filed or deposited by the applicant in the patent office of the convention country as referred to in section 133 verified to the satisfaction of the Controller, within the prescribed period from the date of communication by the Controller.]

(2) If any such specification or other document is in a foreign language, a translation into English of the specification or document, verified by affidavit or otherwise to the satisfaction of the Controller, shall be [207][furnished when required by the Controller.]

(3) For the purposes of this Act, the date on which an application was made in a convention country is such date as the Controller is satisfied, by certificate of the official chief or head of the patent office of the convention country or otherwise, in the date on which the application was made in that convention country.

[208][(4) An international application filed under the Patent Cooperation Treaty designating India shall have effect of filing an application for patent under section 7, section 54 and section 135, as the case may be, and the title, description, claim and abstract and drawings, if any, filed in the international application shall be taken as complete specification for the purposes of this Act.

(5) The filing date of application for patent and its complete specification processed by the patent office as designated office shall be the international filing date accorded under the Patent Cooperation Treaty.

(6) Amendment, if any, proposed by the applicant for an international application designating India or designating and electing India before international searching authority or preliminary examination authority shall, if the applicant so desires, be taken as an amendment made before the patent office.]

139. Other provisions of Act to apply to convention applications

Save as otherwise provided in this Chapter, all the provisions of this Act shall apply in relation to a convention application and a patent granted in pursuance thereof as they apply in relation to an ordinary application and a patent granted in pursuance thereof.

CHAPTER XXIII

MISCELLANEOUS

140. Avoidance of certain restrictive conditions

(1) It shall not be lawful to insert -

(i) in any contract for or in relation to the sale or lease of a patented article or an article made by a patented process; or

(ii) in a licence to manufacture or use a patented article; or

(iii) in a licence to work any process protected by a patent, a condition the effect of which may be -

(a) to require the purchaser, lessee, or licensee to acquire from the vendor, lessor, or licensor, or his nominees, or to prohibit him from acquiring or to restrict in any manner or to any extent his right to acquire from any person or to prohibit him from acquiring except from the vendor, lessor, or licensor or his nominees, any article other than the patented article or an article other than that made by the patented process; or

(b) to prohibit the purchaser, lessee or licensee from using, or to restrict in any manner or to any extent the right of the purchaser, lessee or licensee, to use an article other than the patented article or an article other than that made by the patented process, which is not supplied by the vendor, lessor or licensor or his nominee; or

(c) to prohibit the purchaser, lessee or licensee from using or to restrict in any manner or to any extent the right of the purchaser, lessee or licensee to use any process other than the patented process, or

[209][(d) to provide exclusive grant back, prevention to challenges to validity of patent and coercive package licensing,]

and any such condition shall be void.

(2) A condition of the nature referred to in clause (a) or clause (b) or clause (c) of sub-section (1) shall not cease to be a condition falling within that sub-section merely by reason of the fact that the agreement containing it has been entered into separately, whether before or after the contract relating to the sale, lease or licence of the patented article or process.

(3) In proceedings against any person for the infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent and containing a condition declared unlawful by this section:

Provided that this sub-section shall not apply if the plaintiff is not a party to the contract and proves to the satisfaction of the court that the restrictive condition was inserted in the contract without his knowledge and consent, express or implied.

(4) Nothing in this section shall -

(a) affect a condition in a contract by which a person is prohibited from selling goods other than those of a particular person;

(b) validate a contract which, but for this section, would be invalid;

(c) affect a condition in a contract for the lease of, or licence to use, a patented article, by which the lessor or licensor reserves to himself or his nominee the right to supply such new parts of the patented article as may be required or to put or keep it in repair.

(5) [210][Omitted by the Patents (Amendment) Act, 2002]

141. Determination of certain contracts

(1) Any contract for the sale or lease of a patented article or for licence to manufacture, use or work a patented article or process, or relating to any such sale, lease or licence, [211][***], may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or in any other contract, be determined by the purchaser, lessee, or licensee, as the case may be, of the patent on giving three months notice' in writing to the other party.

(2) The provisions of this section shall be without prejudice to any right of determining a contract exercisable apart from this section.

142. Fees

(1) There shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters in relation to the grant of patents under this Act, such fees as may be prescribed by the Central Government.

(2) Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.

[212][(3) Where a fee is payable in respect of the filing of a document at the patent office, the fee shall be paid along with the document or within the prescribed time and the document shall be deemed not to have been filed at the office if the fee has not been paid within such time.]

(4) Where a principal patent is granted later than two years from the date of filing of [213][the application], the fees which have become due in the meantime may be paid within a term of three months from the date of the recording of the patent in the register [214][or within the extended period not later than nine months from the date of recording.]

[215][143. Restrictions upon publication of specification

Subject to the provisions of Chapter VII, an application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Controller before the expiration of the period prescribed under sub-section (1) of section 11A or before the same is open to public inspection in pursuance of sub-section (3) of section 11A or section 43.]

144. Reports of Examiners to be confidential

The reports of examiners to the Controller under this Act shall not be open to public inspection or be published by the Controller; and such reports shall not be liable to production or inspection in any legal proceeding unless the court certifies that the production or inspection is desirable in the interests of justice, and ought to be allowed.

[216][145. Publication of official journal

The Controller shall publish periodically an official journal which shall contain such information as may be required to be published by or under the provisions of this Act or any rule made thereunder.]

146. Power of Controller to call for information from patentees

(1) The Controller may, at any time during the continuance of the patent, by notice in writing, require a patentee or a licensee, exclusive or otherwise, to furnish to him within two months from the date of such notice or within such further time as the Controller may allow, such information or such periodical statements as to the extent to which the patented invention has been commercially worked in India as may be specified in the notice.

(2) Without prejudice to the provisions of sub-section (1), every patentee and every licensee (whether exclusive or otherwise) shall furnish in such manner and form and at such intervals (not being less than six months) as may be prescribed statements as to the extent to which the patented invention has been worked on a commercial scale in India.

(3) The Controller may publish the information received by him under sub-section (1) or sub-section (2) in such manner as may be prescribed.

147. Evidence of entries, documents, etc.

(1) A certificate purporting to be signed by the Controller as to any entry, matter or thing which he is authorised by this Act or any rules made thereunder to make or do, shall be *prima facie* evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or omitted to be done.

(2) A copy of any entry in any register or of any document kept in the patent office or of any patent, or an extract from any such register or document, purporting to be certified by the Controller and sealed with the seal of the patent office shall be admitted in evidence in all courts, and in all proceedings, without further proof or production of the original.

(3) The Controller or any other officer of the patent office shall not, in any legal proceedings to which he is not a party, be compellable to produce the register or any other document in his custody, the contents of which can be proved by the production of a certified copy issued under this Act or to appear as a witness to prove the matters therein recorded unless by order of the court made for special causes.

148. Declaration by infant, lunatic, etc.

(1) If any person is, by reason of minority, lunacy or other disability, incapable of making any statement or doing anything required or permitted by or under this Act, the lawful guardian, committee or manager (if any) of the person subject to the disability, or if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such statement or a statement as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the statement or the doing of the thing.

149. Service of notions, etc., by post.

Any notice required or authorised to be given by or under this Act and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

150. Security for costs

If any party by whom notice of any opposition is given under this Act or by whom application is made to the Controller for the grant of a licence under a patent neither resides nor carries on business in India, the Controller may require him to give security for the costs of the proceedings, and in default of such security being given may treat the opposition or application as abandoned.

151. Transmission of orders of courts to Controller

(1) Every order of [217][the High Court or the Appellate Board] on a petition for revocation, including orders granting certificates of validity of any claim,

shall be transmitted by [218][the High Court or the Appellate Board] to the Controller who shall cause an entry thereof and reference thereto to be made in the register.

(2) Where in any suit for infringement of a patent or in any suit under section 106 the validity of any claim or a specification is contested and that claim is found by the court to be valid or not valid, as the case may be, the court shall transmit a copy of its judgment and decree to the Controller who shall on receipt thereof cause an entry in relation to such proceeding to be made in the prescribed manner in a supplemental record.

(3) The provisions of sub-sections (1) and (2) shall also apply to the court to which appeals are preferred against decisions of the [219][Appellate Board or the courts as the case may be,] referred to in those sub-sections.

152. [220][Omitted by the Patents (Amendment) Act, 2005]

153. Information relating to patents

A person making a request to the Controller in the prescribed manner for information relating to any such matters as may be prescribed as respects any patent specified in the request or as respects any application for a patent so specified shall be entitled, subject to the payment of the prescribed fee, to have information supplied to him accordingly.

154. Loss or destruction of patents

If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on application made in the prescribed manner and on payment of the prescribed fee, cause a duplicate thereof to be sealed and delivered to the applicant.

155. Reports of Controller to be placed before Parliament

The Central Government shall cause to be placed before both Houses of Parliament once a year a report respecting the execution of this Act by or under the Controller.

156. Patent to bind Government

Subject to the other provisions contained in this Act, a patent shall have to all intents the like effect as against Government as it has against any person.

157. Right of Government to sell or use forfeited articles

Nothing in this Act shall affect the power of the Government or of any person deriving title directly or indirectly from the Government to sell or use any articles forfeited under any law for the time being in force.

[221][157A. Protection of security of India

Notwithstanding anything contained in this Act, the Central Government shall-

(a) not disclose any information relating to any patentable invention or any application relating to the grant of patent under this Act, which it considers prejudicial to the interest of the security of India;

(b) take any action including the revocation of any patent which it considers necessary in the interest of the security of India by issue of a notification in the Official Gazette to that effect.

Explanation.-For the purposes of this section, the expression "security of India" includes any action necessary for the security of India which-

(i) relates to fissionable materials or the materials from which they are derived; or

(ii) relates to the traffic in arms, ammunition and implements of war and to such traffic in other goods and materials as is carried on directly or indirectly for the purpose of supplying a military establishment; or

(iii) is taken in time of war or other emergency in international relations.]

158. Power of High Court to make rules

The High Court may make rules consistent with this Act as to the conduct and procedure in respect of all proceedings before it under this Act.

159. Power of Central Government to make rules

(1) The Central Government may, by notification in the Official Gazette, make rules for carrying out the purposes of this Act.

(2) Without prejudice to the generality of the foregoing power, the Central Government may make rules to provide for all or any of the following matters, namely: -

(i) the form and manner in which any application for a patent, any specifications or drawings and any other application or document may be filed in the patent office;

[222][(ia) the period which the Controller may allow for filing of statement and undertaking for in respect of applications under sub-section (1), the period within which the details relating to processing of applications may be filed before the Controller and the details to be furnished by the applicant to the Controller under sub-section (2) of section 8;

(ib) the period within which a reference to the deposit of materials shall be made in the specification under sub-clause (A) of clause (ii) of the proviso to sub-section (4) of section 10;

(ic) the period for which application for patent shall not be open to the public under sub-section (1) and the manner in which the applicant may make a request to the Controller to publish his application under sub-section (2) of section 11 A;

(id) the manner of making the request for examination for an application for patent and the period within which such examination shall be made under sub-sections (1) and (3) of section 11B;

(ie) the manner in which an application for withdrawal of an application for grant of a patent shall be made and the period within which a request for examination from the date of revocation of secrecy directions shall be made under the proviso to sub-section (4) of section 11B.]

(ii) the time within which any act or thing may be done under this Act, including the manner in which and the time within which any matter may be [223][published] under this Act;

(iii) the fees which may be payable under this Act and the manner [224][and time] of payments of such fees;

(iv) the matters in respect of which the Examiner may make a report to the Controller;

[225][(v) the manner in which and the period within which the Controller shall consider and dispose off a representation under sub-section (1) of section 25;

(va) the period within which the Controller is required to dispose off an application under section 39;]

(vi) the form and manner in which and the time within which any notice may be given under this Act;

(vii) the provisions which may be inserted in an order for restoration of a patent for the protection of persons who may have availed themselves of the subject matter of the patent after the patent had ceased;

(viii) the establishment of branch offices of the patent office and the regulation generally of the business of the patent office, including its branch offices;

(ix) the maintenance of the register of patents [226][and the safeguards to be observed in the maintenance of such register in computer floppies, diskettes or any other electronic form] and the matters to be entered therein;

(x) the matters in respect of which the Controller shall have powers of a civil court;

(xi) the time when and the manner in which the register and any other document open to inspection may be inspected under this Act;

(xii) the qualifications of, and the preparation of a roll of, scientific advisers for the purpose of section 115;

[227][(xiia) the salaries and allowances and other conditions of service of the officers and other employees of the Appellate Board under sub-section (2), and the manner in which the officers and other employees of the Appellate Board shall discharge their functions under sub-section (3), of section 117;

(xiib) the form of making an appeal, the manner of verification and the fees payable under sub-section (3) of section 117A;

(xiic) the form in which, and the particulars to be included in, the application to the Appellate Board under sub-section (1) of section 117D;]

(xiii) the manner in which any compensation for acquisition by Government of an invention may be paid;

(xiv) the manner in which the register of patent agents may be maintained [228][under sub-section (1) of section 125 and the safeguards to be observed in the maintenance of such register of patent agents on computer floppies, diskettes or any other electronic form under sub-section (2) of that section]; and conduct

of qualifying examinations for patent agents; and matters connected with their practice and conduct, including the taking of disciplinary proceedings against patent agents for misconduct;

(xv) he regulation of the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and the inspection of indexes and abridgments and other documents;

(xvi) any other matter which has to be or may be prescribed.

(3) The power to make rules under this section shall be subject to condition of the rules being made after previous publication.

[229][Provided that the Central Government may, if it is satisfied that circumstances exist which render it practically not possible to comply with such condition of previous publication, dispense with such compliance.]

160. Rules to be placed before Parliament

Every rule made under this Act shall be laid, as soon as may be after it is made, before each House of Parliament while it is in session for a total period of thirty days which may be comprised in one session or [230][in two or more successive sessions, and, if before the expiry of the session immediately following the session or the successive sessions aforesaid], both Houses agree in making any modification in the rule or both Houses agree that the rule should not be made, the rule shall thereafter have effect only in such modified form or be of no effect, as the case may be; so, however, that any such modification or annulment shall be without prejudice to the validity of anything previously done under that rule.

161. [231][Omitted by the Patents (Amendment) Act, 2002]

162. Repeal of Act 2 of 1911 in so far as it relates to patents and savings

(1) The Indian Patents and Designs Act, 1911, insofar as it relates to patents, is hereby repealed, that is to say, the said Act shall be amended in the manner specified in the Schedule.

(2) [232][Omitted by the Patents (Amendment) Act, 2002]

(3) [233][Omitted by the Patents (Amendment) Act, 2002]

(4) The mention of particular matters in this section shall not prejudice the general application of the General Clause Act, 1897 (10 of 1897), with respect of repeals.

(5) Notwithstanding anything contained in this Act, any suit for infringement of a patent or any proceeding for revocation of a patent, pending in any court at the commencement of this Act, may be continued and disposed of, as if this Act had not been passed.

163. [234][Omitted by the Patents (Amendment) Act, 2005.]

THE PATENTS RULES, 2003

[As Amended by the Patents (Amendment) Rules, 2016, vide GSR 523(E), Dated. 16.05.2016]

S.O.493(E).-WHEREAS certain draft rules were published in exercise of the powers conferred by section 159 of the Patents Act, 1970 (39 of 1970) *vide* notification of the Government of India in Ministry of Commerce and Industry (Department of Industrial Policy and Promotion) vide Number S.O. 1018(E) dated the 20th September, 2002, in Part II, Section 3, sub-section (ii) of the Gazette of India, (Extraordinary) dated 20th September, 2002 for inviting objections and suggestions from persons likely to be affected thereby before expiry of a period of thirty days from the date on which copies of the Gazette containing the Notification were made available to the public;

AND WHEREAS the copies of the Gazette containing the said Notification were made available to the public on 3rd October, 2002.

AND WHEREAS objections and suggestions received from the public on the said draft rules have been considered by the Central Government;

Now, THEREFORE, in exercise of the powers conferred by section 159 of the Patents Act, 1970 (39 of 1970) and in supersession of the Patents Rules, 1972 published in the Gazette of India, vide S.O. 301(E) dated 20th April, 1972 in Part II, Section 3, sub- section (ii), except as respect things done or omitted to be done before such supersession, Central Government hereby makes the following rules, namely:—

CHAPTER I

PRELIMINARY

1. Short title and commencement

(1) These rules may be called the Patents Rules, 2003.

(2) They shall come into force on the date[235] on which the Patents (Amendment) Act, 2002 comes into force.

2. Definitions

In these rules, unless the context otherwise requires,-

(a) "Act" means the Patents Act, 1970 (39 of 1970);

(b) "appropriate office" means the appropriate office of the patent office as specified in rule 4;

(c) "article" includes any substance or material, and any plant, machinery or apparatus, whether affixed to land or not;

(d) "Form" means a Form specified in the Second Schedule;

[236][(da) "person other than a natural person" shall include a "small entity";]

[237][(db) "Request for examination" means a request for examination, including expedited examination, made under section 11B in respect of rule 24B or rule 24C;]

(e) "Schedule" means Schedule to these rules;
(f) "section" means a section of the Act;
[238][(fa) "small entity" means,-
(i) in case of an enterprise engaged in the manufacture or production of goods, an enterprise where the investment in plant and machinery does not exceed the limit specified for a medium enterprise under clause (a) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006); and
(ii) in case of an enterprise engaged in providing or rendering of services, an enterprise where the investment in equipment is not more than the limit specified for medium enterprises under clause (b) of sub-section (1) of Section 7 of the Micro, Small and Medium Enterprises Development Act, 2006.

Explanation 1 – For the purpose of this clause, "enterprise" means an industrial undertaking or a business concern or any other establishment, by whatever name called, engaged in the manufacture or production of goods, in any manner, pertaining to any industry specified in the First Schedule to the Industries (Development and Regulation) Act, 1951 (65 of 1951) or engaged in providing or rendering of any service or services in such an industry.

Explanation 2 – In calculating the investment in plant and machinery, the cost of pollution control, research and development, industrial safety devices and such other things as may be specified by notification under the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006), shall be excluded.

Explanation 3 – The reference rates of foreign currency of the Reserve Bank of India shall prevail.]

[239][(fb) "Startup" means
(a) an entity in India recognised as a startup by the competent authority under Startup India initiative.
(b) In case of a foreign entity, an entity fulfilling the criteria for turnover and period of incorporation/ registration as per Startup India Initiative and submitting declaration to that effect.

Explanation: In calculating the turnover, reference rates of foreign currency of Reserve Bank of India shall prevail.]

(g) words and expressions used, but not defined in these rules, shall have the meanings respectively assigned to them in the Act.

3. Prescribed particulars

Save as otherwise provided in these rules, the particulars contained in a Form are hereby prescribed as the particulars, if any, required under the relevant provision or provisions of the Act.

4. Appropriate office

(1) The appropriate office of the patent office shall –

(i) for all the proceedings under the Act, [240][***] be the head office of the patent office or the branch office, as the case may be, within whose territorial limits-
(a) the applicant or first mentioned applicant in case of joint applicants for a patent, normally resides or has his domicile or has a place of business or the place from where the invention actually originated; or
(b) the applicant for a patent or party in a proceeding if he has no place of business or domicile in India, the address for service in India given by such applicant or party is situated; and

[241][***]

(2) The appropriate office once decided in respect of any proceedings under the Act shall not ordinarily be changed.

[242][(3) Notwithstanding anything contained in sub-rule (2), the Controller may transfer an application for patent so filed, to head office or, as the case may be, branch office of the Patent Office.

(4) Notwithstanding anything contained in sub-rule (1), further application referred to in section 16 of the Act, shall be filed at the appropriate office of the first mentioned application only.

(5) All further applications referred to Section 16 of the Act filed in an office other than the appropriate office of the first mentioned application, before the commencement of the Patents (Amendment) Rules, 2013 shall be transferred to the appropriate office of the first mentioned application.]

[243][5. Address for service

Every person, concerned in any proceedings to which the Act or these rules relate and every patentee, shall furnish to the Controller an address for service, including a postal address in India and an e-mail address, and such address for service shall be treated for all purposes connected with such proceedings or patent as the address of the person concerned in the proceedings or of the patentee. Unless such an address for service is given, the Controller shall be under no obligation either to proceed or deal with any proceeding, or patent or to send any notice that may be required to be given under the Act or these rules and the Controller may take suo moto decision in the matter:

Provided that a patent agent shall also be required to furnish to the Controller a mobile number registered in India.]

6. Leaving and serving documents

[244][(1) Any application, notice or other document authorized or required to be filed, left, made or given at the patent office, or to the Controller or to any other person under the Act or these rules, may be tendered by hand or sent by a letter addressed to the Controller at the appropriate office or to that person through post or registered post or speed post [245][***] or by electronic transmission duly authenticated. If it is sent by post or

registered post or speed post [246][***] or by electronic transmission duly authenticated, it shall be deemed to have been filed, left, made or given at the time when the mail containing the same would have been delivered in the ordinary course of post or registered post or speed post [247][***] or by electronic transmission duly authenticated, as the case may be. In proving such sending, it shall be sufficient to show that the mail was properly addressed and transmitted.

[248][***]]

[249][(1A) Notwithstanding anything contained in sub-rule (1), a patent agent shall file, leave, make or give all documents only by electronic transmission duly authenticated:

Provided that any document, if asked to be submitted in original, shall be submitted within a period of fifteen days, failing which such documents shall be deemed not to have been filed."]

[250][(2) Any written communication addressed to a patentee at his postal address or e-mail address, as it appears on the register of patents or at his address for service given under rule 5, or to any applicant or opponent in any proceedings under the Act or these rules, at the postal address or e-mail address, appearing on the application or notice of opposition, or given for service, shall be deemed to be properly addressed.]

(3) All notices and all written communications addressed to a patentee, or to any applicant or opponent in any proceedings under the Act or these rules, and all documents forwarded to the patentee or to the said applicant or opponent, shall, except when they are sent by special messenger, be sent by registered post or speed post [251][***] or by electronic transmission duly authenticated.

(4) The date of a notice or a written communication addressed to a patentee or to any applicant or opponent in any proceedings under the Act and these rules shall be the date of dispatch of the said notice or written communication, by registered post or speed post [252][***] or fax or by electronic transmission duly authenticated, as the case may be, unless otherwise specified under the Act or these rules.

(5) In case of delay in receipt of a document or a communication sent by the patent office to a party to any proceedings under the Act or these rules, the delay in transmitting or resubmitting a document to the patent office or doing any act by the party may be condoned by the Controller if a petition for such condonation of delay is made by the party to the Controller immediately after the receipt of the document or a communication along with a statement regarding the circumstances of the fact and evidence in support of the statement:

Provided that the delay condoned by the Controller shall not exceed the period between the date on which the party was supposed to have received the document or communication by ordinary course of mail or electronic transmission and the actual date of receipt of the same.

[253][(6) Without prejudice to sub-rule (5) and notwithstanding anything contained in sub-rule (2) of rule 138, the Controller may condone the delay in transmitting or resubmitting a document to the patent office or performing any act by a party, if a petition for such condonation of delay is made by the party to the Controller along with a statement regarding the circumstances of the fact and evidence in support of the statement, to the satisfaction of the Controller, that the delay was due to war, revolution, civil disorder, strike, natural calamity, a general unavailability of electronic communication services or other like reason in the locality where the party resides or has place of business, and that such situation was of such severity that it disrupted the normal communication in that area and that the relevant action was taken as soon as reasonably possible not later than one month from the date when such situation had ceased to exist:

Provided that the delay condoned by the Controller shall not exceed the period for which the national emergency was in force, or six months from the expiry of the prescribed period, whichever is earlier.

(7) Any liability or burden of proof regarding the authenticity of any document filed, left, made or given under these rules, including electronically transmitted documents, shall lie only with the party filing, leaving, making or giving the document.]

7. Fees

(1) The fees payable under section 142 in respect of the grant of patents and applications therefor, and in respect of other matters for which fees are required to be payable under the Act shall be as specified in the First Schedule. [254][Provided that ten per cent additional fee shall be payable when the applications for patent and other documents are filed through physical mode, namely, in hard copy format:

Provided further that in the case of a small entity, every document, for which a fee has been specified, shall be accompanied by Form-28.]

(2) [255][(a)The fees payable under the Act or these rules may be paid at the appropriate office either in cash or through electronic means or may be sent by bank draft or banker's cheque payable to the Controller of Patents and drawn on a scheduled bank at the place where the appropriate office is situated and if the draft or banker's cheque is sent by post, the fees shall be deemed to have been paid on the date on which the draft or banker's cheque has actually reached the Controller.]

[256][***]

[257][(c) Where a fee is payable in respect of a document, the entire fee shall accompany the document:]

Provided that the Controller may accept the fee in part and allow remaining part of the fee to be paid at any time within one month from the date of filing of the document notwithstanding the expiry of the due date for filing of such document and on such payment the document shall

be taken on record from the date of its filing.

(3) In case an application processed by a natural person is fully or partly transferred to a person other than a natural person, the difference, if any, in the scale of fee(s) between the fee(s) charged from an natural person and the fee(s) chargeable from the person other than the natural person in the same matter shall be paid by the new applicant with the request for transfer.

[258][(3A) In case an application processed by a small entity is fully or partly transferred to a person other than a natural person (except a small entity), the difference, if any, in the scale of fee(s) between the fee(s) charged from a small entity and the fee(s) chargeable from the person other than a natural person (except a small entity) in the same matter shall be paid by the new applicant with the request for transfer.]

[259][(3B) In case an application processed by a startup is fully or partly transferred to any person other than a natural person or a startup, the difference, if any, in the scale of fees between the fees charged from a startup and such person to whom the application is transferred, shall be paid by the new applicant along with the request for transfer:

Explanation.- Where the startup ceases to be a startup after having filed an application for patent due to lapse of more than five years from the date of its incorporation or registration or the turnover subsequently crosses the financial threshold limit as defined, no such difference in the scale of fees shall be payable.]

[260][(4) Fees once paid in respect of any proceeding shall not ordinarily be refunded irrespective of whether the proceeding has taken place or not:

Provided that, if the Controller is satisfied that during the online filing process, the fee was paid more than once for the same proceeding, the excess fee shall be refunded.]

[261][(4A) Notwithstanding anything contained in sub-rule (4), upon the withdrawal of an application in respect of which a request for examination has been filed, but before issuance of first statement of objection, the fee may be refunded to the extent prescribed in the First Schedule on a request made by the applicant in Form 29.]

(5) (i) Subject to the approval of the Controller, any person may deposit money in advance and request the Controller to realise any fee payable by him from the said deposit and in such case the date of the receipt of the request to realise the fee or the date on which the request to realise the fee is deemed to have been received, whichever is earlier, shall be taken as the date of payment of the fee:

Provided that the requisite amount of money is available at the credit of the person making such request

(ii) Subject to the approval of the Controller, any person may discontinue the deposit of money in advance and in such case the balance, if any, shall be refunded.

8. Forms

(1) The Forms set forth in the Second Schedule with such variations as the circumstances of each case may require shall be used for the purposes mentioned therein.

[262][(2) Where no Form is so specified for any purpose, the applicant may use Form 30 specified in the Second Schedule.]

[263][9. Filing of documents and copies, etc.

(1) All documents and copies of the documents, except affidavits and drawings, filed with patent office, shall –

(a) be typewritten or printed in Hindi or English (unless otherwise directed or allowed by the Controller) in large and legible characters not less than 0.28 centimetre high with deep indelible ink with lines widely spaced not less than one and half spaced only upon one side of the paper;

(b) be on such paper which is flexible, strong, white, smooth, non-shiny, and durable of size A4 of approximately 29.7 centimetre by 21centimetre with a margin of at least 4 centimetre on the top and left hand part and 3 centimetre on the bottom and right hand part thereof;

(c) be numbered in consecutive Arabic numerals in the centre of the bottom of the sheet; and

(d) contain the numbering to every fifth line of each page of the description and each page of the claims at right half of the left margin.

(2) Any signature which is not legible or which is written in a script other than English or Hindi shall be accompanied by a transcription of the name either in Hindi or English in capital letters.

(3) In case, the application for patent discloses sequence listing of nucleotides or amino acid sequences, the sequence listing of nucleotides or amino acid sequences shall be filed in computer readable text format along with the application, and no print form of the sequence listing of nucleotides or amino acid sequences is required to be given.

(4) Additional copies of all documents shall be filed at the appropriate office as may be required by the Controller.

(5) Names and addresses of applicant and other persons shall be given in full together with their nationality and such other particulars, if any, as are necessary for their identification.]

CHAPTER II

APPLICATION FOR PATENTS

10. Period within which proof of the right under section 7(2) to make the application shall be furnished

Where, in an application for a patent made by virtue of an assignment of the

right to apply for the patent for the invention, if the proof of the right to make the application is not furnished with the application, the applicant shall within a period of [264][six months] after the filing of such application furnish such proof.

Explanation – For the purposes of this rule, the [265][six months] period in case of an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.

11. Order of recording applications

The applications filed in a year shall constitute a series identified by the year of such filing. In case of an application filed corresponding to an international application in which India is designated, such application shall constitute a series distinct from the rest of the applications identified by the year of filing of corresponding applications in India.

12. Statement and undertaking regarding foreign applications

(1) The statement and undertaking required to be filed by an applicant for a patent under sub-section (1) of section 8 shall be made in Form 3.

[266][(1A). The period within which the applicant shall file the statement and undertaking under sub-section (1) of section 8 shall be [267][six months] from the date of filing the application.

Explanation – For the purpose of this rule, the period of [268][six months] in case of an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.]

(2) The time within which the applicant for a patent shall keep the Controller informed of the details in respect of other applications filed in any country in the undertaking to be given by him under clause (b) of sub-section (1) of section 8 shall be six months from the date of such filing

[269][(3) When so required by the Controller under sub-section (2) of section 8, the applicant shall furnish information relating to objections, if any, in respect of novelty and patentability of the invention and any other particulars as the Controller may require which may include claims of application allowed within [270][six months] from the date of such communication by the Controller.]

13. Specifications

(1) Every specification, whether provisional or complete, shall be made in Form 2.

(2) A specification in respect of a divisional application under section 16 shall contain specific reference to the number of the original application from which the divisional application is made.

(3) A specification in respect of a patent of addition under section 54 shall contain

a specific reference to the number of the main patent, or the application for the main patent, as the case may be, and a definite statement that the invention comprises an improvement in, or a modification of, the invention claimed in the specification of the main patent granted or applied for.

[271][(4) Where the invention requires explanation through drawings, such drawings shall be prepared in accordance with the provisions of rule 15 and shall be supplied with, and referred to in detail, in the specification, including the claims where the features illustrated in the drawings shall be followed by their respective reference signs in parentheses:

Provided that in case of a complete specification, if the applicant desires to adopt the drawings filed with the provisional specification as the drawings or part of the drawings for the complete specification, it shall be sufficient to refer to them in the complete specification as those left or filed with the provisional specification.]

(5) Irrelevant or other matter, not necessary, in the opinion of the Controller, for elucidation of the invention, shall be excluded from the title, description, claims and drawings.

[272][(6) Except in the case of an application (other than a convention application or an application filed under the Patent Cooperation Treaty designating India) which is accompanied by a complete specification, a declaration as to the inventorship of the invention shall be filed in Form 5 with the complete specification or at any time before the expiration of one month from the date of filing of the complete specification, as the Controller may allow on an application made in Form 4.]

Explanation: For the purposes of this rule, the date of filing of the complete specification with respect to an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.

(7) (a) The abstract as specified under clause (d) of sub-section (4) of section 10, accompanying the specification shall commence with the title of the invention. The title of the invention shall disclose the specific features of the invention normally in not more than fifteen words.

[273][(b) The abstract shall contain a concise summary of the matter contained in the specification and the summary shall indicate clearly the technical field to which the invention belongs, technical advancement of the invention as compared to the existing knowledge and principal use of the invention excluding any speculative use and where necessary, the abstract shall contain the chemical formula, which characterises the invention.]

(c) The abstract may not contain more than one hundred and fifty words.

(d) If the specification contains any drawing, the applicant shall indicate on the abstract the figure, or exceptionally, the figures of the drawings which may accompany the abstract when published.

Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing.

(e) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.

[274][(8) The period within which reference to the deposit shall be made in the specification under sub-clause (A) of clause (ii) of sub-section (4) of section 10 shall be three months from the date of filing of the application:
Provided that in case of a request for publication under rule 24A, such reference shall be made on or before the date of filing of such request.]

[275][14. Amendments to Specifications

(1) When amendments are made to a provisional or complete specification or any drawing accompanying it, the pages incorporating such amendments shall be retyped and submitted to form a continuous document.

(2) A marked copy clearly identifying the amendments carried out and a statement clearly indicating the portion (page number and line number) of the specification or drawing being amended along with the reason shall also be filed.

(3) Amendments shall not be made by slips pasted on, or as footnotes or by writing in the margin of any of the said documents.

(4) When a retyped page or pages incorporating amendments are submitted, the corresponding earlier page shall be deemed to have been superseded and cancelled by the applicant.]

15. Drawings

(1) Drawings, when furnished under section 10 by the applicants otherwise than on requisition made by the Controller, shall accompany the specifications to which they relate.

(2) No drawings or sketch, which would require a special illustration of the specification, shall appear in the specification itself.

(3) At least one copy of the drawing shall be prepared neatly and clearly on a durable paper sheet.

(4) Drawings shall be on standard A4 size sheets with a clear margin of at least 4cm on the top and left hand and 3cm at the bottom and right hand of every sheet.

(5) Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings.

(6) Drawing shall be sequentially or systematically numbered and shall bear –

(i) in the left hand top corner, the name of the applicant;

(ii) in the right hand top corner, the number of the sheets of drawings, and the consecutive number of each sheet; and

(iii) in the right hand bottom corner, the signature of the applicant or his agent.

(7) No descriptive matter shall appear on the drawings except in the flow diagrams.

16. Models

Models or samples shall be furnished under section 10 only when required by the Controller.

CHAPTER III

INTERNATIONAL APPLICATIONS UNDER PATENT COOPERATION TREATY (PCT)

17. Definitions

In this Chapter, unless the context otherwise requires, -

(a) "Article" means an Article of the Treaty;

[276][(aa) "Examining Authority" means the Indian International Preliminary Examining Authority referred to in sub-rule (1) of rule 19F;

(ab) "International Bureau" means the International Bureau of World Intellectual Property Organisation;

(ac) "Searching Authority" means the Indian International Searching Authority referred to in sub-rule (1) of Rule 19A;]

(b) "Treaty" or "PCT" means the Patent Cooperation Treaty;

(c) All other words and expressions used herein and not defined but defined in the PCT shall have the same meaning as assigned to them in that Treaty.

[277][18. Appropriate office in relation to international applications

(1) The receiving office, the designated office and the elected office, as the case may be, for the purposes of international applications shall be the appropriate office referred to in rule 4.

(2) Notwithstanding anything contained in sub-rule (1), the Patent Office, Delhi branch shall be the appropriate office for dealing with the International Bureau and any other International Searching Authority and International Preliminary Examining Authority.

(3) An international application shall be filed at and processed by the appropriate office, referred to in sub-rule (1), in accordance with the provisions of this Chapter, the Treaty and the regulations under the Treaty.

(4) The appropriate office referred to in sub-rule (1),shall, on receipt of an international application,-

(a) keep one copy of the application to be called the "home copy" in its office;

(b) transmit one copy to be called the "record copy" to the International Bureau; and

(c) transmit one copy to be called "search copy" to the competent International Searching Authority referred to in Article 16 of the Treaty,

and simultaneously furnish complete details of such application to the Patent Office, Delhi branch.]

[278][19. International applications filed with appropriate office as receiving office

(1) An international application shall be filed with the appropriate office in triplicate either in English or Hindi language.

(2) The fees payable in respect of an international application shall, in addition to the fees specified in the regulations under the Treaty, be the fees as specified in the First Schedule and the Fifth Schedule.

(3) Where an international application has not been filed in triplicate, the appropriate office shall, upon payment of fees specified in the First Schedule, prepare the required additional copies.

(4) On receipt of a request from the applicant and on payment of the fees specified in the First Schedule, the appropriate office shall prepare a certified copy of the priority document and promptly transmit the same to the International Bureau and intimate the applicant and the Patent Office, Delhi branch.

19A. Indian International Searching Authority

(1) The Patent Office, Delhi branch shall perform the functions of the Indian International Searching Authority under the treaty in accordance with an agreement between the Indian Patent Office and the International Bureau.

(2) The fees payable to the Searching Authority shall, in addition to the fees specified in the regulations made under the Treaty, be the fees as specified in the Fifth Schedule.

(3) The Searching Authority referred to in sub-rule (1), shall establish international search report in respect of international applications, or, as the case may be, declare in accordance with sub-rule (3) of rule 19B, in cases where India has been indicated as a competent International Searching Authority.

19B. International search report

(1) The Searching Authority shall, on receipt of the search copy, notify the International Bureau and the applicant about the receipt of search copy with identification mark 'ISA/IN' along with the international application number and its serial number and the date of receipt of the search copy.

(2) Notwithstanding anything contained in the proviso to item (i) of sub-rule (2) of rule 24B, the Searching Authority shall, upon receipt of the search copy, refer the international application, in the order in which the search copy was received, to an examiner or any other officer appointed under sub-section (2) of Section 73 of the Act for preparing an international search report, in accordance with the provisions contained in the Treaty and the regulations under the Treaty, ordinarily within a period of one month but not exceeding two months from the date of such reference.

(3) The Searching Authority, if it considers that-

(a) the international application relates to a subject matter which the Searching Authority is not required to search and accordingly decides not to search; or

(b) the description, claims or drawings fail to comply with the requirements prescribed under the regulation under the Treaty to such an extent that a meaningful search could not be carried out,

the Authority shall so declare and notify the applicant and the International Bureau that no international search report shall be established.

(4) In a case where any situation referred to in clause (a) or clause (b) of sub-rule (3) is found to exist in connection with certain claims only, the Searching Authority shall indicate this fact in the International Search Report in respect of such claims, and for other claims, it shall establish the International Search Report.

(5) The Searching Authority, if it considers that the international application does not comply with the requirement of unity of invention, in accordance with the provisions contained in Rule 13 of the regulations under the Treaty, shall send a notice specifying the reasons for which the international application is not considered as complying with the requirement of unity of invention and inviting the applicant-

(a) to pay the additional fees specified in the Fifth Schedule, indicating the amount of fees to be paid, within a period of one month from the date of such invitation; and

(b) to pay, where applicable, the protest fee specified in the Fifth Schedule, indicating the amount of fee to be paid, within a period of one month from the date of such invitation.

(6) The Searching Authority shall establish the International Search Report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and subject to payment of additional fee within the period specified in sub-rule (5), on those parts of the international application which relate to inventions in respect of which such additional fees were paid.

(7) Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.

(8) The examination of the protest referred to in sub-rule (7) shall be carried out by a Review Committee constituted by the Controller.

(9) The Review Committee constituted under sub-rule (8) shall examine the extent to which the protest is justified and shall accordingly order for the total or partial reimbursement of the additional fee to the applicant.

(10) Where the applicant has not paid the fees for the protest in accordance with clause (b) of sub-rule (5), the protest shall be considered not to have been made and the Searching Authority shall so declare.

(11) The protest fee shall be refunded to the applicant where the Review Committee referred to in sub-rule (8) finds that the protest was entirely justified.

(12) Where the international application contains the disclosure of one or more nucleotide or amino acid sequences and the sequences are not furnished in computer-readable text format, the Searching Authority shall send

a notice to the applicant to submit the sequence listing in computer-readable text format and pay the late furnishing fee specified in the Fifth Schedule, within a period of one month from the date of such notice and if the applicant fails to comply with the notice, the Searching Authority shall search the international application to the extent that a meaningful search can be carried out without the sequence listing.

19C. Time limit for establishing international search report

The Searching Authority shall establish the International Search Report and written opinion or, as the case may be, the declaration referred to in sub-rule (3) of rule 19B within a period of three months from the date of receipt of the search copy by the Searching Authority, or within a period of nine months from the date of priority, whichever expires later.

19D. Transmittal of the International Search Report and written opinion

The Searching Authority shall transmit one copy of the International Search Report or of the declaration referred to in Article 17(2)(a) of the Treaty, and one copy of the written opinion established under Rule 43*bis*.1 of the regulations under the Treaty, to the International Bureau and one copy to the applicant, on the same day.

19E. Confidential treatment

All matters pertaining to international applications shall be kept confidential in accordance with the treaty and the regulations under the Treaty.

19F. Indian International Preliminary Examining Authority

(1) The Patent Office, Delhi branch shall perform the functions of the International Preliminary Examining Authority under the Treaty in accordance with an agreement between the Indian Patent Office and the International Bureau.

(2) The Examining Authority referred to in sub-rule (1), shall establish-

(a) the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority;

(b) the International Preliminary Examination Report in respect of the demands filed by the nationals or residents of other countries in accordance with an agreement between Indian Patent Office and the International Bureau, upon being notified by the International Bureau;

(c) the International Preliminary Examination in respect of demands made by the nationals or residents of other countries not party to the Treaty or not bound by Chapter II of the Treaty, if the Assembly has so approves.

19G. Period for making a demand

(1) The demand for international preliminary examination shall be made within the period specified in the Treaty or regulations under the Treaty.

(2) In case the demand is made after the expiry of the period specified in sub-rule (1), it shall be considered to have not been made and no International Preliminary Examination Report shall be prepared.

19H. Fees payable to Examining Authority

The fees payable to the Examining Authority shall, in addition to the fees specified in the regulations under the Treaty, be the fees specified in the Fifth Schedule.

19I. Manner of making a demand

A demand shall be made in accordance with the provisions contained in these rules, the Treaty and the regulations under the Treaty.

19J. Processing of demands for international preliminary examination

(1) The Examining Authority, on receipt of the demand for international preliminary examination, if the Examining Authority is competent to conduct an international preliminary examination, shall assign the identification mark 'IPEA/IN' and shall notify the Applicant and the International Bureau.

(2) In case where the Examining Authority is not competent to conduct the international preliminary examination of the international application, it shall transmit the demand promptly to the International Bureau.

19K. International Preliminary Examination Report

(1) Notwithstanding anything contained in the proviso to item (i) of sub-rule (2) of rule 24B, the Examining Authority shall refer the international application, in accordance with the provisions contained in the Treaty and the regulations under the Treaty, in the order in which the demand was received in the Examining Authority to an examiner or any other officer appointed under sub-section (2) of section 73 of the Act for preparing an International Preliminary Examination Report ordinarily within a period of three months but not exceeding four months from the date of such reference.

(2) Claims relating to inventions in respect of which no International Search Report has been established shall not be the subject of international preliminary examination.

(3) The Examining Authority, if considers that-

(a) the international application relates to a subject matter on which the Examining Authority is not required to carry out an international preliminary examination, and, decides not to carry out such examination; or

(b) that the description, the claims, or the drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the questions of novelty, inventive step (non-obviousness), or industrial applicability, the Examining Authority shall not go into these questions and shall inform the applicant of this opinion and the reasons therefor.

(4) In a case where any situation referred to in clause (a) or clause (b) of sub-rule (3) is found to exist in connection with certain claims only, the Examining Authority shall indicate this fact in the International Preliminary Examination Report in respect of such claims, and for other

claims, it shall establish the International Preliminary Examination Report.

(5) Where the Examining Authority finds that the international application does not comply with the requirement of unity of invention, in accordance with the provisions contained in Rule 13 of the regulations under the Treaty and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees. it shall issue a notice to the applicant:

(a) specifying at least one possibility of restriction which. in the opinion of the Examining Authority, would be in compliance with the applicable requirement;

(b) specifying the reasons for which the international application is not considered as complying with the requirement of unity of invention;

(c) inviting the applicant to comply with the invitation within one month from the date of such notice;

(d) indicating the amount of the required additional fees to be paid in case the applicant so chooses; and

(e) inviting the applicant to pay, the protest fee within one month from the date of such notice, and indicate the amount to be paid, as specified in the Fifth Schedule.

(6) Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.

(7) The examination of the protest referred to in sub-rule (5) shall be carried out by a Review Committee constituted by the Controller.

(8) The Review Committee constituted under sub-rule (7) shall examine the extent to which the protest is justified and shall accordingly order for the total or partial reimbursement to the applicant of the additional fee.

(9) The protest fee shall be refunded to the applicant where the Review Committee referred to in sub-rule (6) finds that the protest was entirely justified.

19L. Period for establishing international preliminary examination report and its transmission

The period for establishing the International Preliminary Examination Report shall be:

(i) twenty eight months from the priority date; or

(ii) six months from the period specified under Rule 69.1 of the regulations under the Treaty for the start of the international preliminary examination; or

(iii) six months from the date of receipt by the Examining Authority of the translation furnished under Rule 55.2 of the regulations under the Treaty, whichever expires last.

19M. Transmittal of the International Preliminary Examination Report

The Examining Authority shall transmit one copy of the International Preliminary Examination Report and its annexures, if any, to the International Bureau, and one copy to the applicant, on the same day.

19N. Conditions for and extent of refund

The fee paid by the applicant may be refunded, waived or reduced to the extent and in accordance with the conditions specified in the Treaty or the regulations under the Treaty and the agreement entered between the Indian Patent Office and the International Bureau.]

20. International applications designating or designating and electing India

[279][(1) An application corresponding to an international application filed under Patent Cooperation Treaty may be made in Form 1 under sub-section (1A) of section 7

Explanation – For the purpose of this rule, "an application corresponding to an international application" means an international application as filed under Patent Cooperation Treaty which includes any amendments made by the applicant under Article 19 and communicated to Designated Office under Article 20 or any amendment made under sub-clause (b) of clause (2) of Article 34 of the Treaty:

Provided that the applicant, while filing such application corresponding to an international application designating India, may delete a claim, in accordance with the provisions contained in rule 14.]

(2) The Patent Office shall not commence processing of an application filed corresponding to international application designating India before the expiration of the time-limit prescribed under [280][sub-rule (4)(i).]

(3) An applicant in respect of an international application designating India shall, before the time limit prescribed in [281][sub-rule (4)(i),]-

(a) pay the prescribed national fee and other fees to the patent office in the manner prescribed under these rules and under the regulations made under the Treaty;

(b) and where the international application was either not filed or has not been published in English, file with the patent office, a translation of the application in English, duly verified by the applicant [282][or the person duly authorized by him] that the contents thereof are correct and complete.

[283][(4)(i) The time limit referred to in sub-rule (2) shall be thirty-one months from the priority date as referred to in Article 2(xi);

(ii) Notwithstanding anything contained in clause (i), the Patent Office may, on the express request filed in Form 18 along with the fee specified in First Schedule, process or examine the application at any time before thirty-one months.]

(5) The translation of the international referred to in sub-rule (3) shall include a translation in English of,-

(i) the description;
(ii) the claims as filed;
(iii) any text matter of the drawings;
(iv) the abstract;
(v) in case the applicant has not elected India and if the claims have been amended under Article 19, then the amended claims together with any statement filed under the said Article; and
(vi) in case the applicant has elected India and any amendments to the description, the claims and text matter of the drawings that are annexed to the international preliminary examination report.

(6) If the applicant fails to file a translation of the amended claims and annexures referred to in sub-rule (5), even after invitation from the appropriate office to do so, within a time limit as may be fixed by that office having regard to the time left for meeting the requirements, the amended claims and annexures shall be disregarded in the course of further processing the application by the appropriate office.

(7) The applicant in respect of an international application designating India shall when complying with sub-rule (3), preferably use Forms set out in the Second Schedule before the appropriate office as designated office.

21. Filing of priority document

(1) Where the applicant in respect of an international application designating India has not complied with the requirements of paragraph (a) or paragraph (b) of rule 17.1 of the regulations under the Treaty, the applicant shall file with the patent office the priority document referred to in that rule before the expiration of the time limit referred to in sub-rule (4) of rule 20,

(2) Where priority document referred to in sub-rule (1) is not in the English language, an English translation thereof duly verified by the applicant or the person duly authorized by him shall be filed within the time limit specified in sub-rule (4) of rule 20.

(3) Where the applicant does not comply with the requirements of sub-rule (1) or sub-rule (2), the appropriate office shall invite the applicant to file the priority document or the translation thereof, as the case may be, within three months from the date of such invitation, and if the applicant fails to do so, the claim of applicant for the priority shall be disregarded for the purposes of the Act.

22. Effect of non-compliance with certain requirements

An international application designating India shall be deemed to be withdrawn if the applicant does not comply with the requirements of rule 20.

23. The requirements under this Chapter to be supplemental of the regulations, etc, under the Treaty

(1) The provisions of this Chapter shall be supplemental to the PCT and the regulation and the administrative instructions made thereunder.

(2) In case of a conflict between any provisions of the rules contained in this Chapter and provisions of the Treaty and the regulations and the administrative instructions made thereunder, the provisions of the Treaty and the regulations and administrative instructions made thereunder shall apply in relation to international applications.

CHAPTER IV

PUBLICATION AND EXAMINATION OF APPLICATIONS

[284][24. Publication of application

The period for which an application for patent shall not ordinarily be open to public under sub-section (1) of section 11A shall be eighteen months from the date of filing of application or the date of priority of the application, whichever is earlier:

[285][Provided that the period within which the Controller shall publish the application in the Journal shall ordinarily be one month from the date of expiry of said period, or one month from the date of request for publication under rule 24A.]

24A. Request for publication

A request for publication under sub-section (2) of section 11A shall be made in Form 9.

24B. Examination of application

(1) (i) A request for examination under section 11B shall be made in Form 18 [286][within forty-eight months] from the date of priority of the application or from the date of filing of the application, whichever is earlier;

[287][(ii) The period within which the request for examination under sub-section (3) of section 11B to be made shall be forty-eight months from the date of priority, if applicable, or forty-eight months from the date of filing of the application;

(iii) The request for examination under sub-section (4) of section 11B shall be made within forty-eight months from the date of priority or from the date of filing of the application, or within six months from the date of revocation of the secrecy direction, whichever is later;

(iv) The request for examination of application as filed according to the 'Explanation' under sub-section (3) of section 16 shall be made within forty-eight months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later;]

(v) The period for making request for examination under section 11B, of the applications filed before the 1st day of January, 2005 shall be [288][the period specified under the section 11B before the commencement of the Patents (Amendment) Act, 2005 or] the

period specified under these rules, whichever expires later.

(2) [289][(i) Where the request for examination has been filed under sub-rule (1) and application has been published under section 11A, the Controller shall refer the application, specification and other documents related thereto to the examiner and such reference shall be made in the order in which the request is filed:

Provided that in case of a further application filed under section 16, the order of reference of such further application shall be the same as that of the first mentioned application:

Provided further that in case the first mentioned application has already been referred for examination, the further application shall have to be accompanied by a request for examination, and such further application shall be published within one month and be referred to the examiner within one month from the date of such publication.]

(ii) The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding three months from the date of reference of the application to him by the Controller.

[290][(iii) The period within which the Controller shall dispose off the report of the examiner shall ordinarily be one month from the date of the receipt of the such report by the Controller.]

[291][(3) A first statement of objections, along with any documents as may be required, shall be issued by the Controller to the applicant or his authorized agent within one month from the date of disposal of the report of examiner by the Controller:

Provided that where the request for examination was filed by a person interested, only an intimation of such examination may be sent to such person interested.]

[292][(4) Reply to the first statement of objections and subsequent reply, if any, shall be processed in the order in which such reply is received.

(5) The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant to comply with the requirements.

(6) The time for putting an application in order for grant under section 21 as prescribed under sub-rule (5) may be further extended for a period of three months on a request in Form 4 for extension of time along with prescribed fee, made to the Controller before expiry of the period specified under sub-rule (5).]

[293][24C. Expedited examination of applications

(1) An applicant may file a request for expedited examination in Form 18A along with the fee as specified in the first schedule only by electronic transmission duly authenticated within the period prescribed in rule 24B on any of the following grounds, namely:-

(a) that India has been indicated as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application; or

[299a][(b) that the applicant is a startup; or

(c) that the applicant is a small entity; or

(d) that if the applicant is a natural person or in the case of joint applicants, all the applicants are natural persons, then the applicant or at least one of the applicants is a female; or

(e) that the applicant is a department of the Government; or

(f) that the applicant is an institution established by a Central, Provincial or State Act, which is owned or controlled by the Government; or

(g) that the applicant is a Government company as defined in clause (45) of section 2 of the Companies Act, 2013 (18 of 2013); or

(h) that the applicant is an institution wholly or substantially financed by the Government;

Explanation:- For the purpose of this clause, the term 'substantially financed' shall have the same meaning as in the Explanation to subsection (1) of section 14 of the Comptroller and Auditor General's (Duties, Powers and Conditions of Service) Act, 1971(56 of 1971); or

(i) that the application pertains to a sector which is notified by the Central Government on the basis of a request from the head of a department of the Central Government.:

Provided that public comments are invited before any such notification; or

(j) that the applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office.

Explanation:- The patentability of patent applications filed under clause (j) above will be in accordance with the relevant provisions of the Act.]

(2) A request for examination filed under rule 24B may be converted to a request for expedited examination under sub-rule (1) of rule 24C by paying the relevant fees and submitting requisite documents as required under sub-rule (1).

(3) Except where the application has already been published under sub-section (2) of section 11A or a request for publication under rule 24A has already been filed, a request for expedited examination shall be accompanied by a request for publication under rule 24A.

(4) Where the request for expedited examination does not comply with the requirements of this rule, such a request shall be processed in accordance with the provisions contained in rule 24B, with an intimation to the applicant, and shall be deemed to have been filed on the date on which the request for expedited examination was filed.

(5) The Controller shall refer the request for expedited examination along with the application and specification and other documents to the examiner, in respect of the applications where the request for expedited examination has been received, in the order of filing of such requests.

Provided that a request for expedited examination under this rule filed by a startup shall not be questioned merely on the ground that the startup

ceased to be a startup after having filed an application for patent due to the lapse of more than five years from the date of its incorporation or registration, or the turnover subsequently crossed the financial threshold limit, as defined.

(6) The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding two months from the date of reference of the application to him by the Controller.

(7) The period within which the Controller shall dispose of the report of the examiner shall be one month from the date of receipt of such report by the Controller.

(8) A first statement of objections along with any document, if required, shall be issued by the Controller to the applicant or his authorised agent within fifteen days from the date of disposal of the report of examiner by the Controller.

(9) Reply to the first statement of objections and subsequent reply, if any, in respect of an application where the request for expedited examination was filed, shall be processed in the order in which such reply for such application is received.

(10) The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant.

(11) The time for putting an application in order for grant under section 21, as prescribed in sub-rule (10) may be further extended for a period of three months on a request for extension made in Form 4 along with the prescribed fee, made to the Controller before the expiry of the period specified under sub-rule (10).

(12) The Controller shall dispose of the application within a period of three months from the date of receipt of the last reply to the first statement of objections or within a period of three months from the last date to put the application in order for grant under section 21 of the Act, whichever is earlier:
Provided that this time limit shall not be applicable in case of pre-grant opposition.

(13) Notwithstanding anything contained this rule, the Controller may limit the number of requests for expedited examination to be received during the year by way of a notice to be published in the official journal.]

25. Identification of published applications

Publication of application under sub-sections (2) and (5) of section 11A shall be identified by the letter 'A' along with the number of application.

[294][26. A request for withdrawal

The application under sub-section (4) of section 11 B shall be made in Form 29.]

[295][27. Inspection and supply of published documents

After the date of publication of the application under section 11A, the application

together with the complete specification and provisional specification, if any, the drawing, if any, [296][the abstract filed in respect of the application may be inspected at the appropriate office by making a written request to the Controller on payment of the fee in that behalf and copies thereof may be obtained on payment of fees specified in the First Schedule.]

28. Procedure in case of anticipation by prior publication

(1) If the Controller is satisfied after investigation under section 13 that the invention so far as claimed in any claim of the complete specification has been published in any specification or other document referred to in clause (a) of sub-section (1) or sub-section (2) of the said section, the Controller shall communicate the gist of specific objections and the basis thereof to the applicant and the applicant shall be afforded an opportunity to amend his specification.

(2) If the applicant contests any of the objections communicated to him by the Controller under sub-rule (1), or if he refiles his specification along with his observations as to whether or not the specification is to be amended, he shall be given an opportunity to be heard in the matter if he so requests:
Provided that such request shall be made on a date earlier than ten days of the final date of the period [297][referred to] under sub-section (1) of section 21:
Provided further that a request for hearing may be allowed to be filed within such shorter period as the Controller may deem fit in the circumstances of the case.

(3) If the applicant requests for a hearing under sub-rule (2) within a period of one month from the date of communication of the gist of objections, or, the Controller, considers it desirable to do so, whether or not the applicant has refiled his application, he shall forthwith fix a date and time for hearing having regard to the period remaining for putting the application in order or to the other circumstances of the case.

(4) The applicant shall be given ten days' notice of any such hearing or such shorter notice as appears to the Controller to be reasonable in the circumstances of the case and the applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.

(5) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as he thinks fit to be made and may refuse to [298][grant the patent] unless the amendment so specified or permitted is made within such period as may be fixed.

[299][(6) The hearing may also be held through video-conferencing or audio-visual communication devices: Provided that such hearing shall be deemed to have taken place at the appropriate office.
Explanation – For the purposes of this rule, the expression "communication device" shall have the same meaning as assigned to it in clause (ha) of sub-section (1) of section 2 of the Information Technology Act, 2000 (21 of 2000).

(7) In all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the date of hearing.]

[300][28A. Procedure in relation to consideration of report of examiner under section 14

In case the applicant contests any of the objections communicated to him, the procedure specified under rule 28 may apply.]

29. Procedure in case of anticipation by prior claiming

(1) When it is found that the invention so far as claimed in any claim of the complete specification, is claimed in any claim of any other specification falling within clause (b) of sub-section (1) of section 13, the applicant shall be so informed and shall be afforded an opportunity to amend his specification.

[301][(2) If the applicant's specification is otherwise in order for grant and an objection under clause (b) of sub-section (1) of section 13 is outstanding, the Controller may postpone the grant of patent and allow a period of two months for removing the objection.]

30. Amendment of the complete specification in case of anticipation

(1) If the applicant so requests at any time, or if the Controller is satisfied that the objection has not been removed within the period referred to in sub-clause (2) of rule 29, a date for hearing the applicant shall be fixed forthwith and the applicant shall be given at least ten days' notice of the date so fixed. The applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.

(2) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as will be to his satisfaction to be made and may direct that reference to such other specification, as he shall mention shall be inserted in the applicant's specification unless the amendment is made or agreed to within such period as he may fix.

31. Form of reference to another specification

When in pursuance of rule 30, the Controller directs that a reference to another specification shall be inserted in the applicant's complete specification, such reference shall be inserted after the claims and shall be in the following form, namely:

"Reference has been directed, in pursuance of section 18(2) of the Patents Act, 1970, to the specification filed in pursuance of application No. ....."

32. Procedure in case of potential infringement

If in consequence of an investigation made under section 13, [302][***] it appears to the Controller that the applicant's invention cannot be performed without substantial risk of infringement of a claim of another patent, the applicant shall be so informed and the procedure provided in rule 29 shall, so far as may be necessary, be applicable.

33. Form of reference to another patent

Where the Controller directs that a reference to another patent shall be inserted in the applicant's complete specification under sub-section (1) of section 19, such reference shall be inserted after the claims in the following form, namely-

"Reference has been directed, in pursuance of section 19(1) of the Patents Act, 1970, to Patent No....."

34. Manner in which a claim under section 20(1) shall be made

(1) A claim under sub-section (1) of section 20 shall be made in Form 6.

(2) The original assignment or agreement or an official copy or notarized copy thereof shall also be produced for the Controller's inspection and the Controller may call for such other proof of title or written consent as he may require.

35. Manner in which a request may be made under section 20(4)

(1) A request under sub-section (4) of section 20 shall be made in Form 6.

(2) The request shall be accompanied by proof of death of the joint applicant and a certified copy of the probate of the will of the deceased or letters of administration in respect of his estate or any other document to prove that the person who gives the consent is the legal representative of the deceased applicant.

36. Manner of application under section 20(5)

(1) An application under sub-section (5) of section 20 shall be made in Form 6 in duplicate and shall be accompanied by a statement setting out fully the facts upon which the applicant relies and the directions which he seeks.

(2) A copy of the application and statement shall be sent by the Controller to every other joint applicant.

[303][37. Numbering of applications on the grant of patent

On the grant of a patent, the application shall be accorded a number (called serial number) in the series of numbers accorded to patents under the Indian Patents and Designs Act, 1911 (2 of 1911)[304] which shall be the number of the patent so granted.]

38. [305][Omitted by the Patents (Amendment) Rules, 2005]

CHAPTER V

EXCLUSIVE MARKETING RIGHTS

39 to 54. [306][Omitted by the Patents (Amendment) Rules, 2005]

CHAPTER VI

[307][OPPOSITION PROCEEDINGS TO GRANT OF PATENT]

[308][55. [309][Opposition to the patent]

[310][(1) Representation for opposition under sub-section (1) of section 25 shall be filed in Form 7(A) at the appropriate office with a copy to the applicant, and shall include a statement and evidence, if any, in support of the representation and a request for hearing, if so desired.]

(1A) Notwithstanding anything contained in sub-rule(1), no patent shall be granted before the expiry of a period of six months from the date of publication of the application under section 11A.]

(2) The Controller shall consider such representation only when a request for examination of the application has been filed.

[311][(3) On consideration of the representation if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that effect.]

[312][(4) On receiving the notice under sub-rule (3), the applicant shall, if he so desires, file his statement and evidence, if any, in support of his application within three months from the date of the notice, with a copy to the opponent.]

[313][(5) On consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and after hearing the parties, if so requested, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refuse to grant a patent on the application, by passing a speaking order to simultaneously decide on the application and the representation ordinarily within one month from the completion of above proceedings.]

[314][***]

55A. Filing of notice of opposition

The notice of opposition to be given under [315][sub-section (2) of section 25] shall be made in Form 7 and sent to the Controller in duplicate at the appropriate office.

56. Constitution of Opposition Board and its proceeding

(1) On receipt of [316][notice of opposition under rule 55A], the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board.

(2) An examiner appointed under sub-section (2) of section 73 shall be eligible to be a member of the Opposition Board.

(3) The examiner, who has dealt with the application for patent during the proceeding for grant of patent thereon shall not be eligible as member of Opposition Board as specified in sub-rule (2) for that application.

(4) The Opposition Board shall conduct the examination of the notice of opposition along with documents filed under rules 57 to 60 referred to under [317][sub-section (3) of section 25], submit a report with reasons on each ground taken in the notice of opposition with its joint recommendation within three months from the date on which the documents were forwarded to them.

57. Filing of written statement of opposition and evidence

The opponent shall send a written statement in duplicate setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition and shall deliver to the patentee a copy of the statement and the evidence, if any.]

58. Filing of reply statement and evidence

(1) If the [318][patentee] desires to contest the opposition, he shall leave at the appropriate office a reply statement setting out fully the grounds upon which the opposition is contested and evidence if any, in support of his case within a period of two months from the date of receipt of the copy of the written statement and opponent's evidence, if any by him under rule 57 and deliver to the opponent a copy thereof.

[319][(2) If the patentee does not desire to contest or leave his reply and evidence within the period as specified in sub-rule (1), the patent shall be deemed to have been revoked.]

59. Filing of reply evidence by opponent

The opponent may, within one month from the date of delivery to him of a copy of the [320][patentee's] reply statement and evidence under rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the patentee's evidence and shall deliver to the patentee a copy of such evidence.

60. Further evidence to be left with the leave of the Controller

No further evidence shall be delivered by either party except with the leave or directions of the Controller:

Provided that such leave or direction is prayed before the Controller has fixed the hearing under rule 62.

61. Copies of documents to be supplied

(1) Copies of all documents referred to in the notice of opposition or in any statement or evidence filed in connection with the opposition and authenticated to the satisfaction of the Controller, shall be simultaneously furnished in duplicate unless the Controller otherwise directs.

(2) Where a specification or other document in a language other than English is referred to in the notice, statement or evidence, an attested translation thereof, in duplicate, in English shall be furnished along with such notice, statement or evidence, as the case may be.

62. Hearing

[321][(1) On the completion of the presentation of evidence, if any, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall fix a date and time for the hearing of the opposition and shall give the parties not less than ten days' notice of such hearing and may require members of Opposition Board to be present in the hearing.]

(2) If either party to the proceeding desires to be heard, he shall inform the Controller by a notice along with the fee as specified in the First Schedule.

(3) The Controller may refuse to hear any party who has not given notice under sub-rule (2),

(4) If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to the Controller not less than five days' notice of his intention, together with details of such publication.

[322][(5) After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition and notify his decision to the parties giving reasons therefor.]

[323][63. Determination of costs

If the patentee notifies the Controller that he desires to withdraw the patent after notice of opposition is given, the Controller, depending on the merits of the case, may decide whether costs should be awarded to the opponent.]

[324][63A.Request made under section 26(1)

Request under section 26(1) shall be made on Form 12 within three months from the date of the order of the Controller and shall be accompanied by a statement setting out the facts upon which the petitioner relies and relief he claims.]

64. [Omitted by the Patents (Amendment) Rules, 2005]

65. [Omitted by the Patents (Amendment) Rules, 2005]

66. Form of making a request under section 28(2)

A request under sub-section (2) of section 28 shall be made in Form 8.

67. Form of making a claim under section 28(3)

(1) A claim under sub-section (3) of section 28 shall be made in Form 8, and shall be accompanied by a statement setting out the circumstances under which the claim is made.

(2) A copy of the claim and the statement shall be sent by the Controller to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested.

68. Form of application to be made under section 28(7)

(1) An application under sub-section (7) of section 28 shall be made in Form 8 and shall be accompanied by a statement setting out the circumstances under which the application is made.

(2) A copy of the application and the statement shall be sent by the Controller to each patentee or the applicant for patent, as the case may be, and to any other person whom the Controller may consider to be interested.

[325][69. Procedure for the hearing of claim or an application under section 28

The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and cost shall, so far as may be, apply to the hearing of a claim or an application under section 28 as they apply to the opposition proceedings subject to the modification that reference to patentee shall be construed as the person making the claim, or an application, as the case may be.]

70. Mention of inventor

Any mention of the inventor under sub-section (1) of section 28 shall be madein the relevant documents in the following form, namely: -

"The inventor of this invention/substantial part of this invention within the meaning of section 28 of the Patents Act, 1970, is _____ of_____"

CHAPTER VII

SECRECY DIRECTIONS

[326][71. Permission for making patent application outside India under section 39

(1) The request for permission for making patent application outside India shall be made in Form 25.

[327][(2) The Controller shall dispose of the request made under sub-rule (1) within a period of twenty-one days from the date of filing of such request: Provided that in case of inventions relating to defence or atomic energy, the period of twenty-one days shall be counted from the date of receipt of consent from the Central Government.]

72. Communication of result of reconsideration under section 36(2)

(1) The result of every reconsideration under sub-section (1) of section 36 shall be communicated to the applicant for patent within fifteen days of the receipt of the notice by the Controller.

(2) *Extension of time on revocation of secrecy directions under Section 38* – The extension of time to be given for doing anything required or authorised to be done under section 38 shall not exceed the period for which directions given by the Central Government under sub-section (1) of section 35 were in force.

CHAPTER VIII

[328][GRANT OF PATENTS]

73. [Omitted by the Patents (Amendment) Rules, 2005]

[329][74. Form of patent

(1) A patent shall be in the form as specified in the Third Schedule with such modifications as the circumstances of each case may require and shall bear the number accorded to the application under rule 37.

(2) The patent certificate shall ordinarily be issued within seven days from the date of grant of patent under section 43.]

[330][74A.Inspection of documents related to grant of patent

After the date of publication of a grant of a patent, the application together with the complete specification and provisional specification, if any, the drawing if any, abstract and other documents related thereto may be inspected at the appropriate office by making a written request to the Controller and on payment of fee and may obtain copies on payment of fee specified in the First Schedule.]

75. Amendment of patent under section 44

An application under section 44 for the amendment of a patent shall be made in Form 10 along with substantiating evidence and be accompanied by the patent.

76. Manner of applying for direction under section 51(1)

(1) An application for directions under sub-section (1) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.

(2) A copy of the application and of the statement shall be sent by the Controller to every other person registered as grantee or proprietor of the patent.

77. Manner of application under section 51(2)

(1) An application for directions under sub-section (2) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.

(2) A copy of the application and statement shall be sent by the Controller to the person in default.

[331][78. Procedure for the hearing of proceedings under section 51

The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of an application under section 51 as they apply to the hearing of an opposition proceeding.]

79. Request under section 52(2)

(1) A request under sub-section (2) of section 52 shall be made in Form 12 within three months from the date of the order of the [332][Appellate Board or] Court referred to in sub-section (1) of the said section and shall be accompanied by a statement setting out the facts upon which the petitioner relies and the relief he claims and a certified copy of the order of the [333][Appellate Board or] Court.

(2) Where the [334][Appellate Board or Court] has ordered the grant of patent to the applicant only for a part of the invention, the new patent granted shall be accorded a number in the same series of numbers accorded to the complete specifications accepted on the same day as the patent is granted.

80. Renewal fees under section 53

(1) To keep a patent in force, the renewal fees specified in the First Schedule shall be payable at the expiration of the second year from the date of the patent or of any succeeding year and the same shall be remitted to the patent office before the expiration of the second or the succeeding year.

[335][(1A) The period for payment of renewal fees so specified in sub-rule (1) may be extended to such period not being more than six months if the request

for such extension of time is made in Form 4 with the fee specified in the First Schedule.]

(2) While paying the renewal fee, the number and date of the patent concerned and the year in respect of which the fee is paid shall be quoted.

(3) The annual renewal fees payable in respect of two or more years may be paid in advance.

(4) The Controller shall, after making such enquiry as he may deem necessary, credit any renewal fee and issue a certificate that the fee has been paid.

CHAPTER IX

AMENDMENT OF APPLICATION, SPECIFICATION OR ANY DOCUMENT RELATING THERETO

81. Amendment of application, specification or any document relating thereto

(1) An application under section 57 for the amendment of an application for a patent or a complete specification or any document related thereto shall be made in Form 13.

(2) If the application for amendment under sub-rule (1) relates to an application for a patent which has not been [336][granted], the Controller shall determine whether and subject to what conditions, if any, the amendment shall be allowed.

[337][3(a) If the application for amendment under sub-rule (1) is made after grant of patent and the nature of the proposed amendment is substantive, the application shall be published.

(b) Any person interested in opposing the application for amendment shall give a notice of opposition in Form 14 within three months from the date of publication of the application.

(c) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 57 as they apply to the hearing of an opposition proceeding.]

82. Preparation of amended specifications, etc.

Where the Controller allows the application for a patent or the complete specification or any other document to be amended, the applicant shall, if the Controller so requires and within the time to be specified by him, leave at the appropriate office an amended application or the specification of the other document, as the case may be, in accordance with the provisions of these rules.

[338][83. Publication of the amendment allowed

The amendments allowed after a patent has been granted, shall be published.]

CHAPTER X

RESTORATION OF PATENTS

84. Restoration of patents

(1) An application for the restoration of a patent under section 60 shall be made in Form 15.

(2) Where the Controller is satisfied that a *prima facie* case for the restoration of any patent has not been made out, he shall intimate the applicant accordingly and unless the applicant makes a request to be heard in the matter within one month from the date of such intimation the Controller shall refuse the application.

[339][(3) Where applicant requests for a hearing within the time allowed and the Controller, after giving the applicant such a hearing, is *prima facie* satisfied that the failure to pay the renewal fees was unintentional, he shall publish the application.]

[340][85. Opposition to restoration under section 61

(1) At any time, within two months from the date of publication of the application under sub-rule (3) of rule 84, any person interested may give notice of opposition thereto in Form 14.

(2) A copy of the notice of opposition shall be sent by the Controller to the applicant.

(3) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 60 as they apply to the hearing in the opposition proceeding.]

86. Payment of unpaid renewal fees

(1) Where the Controller decides in favour of the applicant, the applicant shall pay the unpaid renewal fees and the additional fee specified in the First Schedule, within a month from the date of the order of the Controller allowing the application for restoration.

[341][(2) The Controller shall publish his decision.]

CHAPTER XI

SURRENDER OF PATENTS

[342][87. Surrender of Patents

(1) The Controller shall publish the notice of an offer given under section 63.

(2) Any person interested may, within three months from the date of publication of the notice, give notice of opposition to the Controller in Form 14 in duplicate.

(3) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so

far as may be, apply to the hearing of the opposition under section 63 as they apply to the hearing in opposition proceeding.

(4) If the Controller accepts the patentee's offer to surrender the patent, he may direct the patentee to return the patent, and on receipt of such patent, the Controller shall by order revoke it and publish the revocation of the patent.]

CHAPTER XII

REGISTER OF PATENTS

88. Register of patents under section 67

(1) Upon the [343][grant] of a patent, the Controller shall enter in the register of patents at each appropriate office, the name, address and nationality of the grantee as the patentee thereof, the title of the invention (including the categories to which the invention relates), the date of the patent and the date of [344][grant] thereof together with the address for service of the patentee.

(2) The Controller shall also enter in the register of patents particulars regarding proceedings under the Act before the [345][Controller or Appellate Board or the courts] in respect of every patent.

(3) Where the register of patents or any part thereof is in computer floppies, diskettes or any other electronic form it shall be maintained and accessed only by the person who is duly authorised by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is not so authorised by the Controller.

89. [Omitted by the Patents (Amendment) Rules, 2005]

90. Registration of title and interest in patents

(1) An application referred to in sub-section (1) or sub-section (2) of section 69 shall be made in [346][Form 16.]

(2) An application for an entry in the register of patents of any other document purporting to affect the proprietorship of the patent by the person benefiting under the document shall be made in [347][Form 16.]

91. Presentation of assignment, etc of patent to Controller

Every assignment and every other document giving effect to or being evidence of the transfer of a patent or affecting the proprietorship thereof or creating an interest therein as claimed in such application, shall, unless the Controller otherwise directs, be presented to him together with the application which shall be accompanied by two copies of the assignment or other document certified to be true copies by the applicant or his agent and the Controller may call for such other proof of title or written consent as he may require.

92. Registration of title or interest in a patent

After the receipt of an application under sub-section (1) or sub-section (2) of section 69, the Controller shall register the title of the person concerned or his interest in a patent, as the case may be, and an entry in the following form shall be made in the register, namely: -

"In pursuance of an application received on the_____ Proprietor_____ Assignment _____ registered as _____ licensee _____ by virtue of licence _____ Mortgagee, etc _____ Mortgage, deed, etc dated _____ and made between _____ on the one part and _____ of the other part."

[348][93. Entry of renewal fee

Upon receipt of the payment of the prescribed renewal fee in respect of a patent, the Controller shall enter in the register of patents the fact that the fee has been paid and the date of payment of such fee and issue a certificate of renewal of the patent.]

94. Alteration of address

(1) A patentee may make a request in writing along with fee payable to the Controller for the alteration of his name, nationality, address or address for service as entered in the register of patents in respect of any patent granted to him. The Controller may require such proof of the alteration as he may think fit before acting on a request to alter the name or nationality.

(2) If the Controller allows a request made under sub-rule (1), he shall cause the entries in the register to be altered accordingly.

(3) If a patentee makes a request in writing along with fee payable for entering an additional address for service in India and if the Controller is satisfied that the request should be allowed, he shall have the additional address for service entered in the register.

95. Inspection of register of patents under section 72 and fees payable therefor

(1) The register of patents shall be open for public inspection during office hours on payment of the fees specified therefor in the First Schedule.

(2) When register of patents or any part thereof is in computer floppies, diskettes or any other electronic form the person authorised by the Controller under sub-rule (3) of rule 88 shall provide access to the computer floppies, diskettes or other electronic form or printouts of the records thereof.

CHAPTER XIII

COMPULSORY LICENCE AND REVOCATION OF PATENT

[349][96. Application for compulsory licence, etc.

An application to the Controller for an order under section 84, section 85, section 91 or section 92 or section 92A shall be in Form 17, or Form 19, as the case may be. Except in the case of an application made by the Central

Government, the application shall set out the nature of the applicant's interest and terms and conditions of the licence the applicant is willing to accept.]

97. When a prima facie case is not made out

(1) If, upon consideration of the evidence, the Controller is satisfied that a prima facie case has not been made out for the making of an order under any of the sections referred to in rule 96, he shall notify the applicant accordingly, and unless the applicant requests to be heard in the matter, within one month from the date of such notification, the Controller shall refuse the application.

(2) If the applicant requests for a hearing within the time allowed under sub-rule (1), the Controller shall, after giving the applicant an opportunity of being heard, determine whether the application may be proceeded with or whether it shall be refused.

98. Notice of opposition under section 87(2)

(1) A notice of opposition under sub-section (2) of section 87 shall be given in Form 14 and shall be sent to the Controller within two months from the date of the [350][publication] of the application under sub-section (1) of the said section.

(2) The notice of opposition referred to in sub-rule (1) shall include the terms and conditions of the licence, if any, the opponent is prepared to grant to the applicant and shall be accompanied by evidence in support of the opposition.

(3) The opponent shall serve a copy of his notice of opposition and evidence on the applicant and notify the Controller when such service has been effected.

(4) No further statement or evidence shall be delivered by either party except with the leave of or on requisition by the Controller.

(5) The Controller shall forthwith fix a date and time for the hearing of the case and shall give the parties not less then ten days' notice of such hearing.

(6) The procedure specified in sub-rules (2) to (5) of rule 62, shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing [351][in opposition proceedings.]

[352][99. Manner of publication of the revocation order

The Controller shall publish the order made by him under sub-section (3) of section 85 revoking a patent.]

100. Application under section 88(4)

(1) An application under sub-section (4) of section 88 for the revision of the terms and conditions of a licence which have been settled by the Controller shall be in [353][Form 20] and shall state the facts relied upon by the applicant and the relief he seeks and shall be accompanied by evidence in support of the application.

(2) If the Controller is satisfied that a prime facie case has not been made out

for the revision of the terms and conditions of the licence, he may notify the applicant accordingly and unless within a month the applicant requests to be heard in the matter, the Controller may refuse the application.

(3) The Controller, after giving the applicant an opportunity of being heard, shall determine whether the application shall be proceeded with or whether the application shall be refused.

101. Procedure to be followed in case of applications under section 88(4)

(1) If the Controller allows the application to be proceeded with, he shall direct the applicant to serve copies of the application and of the evidence in support thereof upon the patentee or any other person appearing in the register to be interested in the patent or upon any other person on whom, in his opinion such copies should be so served.

(2) The applicant shall inform the Controller the date on which the service of copies of application and of the evidence on the patentee and other persons referred to in sub-rule (1) has been effected.

(3) The patentee or any other person on whom copies of the application and of the evidence have been served, may give to the Controller notice of opposition in Form 14 within one month from the date of such service. Such notice shall contain the grounds relied upon by the opponent and shall be accompanied by evidence in support of the opposition.

(4) The opponent shall serve copies of the notice of opposition and his evidence on the applicant and inform the Controller the date on which such service has been effected.

(5) No further evidence or statement shall be filed by either party except with special leave of or on requisition by the Controller.

(6) On completion of the above proceedings, the Controller shall forthwith fix a date and the time for the hearing of the case and shall give the parties not less than ten days' notice of such hearing.

(7) The procedure specified in sub-rules (2) to (5) of rule 62 shall; so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing [354][in opposition proceedings.]

(8) If the Controller decides to revise the terms and conditions of licence he shall forthwith amend the licence granted to the applicant in such manner, as he may deem necessary.

102. Application for termination of compulsory licence under section 94

(1) An application for termination of compulsory licence under section 94(1) shall be made in [355][Form 21] by the patentee or any other person deriving title or interest in the patent. The application shall be accompanied by the evidence in support of the application.

(2) The applicant shall serve a copy of the application and evidence on the holder of the compulsory licence and shall inform the Controller the date on which the service has been effected.

(3) The holder of the compulsory licence may file his objection along with

evidence, if any, to the application within one month from the date of receipt of the application and evidence by him to the Controller and serve a copy thereof to the applicant.

(4) No further evidence or statement shall be filed by either party except with special leave of or on requisition by the Controller.

(5) On completion of the above proceedings, the Controller shall forthwith fix a date and the time for the hearing of the case and shall give the parties not less than ten days' notice of such hearing.

(6) The procedure specified in sub-rules (2) to (5) of rule 62 so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing [356][in opposition proceedings.]

(7) If the Controller decides to terminate the compulsory licence he shall forthwith issue an order giving terms and conditions, if any, of such termination and serve copies of the order to both the parties.

CHAPTER XIV

SCIENTIFIC ADVISERS

103. Roll of scientific advisers

(1) The Controller shall maintain a roll of scientific advisers for the purpose of section 115. The roll shall be updated annually. The roll shall contain the [357][names, addresses, specimen signatures and photographs] of scientific advisers, their designations, information regarding their educational qualifications, the disciplines of their specialisation and their technical, practical and research experience.

(2) A person shall be qualified to have his name entered in the roll of scientific advisers, if he-

(i) holds a degree in science, engineering, technology or equivalent;

[358][(ii) has at least fifteen years' technical, practical or research experience; and]

(iii) he holds or has held a responsible post in a scientific or technical department of the Central or State Government or in any organisation.

[359][103A. Disqualifications for inclusion in the roll of scientific advisers

A person shall not be eligible to be included in the roll of scientific advisors, if he—

(i) has been adjudged by a competent court to be of unsound mind;

(ii) is an undischarged insolvent;

(iii) being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part;

(iv) has been convicted by a competent court, whether within or outside India of an offence to undergo a term of imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the Central Government has, by order in this behalf, removed the disability; or

(v) has been guilty of professional misconduct.]

[360][104. Manner of application for inclusion in the roll of scientific advisers

Any interested person may apply to the Controller for inclusion of his name in the roll of scientific advisers by furnishing his bio-data.]

105. Inclusion of the name of any other person in the roll of scientific advisers

The Controller may, notwithstanding anything contained in rules 103 and 104, enter the name of any person in the roll of scientific advisers, if he is of the opinion after such inquiry as he deems fit, that such person should be entered in the roll of scientific advisers.

106. Power to relax

Where the Controller is of the opinion that it is necessary or expedient so to do, he may, by order, for reasons to be recorded in writing, relax any of the qualifications specified in sub-rule (2) of rule 103 with respect to any person, if such person is otherwise well qualified.

107. Removal of names from the roll of scientific advisers

The Controller may remove the name of any person from the roll of scientific advisers, if-

(a) such person makes a request for such removal; or

(b) the Controller is satisfied that his name has been entered in the roll by error or on account of misrepresentation or suppression of any material fact; or

[361][(c) such person has been convicted of an offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity and the Controller is of the opinion that his name should be removed from the roll; or

(d) such person is dead:

Provided that except in the cases falling under clause (a) and (d) above, before removing the name of any person from the roll of scientific advisers under this rule, such person shall be given a reasonable opportunity of being heard.]

CHAPTER XV

PATENT AGENTS

108. Particulars to be contained in the register of patent agents

[362][(1) The register of patent agents maintained under section 125 shall contain the name, nationality, address of the principal place of business, addresses of branch offices, if any, the qualifications, the date of registration of every registered patent agent and the details of their renewal of registration and any other particulars so specified by the Controller.]

(2) Where the register of patent agents is in computer floppies, diskettes or any other electronic form, it shall be maintained and accessed only by the person who is duly authorised by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is not so authorised by the Controller.

[363][(3)(i) Copies of register of patent agents shall be maintained in each of the branch offices;

(ii) The register of patent agents shall also contain specimen signatures and photographs of the persons registered as patent agents.]

109. Application for registration of patent agents

(1) Every person who desires to be registered as a patent agent shall make an application in [364][Form 22.]

(2) The applicant shall furnish such other information as may be required by the Controller.

[365][(3) A person desirous to appear in the qualifying examination under rule 110 shall make a request to the Controller along with the fee specified in the First Schedule after announcement of such examination and within the period as may be specified in the announcement.]

110. Particulars of the qualifying examination for patent agents

(1) The qualifying examination referred to in clause (c) (ii) of sub-section (1) of section 126 shall consist of a written test and a viva voce examination.

(2) The qualifying examination shall consist of the following papers and marks, namely:

Paper I	Patent Act and Rules	100
Paper II	Drafting and interpretation of patent specifications and other documents	100
	Viva Voce	[366][50]

[367][(3) A candidate shall be required to secure a minimum of fifty marks in paper I and paper II and shall be declared to have passed the examination only, if he obtains an aggregate of sixty percent of the total marks.]

111. Registration of patent agents

After a candidate passes the qualifying examination specified in rule 110 and after obtaining any further information which the Controller considers necessary he shall, on receipt of the fee specified therefor in the First Schedule, enter the candidate's name in the register of patent agents and issue to him a certificate of registration as a patent agent.

[368][111A. Issue of duplicate certificate of patent agents

The Controller may issue a duplicate certificate of registration as patent agent on a request made by the person so registered as patent agent along with fee specified in the First Schedule and contain a statement setting out the circumstances in which the original certificate issued under rule 111 was lost, destroyed and cannot be produced.]

112. Details to be included in an application for the registration of a patent agent

An application by a person entitled to be registered as a patent agent under sub-section (2) of section 126 shall also be made in [369][Form 22.]

113. Registration of patent agents under section 126(2)

On receipt of an application for the registration of a person as a patent agent under rule 112, the Controller may if he is satisfied that the said person fulfils the conditions specified in sub-section (2) of section 126 enter his name in the register of patent agents.

114. Disqualifications for registration as a patent agent

A person shall not be eligible to be registered as a patent agent, if he-

(i) has been adjudged by a competent court to be of unsound mind;

(ii) is an undischarged insolvent;

(iii) being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part;

(iv) has been convicted by a competent court, whether within or outside India of an offence to undergo a term of imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the Central Government has, by order in this behalf, removed the disability;

(v) being a legal practitioner has been guilty of professional misconduct; or

(vi) being a chartered accountant, has been guilty of negligence or misconduct.

115. Payment of fees

The continuance of a person's name in the register of patent agents shall be subject to the payment of the fees specified therefor in the First Schedule.

116. Removal of a name from the register of patent agents

(1) The Controller may delete from the register of patent agents, the name of any patent agent-

(a) from whom a request has been received to that effect; or

(b) when he is dead; or

(c) when the Controller has removed the name of a person under sub-section (1) of section 130; or

[370][(d) if he has defaulted in the payment of fees specified in rule 115, by more than three months after they are due; or

(e) if he ceases to be a citizen of India:

Provided that except under clause (a) and (b), before removing the name of any person from the register of patent agents under this rule, such person shall be given a reasonable opportunity of being heard.]

(2) The removal of the name of any person from the register of patent agents [371][shall be published] and shall be, where relevant forthwith communicated to the person concerned.

117. Restoration of name of persons removed from the register of patent agents

(1) An application for the restoration of the name of any person removed from the register of patent agents under sub-section (2) of section 130 shall be made in [372][Form 23] within two months from the date of such removal.

(2) If the name of a person is restored to the register of patent agents, his name shall be continued therein for a period of one year from the date on which his last annual fee became due.

[373][(3) The restoration of a name to the register of patent agents shall be communicated to the patent agent and also published on the official website.]

118. Alteration of names etc in the register of patent agents

[374][(1) A patent agent may apply for the alteration of his name, address of the principal place of business and branch offices, if any, or the qualifications entered in the register of patent agents, e-mail address, telephone number, fax number or any other particulars under sub-section (1) of section 125. On receipt of such application and the fee specified therefor in the First Schedule for such request for alteration of particulars, the Controller shall cause the necessary alterations to be made in the register of patent agents.]

(2) Every alteration made in the register of patent agents [375][shall be published.]

119. Refusal to recognise as patent agent

If the Controller is of the opinion that any person should not be recognised as a patent agent in respect of any business under the Act as provided in sub-section (1) of section 131 thereof, he shall communicate his reasons to that person and direct him to show-cause why he should not refuse to recognise him as such agent, within such time as he may allow, and after considering the reply, if any, of that person and giving him an opportunity of being heard, the Controller may pass such orders as he may deem fit.

120. Publication of the names of patent agents, registered under the Act

The names and addresses of persons registered as patent agents shall from time to time be published [376][***].

CHAPTER XVI
MISCELLANEOUS

[377][121. Period within which copies of specification, etc. are to be filed

The period within which copies of specification or corresponding documents to be filed by the applicant under subsection (1) of section 138 shall be three months from the date of communication by the Controller.

121A. Address of communications

All communications in relation to any proceeding under the Act or these rules shall be addressed to the Controller at the appropriate office.]

122. Correction of clerical errors

A request for the correction of a clerical error in any document referred to in section 78 shall be accompanied by a copy of the document highlighting the corrections clearly along with the fees payable therefor as specified in the First Schedule.

123. Manner of advertisement of the proposed correction of any error

Where the Controller requires a notice of the nature of the proposed correction to be advertised, the request and the nature of the proposed correction shall be published [378][***] and the person making the request shall also serve copies of the request and the copies of the document showing the proposed corrections to such persons who, in the opinion of the Controller, may be interested.

124. Manner and time of opposition to the making of corrections

(1) Any person interested may, at any time, within three months from the date of the advertisement of the request for correction and [379][***] give notice of opposition to the Controller in Form 14 in duplicate.

(2) Such notice of opposition shall be accompanied by a statement in duplicate setting out the nature of the opponent's interest, the facts on which he relies and the relief which he seeks.

(3) A copy of the notice and of the statement shall be sent by the Controller to the person making the request.

(4) The procedure specified in rules 58 to 63 relating to the filing of reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition proceeding under section 78 as they apply [380][in the hearing of the opposition proceedings.]

125. Notification of corrections

The Controller shall notify the person making a request for the correction and the opponent, if any, of the corrections made in the relevant document.

126. Form, etc of affidavits

(1) The affidavits required by the Act or these rules to be filed at the patent office or furnished to the Controller shall be duly sworn to in the manner as prescribed in sub-rule (3).

(2) Affidavits shall be confined to such facts as the deponent is able, of his own knowledge, to prove except in interlocutory matters, where statements of belief of the deponent may be admitted, provided that the grounds thereof are given.

(3) Affidavits shall be sworn to as follows: -

(a) *in India* - before any court or person having by law authority to receive evidence, or before any officer empowered by such court as aforesaid to administer oaths or to take affidavits;

(b) *in any country or place outside India* - before a diplomatic or consular officer, within the meaning of the Diplomatic and Consular Officers (Oaths and Fees) Act, 1948 (41 of 1948) in such country or place or before a notary of the country or place, recognised by the Central Government under section 14 of the Notaries Act, 1952 (53 of 1952), or before a Judge or Magistrate of the country or place.

(4) Alterations and interlineations shall, before an affidavit is sworn to or affirmed be authenticated by the initials of the person before whom the affidavit is sworn to.

127. Exhibits

Where there are exhibits to be filed in an opposition or any other proceedings, a copy or impression of each exhibit shall be supplied to the other party at his request and expense; if copies or impressions of the exhibits cannot conveniently be furnished, the originals shall be left with the Controller for inspection by the person interested by prior appointment. The exhibits in original if not already left with the Controller shall be produced at the hearing.

128. Directions not otherwise prescribed

(1) Where for the proper prosecution or completion of any proceedings under the Act or these rules, the Controller is of the opinion that it is necessary for a party to such proceedings to perform an act, file a document or produce evidence, for which provision has not been made in the Act or these rules, he may, by notice in writing, require such party to perform the act, file the document or produce the evidence specified in such notice.

(2) Where an applicant or a party to a proceeding desires to be heard or not heard, the Controller may, at any time, require him to submit his statement in writing giving such information as the Controller may deem necessary within the time specified by him.

[381][129. Exercise of discretionary power by the Controller

Before exercising any discretionary power under the Act or these rules which is likely to affect an applicant for a patent or a party to a proceeding adversely, the Controller shall give such applicant or party, a hearing, after giving him or them, ten days' notice of such hearing ordinarily.]

[382][129A. Adjournment of hearing

An applicant for patent or a party to a proceeding may make a request for adjournment of the hearing with reasonable cause along with the prescribed fee prescribed in First Schedule, at least three days before the date of hearing and the Controller, if he thinks fit to do so, and upon such terms as he may direct, may adjourn the hearing and intimate the parties accordingly:

Provided that no party shall be given more than two adjournments and each adjournment shall not be for more than thirty days.]

130. Application for review of decisions or setting aside of orders of the Controller

(1) An application to the Controller for the review of his decision under clause (f) of sub-section (1) of section 77 shall be made in [383][Form 24] within one month from the date of communication of such decision to the applicant or within such further period not exceeding one month thereafter as the Controller may on a request made in Form 4 allow and shall be accompanied by a statement setting forth the grounds on which the review is sought. Where the decision in question concerns any other person in addition to the applicant, the Controller shall forthwith transmit a copy of each of the application and the statement to the other person concerned.

(2) An application to the Controller for setting aside an order passed by him *ex parte* under clause (g) of sub-section (1) of section 77 shall be made in Form 24 within one month from the date of communication of such order to the applicant or within such further period not exceeding one month as the Controller may on a request made in Form 4 allow and shall be accompanied by a statement setting forth the grounds on which the application is based. Where the order concerns any other person in addition to the applicant, the Controller shall, forthwith transmit a copy each of the application and the statement to the other person concerned.

131. Form and manner in which statements required under section 146(2) to be furnished

(1) The statements shall be furnished by every patentee and every licensee under sub-section (2) of section 146 in [384][Form 27] which shall be duly verified by the patentee or the licensee or his authorised agent.
(2) The statements referred to in sub-rule (1) shall be furnished in respect of every calendar year within three months of the end of each year.
(3) The Controller may publish the information received by him under sub-section (1) or sub-section (2) of section 146 [385][***].

132. Form of application for the issue of a duplicate patent

An application for the issue of a duplicate patent under section 154 shall contain a statement setting out the circumstances in which the patent was lost or destroyed or cannot be produced together with the fee as specified therefor in the First Schedule.

[386][133. Supply of certified copies and certificates under sections 72 and 147

(1) Certified copies of any entry in the register, or certificates of, or extracts from patents, specifications and other public documents in the patent office, or from registers and other records including records in computer floppies, diskettes or any other electronic form kept there, may be furnished by the Controller on a request therefor made to him and on payment of the fee specified therefor in the First Schedule:
Provided that certified copies shall be issued in the order in which the request is filed.
(2) Notwithstanding anything contained in sub-rule (1), certified copies shall be furnished within a period of one week if such request is made along with the fee specified therefore in the First Schedule.]

134. Request for information under section 153

(1) A request for information in respect of the following matters relating to any patent or application for patent shall be admissible, namely: -
(a) as to when a complete specification following a provisional specification has been filed or an application for patent has been deemed to have been abandoned;
[387][(aa) as to when the information under section 8 has been filed;]
(b) as to when publication of application has been made under section 11A;
(c) as to when an application has been withdrawn under section 11B;
(d) as to when a request for examination has been made under section 11B;
(e) as to when the examination report has been issued under section 12;
[388][(f) as to when an application for patent has been refused;
(g) as to when a patent has been granted;]
(h) as to when a renewal fee has been paid;
(i) as to when a term of a patent has expired or shall expire;
(j) as to when an entry has been made in the register or application has been made for the making of such entry; or
[389][(k) as to when any application is made or action taken involving an entry in the register, publication in the [390][Official Journal] or otherwise, if the nature of the application or action is specified in the request.]
(2) Separate request shall be made in respect of each item of information required.
(3) The fee payable on a request to be made under section 153 shall be as set out in the First Schedule.

135. Agency

[391][(1) The authorisation of an agent for the purposes of the Act and these rules shall be filed in Form 26 or in the form of a power of attorney within a period of three months from the date of filing of such application or document, failing which no action shall be taken on such application or documents for further processing till such deficiency is removed.]
(2) Where any authorisation has been made under sub-rule (1), service upon the agent of any document relating to any proceeding or matter under the Act or these rules shall be deemed to be service upon the person so authorising him and all communications directed to be made to a person in respect of any proceeding or matter may be addressed to such agent, and all appearances before the Controller relating thereto may be made by or through such agent.
(3) Notwithstanding anything contained in sub-rule (1) and (2), the Controller may, if it is considered necessary, require the personal signature or presence of an applicant, opponent or party to such proceeding or matter.

136. Scale of costs

(1) In all proceedings before the Controller, he may, subject to rule 63, award costs as he considers reasonable, having regard to all the circumstances of the case:
Provided that the amount of costs awarded in respect of any matter set forth in the Fourth Schedule shall not exceed the amount specified therein.
(2) Notwithstanding anything contained in sub-rule (1), the Controller may, in his discretion award a compensatory cost in any proceeding before him which in his opinion is false or vexatious.

137. Powers of Controller generally

Any document for the amendment of which no special provision is made in the

Act may be amended and any irregularity in procedure which in the opinion of the Controller may be obviated without detriment to the interests of any person, may be corrected if the Controller thinks fit and upon such terms as he may direct.

[392][138. Power to extend time prescribed

(1) Except for the time prescribed in clause (i) of sub-rule (4) of rule 20, sub-rule (6) of rule 20, rule 21, sub-rules (1), (5) and (6) of rule 24B, sub-rules (10) and (11) of rule 24C, sub-rule (4) of rule 55, sub-rule (1A) of rule 80 and sub-rules (1) and (2) of rule 130, the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct.

(2) Any request for extension of time prescribed by these rules for the doing of any act or the taking of any proceeding thereunder shall be made before the expiry of such time prescribed in these rules.]

139. Hearing before the Controller to be in public in certain cases

Where the hearing before the Controller of any dispute between two or more parties relating to an application for a patent or to any matter in connection with a patent takes place after the date of the publication of the complete specification, the hearing of the dispute shall be in public unless the Controller, after consultation with the parties to the dispute who appear in person or are represented at the hearing, otherwise directs.

[1][THE FIRST SCHEDULE

(See Rule 7)

Table 1 – FEES PAYABLE

No. of entry	On what payable	Number of the relevant Form	For e-filing			For Physical filing		
			Natural person(s) and/or Startup	Small entity, alone or with natural person(s) and/or Startup	Others, alone or with natural person(s) and/or Startup and/ or small entity	Natural person(s) and/ or Startup	Small entity, alone or with natural persons(s) and/or Startup	Others, alone or with natural persons(s) and/or Startup and/ or small entity
			Rupees	**Rupees**	**Rupees**	**Rupees**	**Rupees**	**Rupees**
1.	On application for a patent under sections 7, 54 or 135 and rule 20(1) accompanied by provisional or complete specifications--- (i) for each sheet of specification in addition to 30, excluding sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9) (ii) for each claim in addition to 10; (iii) for each page of sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9).	1	1600 Multiple of 1600 in case of every multiple priority. (i) 160 (ii) 320 (iii)160 subject to a maximum of 24000	4000 Multiple of 4000 In case of Every multiple priority. (i) 400 (ii) 800 (iii) 400 Subject to a maximum of 60000	8000 Multiple of 8000 in case of every multiple priority (i) 800 (ii) 1600 (iii) 800 'subject to a Maximum of 120000	1750 Multiple of 1750 in case of every multiple priority (i) 180 (ii) 350 Not allowed	4400 Multiple of 4400 in Case of every multiple priority (i) 440 (ii) 880 Not allowed	8800 Multiple of 8800 in Case of every multiple priority (i) 880 (ii) 1750 Not allowed

2.	On filing complete specification after provisional up to 30 pages having up to 10 claims – (i) for each sheet of specification in addition to 30, excluding sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9); (ii) for each claim in additions to 10.	2	No fee (i) 160 (ii) 320	No fee (i) 400 (ii) 800	No fee (i) 800 (ii) 1600	No fee (i) 180 (ii) 350	No fee (i) 440 (ii) 880	No fee (i) 880 (ii) 1800
	(iii) for each page of sequence listing of nucleotides and/ or amine acid sequences under sub-rule (3) of rule (9).		(iii) 160 Subject to a Maximum of 24000	(iii) 400 Subject to a Maximum of 60000	(iii) 800 subject to a maximum of 120000	Not allowed	Not allowed	Not allowed
3.	On filing a statement and undertaking under section 8.	3	No fee	No fee	No fee	No fee	No fee	No fee
4	i) On request for extension of time under sections 53(2) and 142(4), rules 13(6), 80(1A) and 130(per month). ii) On request for extension of time under sub-rule (5) of rule 24B (per month). iii) On request for extension of time under sub-rule (11) of rule 24C (per month)	4 4 4	480 1000 2000	1200 2000 5000	2400 4000 10000	530 1100 2200	1300 2200 5500	2600 4400 11000
5.	On filing a declaration as to inventorship under sub-rule (6) of rule 13.	5	No fee	No fee	No fee	No fee	No fee	No fee
6.	On application for postdating	–	800	2000	4000	880	2200	4400
7.	On application for deletion of reference under section 19 (2)	–	800	2000	4000	880	2200	4400
8.	(i) On claim under section 20(1); (ii) On request for direction under section 20 (4) or 20 (5)	6 6	800 800	2000 2000	4000 4000	880 880	2200 2200	4400 4400

9.	(i) On notice of opposition to grant of patent under section 25(2); (ii) On filing representation opposing grant of patent under section 25(1)	7 7A	2400 No fee	6000 No fee	12000 No fee	2600 No fee	6600 No fee	13200 No fee
10.	On giving notice that hearing before Controller under rule 62(2).	–	1500	3800	7500	1700	4100	8300
11.	On application under sections 28(2), 28(3), 28(7)	8	800	2000	4000	880	2200	4400
12.	Request for publication under section 11A(2) and rule 24A.	9	2500	6250	12500	2750	6900	13750
13.	Application for withdrawing the application under section 11B(4), and rules 7(4A) and 26.	29	No fee	No fee	No fee	No fee	No fee	No fee
14.	On request for examination of application for patent- (i) under section 11B and rule 24(1); (ii) under rule 20(4)(ii)	18 	 4000 5600	 10000 14000	 20000 28000	 4400 6150	 11000 15400	 22000 30800
14.A	On request for expedited examination of application of patent under rule 24C	18A	8000	25000	60000	Not allowed	Not allowed	Not allowed
14B.	Conversion of the request for examination filed under rule 24B to request for expedited. Examination under rule 24C	18A	4000	15000	40000	Not allowed	Not allowed	Not allowed
15.	On application under section 44 for amendment of patent	10	2400	6000	12000	2650	6600	13200
16.	On application for directions under section 51(1) or 51(2)	11	2400	6000	12000	2650	6600	13200
17.	On request for grant of a patent under sections 26(1) and 52(2)	12	2400	6000	12000	2650	6600	13200
18.	On request for converting a patent of addition to an independent patent under section 55(1).	–	2400	6000	12000	2650	6600	13200

19.	For renewal of a patent under section 53--							
	(i) Before the expiration of the 2nd year from the date of patent in respect of 3rd year.	–	800	2000	4000	880	2200	4400
	(ii) Before the expiration of the 3rd year in respect of the 4th year;	–	800	2000	4000	880	2200	4400
	(iii) Before the expiration of the 4th year in respect of the 5th year;	–	800	2000	4000	880	2200	4400
	(iv) Before the expiration of the 5th year in respect of the 6th year.	–	800	2000	4000	880	2200	4400
	(v) Before the expiration of the 6th year in respect of the 7th year;	–	2400	6000	12000	2650	6600	13200
	(vi) Before the expiration of the 7th year in respect of the 8th year.	–	2400	6000	12000	2650	6600	13200
	(vii) Before the expiration of the 8th year in respect of the 9th year.	–	2400	6000	12000	2650	6600	13200
	(viii) Before the expiration of the 9th year in respect of the 10th year.	–	2400	6000	12000	2650	6600	13200
	(ix) Before the expiration of the 10th year in respect of the 11th year.	–	4800	12000	24000	5300	13200	26400
	(x) Before the expiration of the 11th year in respect of the 12th year.	–	4800	12000	24000	5300	13200	26400
	(xi) Before the expiration of the 12th year in respect of the 13th year.	–	4800	12000	24000	5300	13200	26400
	(xii) Before the expiration of the 13th year in respect of the 14th year.	–	4800	12000	24000	5300	13200	26400
	(xiii) Before the expiration of the 14th year in respect of the 15th year.	–	4800	12000	24000	5300	13200	26400
	(xiv) Before the expiration of the 15th year in respect of the 16th year.	–	8000	20000	40000	8800	22000	44000
	(xv) Before the expiration of the 16th year in respect of the 17th year.	–	8000	20000	40000	8800	22000	44000

	(xvi) Before the expiration of the 17th year in respect of the 18th year.	–	8000	20000	40000	8800	22000	44000
	(xvii) Before the expiration of the 18th year in respect of the 19th year.	–	8000	20000	40000	8800	22000	44000
	(xviii) Before the expiration of the 19th year in respect of the 20th year.	–	8000	20000	40000	8800	22000	44000
20.	On application for amendment of application for patent or complete specification or other related documents under section 57---	13						
	(i) Before grant of patent;		800	2000	4000	880	2200	4400
	(ii) After grant of patent;		1600	4000	8000	1750	4400	8800
	(iii) Where amendment is for changing name or address or nationality or address for service		320	800	1600	350	880	1750
21.	On notice of opposition to an application under sections 57(4), 61(1) and 87(2) or to surrender a patent under section 63(3) or to a request under section 78(5)	14	2400	6000	12000	2650	6600	13200
22.	On application for restoration of patent under section 60.	15	2400	6000	12000	2650	6600	13200
23.	Additional fee for restoration under section 61(3) and rule 86(1)	–	4800	12000	24000	5300	13200	26400
24.	On notice of offer to surrender a patent under section 63.	–	1000	2500	5000	1100	2750	5500
25.	On application for the entry in the register of patents of the name of a person entitled to a patent or as a share or as a mortgage or as licensee or as otherwise or for the entry in the register of patents of notification of a document under sections 69(1) or 69(2) and rules 90(1) or 90(2).	16	1600 (In respect of each patent)	4000 (In respect of each patent)	8000 (In respect of each patent)	1750 (In respect of each patent)	4400 (In respect of each patent)	8800 (In respect of each patent)

26.	On application for alteration of an entry in the register of patents or register of patent agents under rules 94(1) or rule 118(1)	–	320	800	1600	350	880	1750
27.	On request for entry of an additional address for service in the Register of Patents under rule 94(3)	–	800	2000	4000	880	2200	4400
28.	On application for compulsory license under sections 84(1) 91(1), 92(1) and 92A	17	2400	6000	12000	2650	6600	13200
29.	On application for revocation of a patent under section 85(1)	19	2400	6000	12000	2650	6600	13200
30.	On application for revision of terms and conditions of licence under section 88(4)	20	2400	6000	12000	2650	6600	13200
31.	On request for termination to compulsory licence under section 94.	21	2400	6000	12000	2650	6600	13200
32.	On application for registration as a patent agent under rule 109(1) or rule 112	22	3200	Not applicable	Not applicable	3500	Not applicable	Not applicable
33.	On request for appearing in the qualifying examination under rule 109(3)	–	1600	Not applicable	Not applicable	1750	Not applicable	Not applicable
34.	For continuance of the name of a person in the register of patent agents--- (i) for the 1st year to be paid along with registration; (ii) for every year excluding the 1st year to be paid on the 1st April in each year	 – –	 800 800	 Not applicable Not applicable	 Not applicable Not applicable	 800 800	 Not applicable Not applicable	 Not applicable Not applicable
35.	On application for duplicate certificate of patent agent under rule 111A.	–	1600	Not applicable	Not applicable	1750	Not applicable	Not applicable
36.	On application for restoration of the name of a person in the register of patent agents under rule 117(1)	23	1600 (Plus continuation fee under entry number 34)	Not applicable	Not applicable	1750 (Plus continuation fee under entry number 34)	Not applicable	Not applicable

37.	On a request for correction of clerical error under section 78(2)	–	800	2000	4000	880	2200	4400
38.	On application for review or setting aside the decision or order of the controller under section 77(1)(f) of 77(1)(g).	24	1600	4000	8000	1750	4400	8800
39.	On application for permission for applying patent outside India under section 39 and rule 71(1).	25	1600	4000	8000	1750	4400	8800
40.	On application for duplicate patent under section 154 and rule 132.	–	1600	4000	8000	1750	4400	8800
41.	(i) On request for certified copies under section 72 or for certificate under section 147 and rule 133(1). (ii) On request for certified copies under section 72 or for certificate under section 147 and rule 133(2).	– –	1000 (up to 30 Pages and, thereafter, 30 for each extra page) 2400 (up to 30 Pages and, thereafter, 30 for each extra page)	2500 (up to 30 Pages and, thereafter, 75 for each extra page) 6000 (up to 30 Pages and, thereafter, 30 for each extra page)	5000 (up to 30 Pages and, thereafter, 150 for each extra page) 12000 (up to 30 Pages and, thereafter, 30 for each extra page)	1100 (up to 30 Pages and, thereafter, 30 for each extra page) 3300 (up to 30 Pages and, thereafter, 30 for each extra page)	2750 (up to 30 Pages and, thereafter, 75 for each extra page) 6600 (up to 30 Pages and, thereafter, 30 for each extra page)	5500 (up to 30 Pages and, thereafter, 150 for each extra page) 13200 (up to 30 Pages and, thereafter, 30 for each extra page)
42.	For certifying office copies, printed each.	–	800	2000	4000	880	2200	4400
43.	On request for inspection of register under section 72, inspection under rule 27 or rule 74A.	–	320	800	1600	350	880	1750
44.	On request for information under section 153 and rule 134.	–	480	1200	2400	530	1300	2650
45.	On form of authorization of a patent agent.	26	No fee	No fee	No fee	No fee	No fee	No fee
46.	On petition not otherwise provided for.	–	1600	4000	8000	1750	4400	8800
47.	For supplying of photocopies of the documents, per page	–	10	10	10	10	10	10

48.	Transmittal fee for International application	–	3200	8000	16000	3500	8800	17600
[2a][48A.	Transmittal fee for International application (for ePCT filing).	–	No fee	No fee	No fee	Not applicable	Not applicable	Not applicable]
49.	For preparation of certified copy of priority document and for transmission of the same to the International Bureau of World Intellectual Property Organization	–	1000 (up to 30 Pages and, thereafter, 30 for each extra page)	2500 (up to 30 Pages and, thereafter, 75 for each extra page)	5000 (up to 30 Pages and, thereafter, 150 fore ach extra page)	1100 (up to 30 Pages and, thereafter, 30 for each extra page)	2750 (up to 30 Pages and, thereafter, 75 for each extra page)	5500 (up to 30 Pages and, thereafter, 150for each extra page)
[2a][49A.	For preparation of certified copy of priority document and e-transmission through WIPO DAS.	–	No fee	No fee	No fee	Not applicable	Not applicable	Not applicable]
50.	On statement regarding working of a potential invention on a commercial scale in India under section 146(2) and rule 131(1).	27	No fee	No fee	No fee	No fee	No fee	No fee
51.	To be submitted for claiming the status of a small entity or startup	28	No fee	No fee	No fee	No fee	No fee	No fee
52.	Request for adjournment of hearing udner rule 129A (for each adjournment)	–	1000	2500	5000	1100	2750	5500
53.	Miscellaneous form under rule 8(2), to be used when no other form is prescribed.	30	As applicable.					

[2][TABLE II – FEES REFUNDABLE

On what account fee refundable	Refund of fees
Refund of fees under sub-rule (4A) of rule 7,	90% of fee paid for request for examination or request for expedited examination".]

[3][THE SECOND SCHEDULE

(See Rule 8)

FORMS

LIST OF FORMS

Form No.	Section and rule	Title
1.	Sections 7, 54, and 135 and rule 20(1)	Application for grant of a patent
2.	Section 10; rule 13	Provisional/Complete Specification
3.	Section 8 and rule 12	Statement and undertaking
4.	Sections 53(2) and 142(4), rule, 13(6), 24B(4)(ii), 80(1A) and 130	Request for extension for time
5.	Section 10(6) and rule 13(6)	Declaration as to inventorship
6.	Sections 20(1), 20(4), 20(5) and rules 34(1), 35(1) or 36(1)	Claim or request regarding any change in applicant for patent
7.	Section 25(3) and rule 55A	Notice of opposition on grant of a patent
[4][7A.	Section 25(1) and rule 55(1)	For filing a representation opposing grant of a patent under sub-section (1) of section 25]
8.	Sections 28(2), 28(3) or 28(7) and rules 66, 67, 68	Request or claim regarding mention of inventor as such in a patent
9.	Section 11A(2) and rule 24A	Request for publication
10.	Section 44 and rule 75	Application for amendment of patent
11.	Sections 51(1), 51(2) and rules 76, 77	Application for direction of the controller
12.	Sections 26(1) & 52(2) and rules 63A and 79	Request for grant of patent
13.	Section 57 and rule 81(1)	Application for amendment of the application for patent/complete specification
14.	Sections 57(4), 61(1), 63(3), 78(5) and 87(2) and rules 81(3)(b), 85(1), 87(2), 98(1), 101 (3) or 124	Notice of opposition to amendment/ restoration/surrender of patent/grant of compulsory license or revision of terms thereof or to a correction of clerical errors
15.	Section 60 and rule 84.	Application for restoration of patents
16.	Sections 69(1) or 69(2) and rules 90(1) and 90(2)	Application for registration of title/interest in a patent or share in it or registration of any document purporting to affect proprietorship of the patent
17.	Sections 84(1), 91, 92 or 92A and rule 96	Application for compulsory license
18.	Section 11B and Rule 20(4)(ii) and 24B(1)(i)	Request for examination of application for patent
18A	Section 11B and Rule 24C	Request for expedited examination of application for patent

19.	Section 85(1) and rule 96	Application for revocation of a patent for non-working
20.	Section 88(4) and rule 100	Application for revision of terms and conditions of license
21.	Section 94, rule 102(1)	Request for termination of compulsory licence
22.	Rules 109(1) and 112	Application for registration of Patent Agent
23.	Section 130(2) and rule 117(1)	Application for the restoration of the name in the register of Patent Agents
24.	Sections 77(1)(f), 77(1)(g) and rules 130(1) and 130(2)	Application for review/setting aside controller's decision/order
25.	Section 39 and rule 71(1)	Request for permission for making patent application outside India
26.	Sections 127, 132 and rule 135	Form of authorization of a Patent Agent/or any person in a matter or proceeding under the Act
27.	Section 146(2) and rule 131(1)	Statement regarding the working of the Patented invention on commercial scale in India]
[5][28.	Rules 2(fa) and 7	To be submitted by a small entity with every document for which a fee has been specified]
[6][29.	Section 11B(4) and rules 7(4A), 24C(5) and 26	Request for withdrawal of patent application
30.	Rule 8(2)	Miscellaneous form, to be used when no other form is prescribed]

[7][FORM 1

THE PATENTS ACT 1970 (39 of 1970) and THE PATENTS RULES, 2003

APPLICATION FOR GRANT OF PATENT

(See section 7, 54 and 135 and sub-rule (1) of rule 20)

(FOR OFFICE USE ONLY)	
Application No.	
Amount of Fee paid	
CBR No.	
Signature:	

1. APPLICANT'S REFERNCE / IDENTIFICATION NO. (AS ALLOTTED BY OFFICE)

2. TYPE OF APPLICATION [Please tick (✓) at the appropriate category)

Ordinary ( )		Convention ( )		PCT – NP ( )	
Divisional ( )	Patent of Addition ( )	Divisional ( )	Patent of Addition ( )	Divisional ( )	Patent of Addition ( )

3A. APPLICANT(S)

Name in Full	Nationality	Country of Residence	Address of the Applicant	
			House No.	
			Street	
			City	
			State	
			Country	
			Pin code	

3B. CATEGORY OF APPLICANT [Please tick (✓) at the appropriate category]

Natural Person ( )	Other than Natural Person		
	Small Entity ( )	Startup ( )	Other ( )

4. INVENTOR(S) [Please tick (✓) at the appropriate category]

Are all the inventor(s) same as the applicant(s) named above?	Yes ( )	No ( )

If "No", furnish the details of the inventor (s)

Name in Full	Nationality	Country of Residence	Address of the Inventor	
			House No.	
			Street	
			City	

			State	
			Country	
			Pin code	

5. TITLE OF THE INVENTION

6. AUTHORISED REGISTERED PATENT AGENT(S)

IN/PA No.	
Name	
Mobile No.	

7. ADDRESS FOR SERVICE OF APPLICANT IN INDIA

Name	
Postal Address	
Telephone No.	
Mobile No.	
Fax No.	
E-mail ID	

8. IN CASE OF APPLICATION CLAIMING PRIORITY OF APPLICATION FILED IN CONVENTION COUNTRY, PARTICULARS OF CONVENTION APPLICATION

Country	Application Number	Filing date	Name of the applicant	Title of the invention	IPC (as classified in the convention country)

9. IN CASE OF PCT NATIONAL PHASE APPLICATION, PARTICULARS OF INTERNATIONAL APPLICATION FILED UNDER PATENT CO-OPERATION TREATY (PCT)

International application number	International filing date

10. IN CASE OF DIVISIONAL APPLICATION FILED UNDER SECTION 16, PARTICULARS OF ORIGINAL (FIRST) APPLICATION

Original (first) application No.	Date of filing original (first) application

11. IN CASE OF PATENT OF ADDITION FILED UNDER SECTION 54, PARTICULARS OF MAIN APPLICTION OR PATENT

Main application/patent No.	Date of filing of main application

12. DECLARATIONS

(i) Declaration by the inventor(s)

(**In case the applicant is an assigner**: the inventor(s) may sign herein or the applicant may upload the assignment or enclose the assignment with this application for patent or send the assignment by post/electronic transmission duly authenticated within the prescribed period)

I/We, the above named inventor(s) is/are the true & first inventor(s) for this Invention and declare that the applicant(s) herein is/are my/our assignee or legal representative.

(a) Date
(b) Signature (s)
(c) Name (s)

(ii) Declaration by the applicant(s) in the convention country

(**In case the applicant in India is different than the applicant in the convention country:** the applicant in the convention country may sign herein below or applicant in India may upload the assignment from the applicant in the convention country or enclose the said assignment with this application for patent or send the assignment by post/electronic transmission duly authenticated within the prescribed period)

I/We, the applicant(s) in the convention country declare that the applicant(s) herein is/are my/our assignee or legal representative.

(a) Date
(b) Signature(s)
(c) Name(s) of the signatory

(iii) Declaration by the applicant(s)

I/We the applicant(s) hereby declare(s) that:-

- I am/We are in possession of the above-mentioned invention.
- The provisional/complete specification relating to the invention is filed with this application
- The invention as disclosed in the specification uses the biological material from India and the necessary permission from the competent authority shall be submitted by me/us before the grant of patent to me/us.
- There is no lawful ground of objection(s) to the grant of the Patent to me/us.
- I am/we are the true & first inventor(s).
- I am/we are the assignee or legal representative of true & first inventor(s).
- The application or each of the application, particulars of which are given in Paragraph-8, was the first application in convention country/countries in respect of my/our inventions(s).
- I/We claim the priority from the above mentioned application(s) filed in convention country/countries and state that no application for protection in respect of the invention had been made in a convention country before that date by me/us or by an y person from which I/We derive the title.
- My/our application in India is based on international application under patent Cooperation Treaty (PCT) as mentioned in paragraph-9.
- The application is divided out of my / our application particulars of which is given in paragraph-10 and pray that this application may be treated as deemed to have been filed on DD/MM/YYYY under section 16 of the Act.
- The said invention is an improvement in or modification of the invention particulars of which are given in paragraph-11.

13. FOLLOWING ARE THE ATTACHMENTS WITH THE APPLICATION

(a) Form 2

Item	Details	Fee	Remarks
Complete/ provisional			
Specification)#	No of pages		
No. of Claim(s)	No. of claims and No. of pages		
Abstract	No. of pages		
No. of Drawing(s)	No. of drawings and No. of pages		
# In case of a complete specification, if the applicant desires to adopt the drawings filed with his provisional specification as the drawings or part of the drawings for the complete specification under rule 13(4), the number of such pages filed with the provisional specification are required to be mentioned here.			

(b) Complete specification (in conformation with the international application)/ as amended before the International Preliminary Examination Authority (IPEA), as applicable (2 copies).
(c) Sequence listing in electronic form
(d) Drawings (in conformation with the international application)/as amended before the International Preliminary Examination Authority (IPEA), as applicable (2 copies).
(e) Priority document(s) or a request to retrieve the priority document(s) from DAS (Digital Access Service(if the applicant had already requested the office of first filing to make the priority document(s) available to DAS.
(f) Translation of priority document/Specification/International Search Report/ International Preliminary Report on Patentability.
(g) Statement and Undertaking of Form 3
(h) Declaration of Inventionrship on Form 5
(i) Power of Authority
(j) _____

Total fee `_____ in Cash/Banker's Cheque/Bank Draft bearing No_____ Date.....on _____Bank

I/We hereby declare that to the best of my/our knowledge, information and believe the facts and matter stated herein are correct and I/We request that a patent may be granted to me/us for the said invention.

Dated this_____ day of_____ 20_____
Signature
Name:

To,
The Controller of Patents
The Patent Office,
At _____

Note:-
- Repeat boxes in case of more than one entry.
- To be signed by the applicant(s) or by authorized registered patent agent otherwise where mentioned.
- Tick (✓) cross (×) whichever is applicable/not applicable in declaration in paragraph-12.
- Name of the inventor and applicant should be given in full, family name in the beginning.
- Strike out the portion which is/are not applicable.
- For fee; See First Schedule"]

FORM 2

THE PATENT ACT 1970

(39 OF 1970) & THE PATENTS RULES, 2003

PROVISIONAL/COMPLETE SPECIFICATION

[See section 10 and rule 13]

1. TITLE OF THE INVENTION
2. APPLICANT(S)
   (a) Name:
   (b) Nationality:
   (c) Address:
3. PREAMBLE TO THE DESCRIPTION

Provisional	Complete
The following specification describes the invention.	The following specification particularly describes the invention and the manner in which it is to be performed

4. DESCRIPTION (Description shall start from next page)
5. CLAIMS (not applicable for provisional specification. Claims should start with the preamble --- "I/we claim" on separate page)
6. DATE AND SIGNATURE (to be given at the end of last page of specification)
7. ABSTRACT OF THE INVENTION (to be given along with complete specification on separate page)

Note:-
- Repeat boxes in case of more than one entry.
- To be signed by the applicant(s) or by authorized registered patent agent.
- Name of the applicant should be given in full, family name in the beginning.
- Complete address of the applicant should be given stating the postal index No./ code, state and country.
- Strike out the column which is/are not applicable.

[8][FORM 3

THE PATENTS ACT, 1970
(39 of 1970)
AND
THE PATENTS RULES, 2003

STATEMENT AND UNDERTAKING UNDER SECTION 8

(See section 8; Rule 12)

1. Name of the applicant(s)	I/We _____ _____ _____ _____ _____ Hereby declare.				
2. Name address and nationality of the joint applicant.	(i) that I/We have not made any application for the same/ substantially the same invention outside India. Or (ii) that I/We who have made this applicant No_____ dated _____ alone/jointly with_____made for the same/ substantially same invention, application(s) for patent in the other countries, the particulars of which are given below:				
Name of the country	Date of application	Application No.	Status of the application	Date of publication	Date of grant
3. Name and address of the assignee	(iii) that the rights in the application(s) has/have been assigned to_____ _____ _____ that I/We undertake that upto the date of grant of the patent by the Controller, I/We would keep him informed in writing the details regarding corresponding applications for patents filed outside India within six months from the date of filing of such application. Dated this_____ day of _____20_____				
4. To be signed by the applicant or his authorized registered patent agent.	Signature_____				
5. Name of the natural person who has signed.	(_____)				
	To The Controller of Patents, The Patent Office, At _____				
Note:- Strike out whichever is not applicable.]					

[9][FORM 4

THE PATENTS ACT, 1970
(39 of 1970)
AND
THE PATENTS RULES, 2003

REQUEST FOR EXTENSION OF TIME

[See section 53(2), and 142(4); rules 13(6), 24B(6), 24C(11) and 80(1A), 138]

1. Name of the applicant	I/We_____ _____ _____ hereby request for extension of time for_____ months(s) under section/rule_____ is connection with my/our/ applications/Patent No. _____ The reasons for making the request are as follows:- _____ _____ Dated this_____ day of_____20___
2. To be signed by the applicant or his authorized registered patent agent	Signature (_____)
3. Name of the natural person who has signed	
	To The Controller of Patents, The Patent Office, At _____
Note:- Fore fee; See First Schedule]	

FORM 5

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

DECLARATION AS TO INVENTORSHIP

[See section 10(6) and, rule 13(6)]

1. Name of applicant(s). _____
_____
hereby declare that the true and first inventor(s) of the invention disclosed in the complete specification filed in pursuance of my/our application numbered _____dated _____ is/are

2. Inventor(s)
   (a) Name _____
   (b) Nationality _____
   (c) Address _____
   _____

   Dated this_____ day of_____20_____

   Signature
   Name of the signatory _____
3. Declaration to be given when the application in India is filed by the applicant(s) in the convention country: -
   We the applicant(s) in the convention country hereby declare that our right to apply for a patent in India is by way or assignment from the true and first inventor(s).

   Dated this_____ day of_____ 20_____

   Signature
   Name of the signatory _____
4. STATEMENT (to be signed by the additional inventor(s) not mentioned in the application form)
   I/We assent to the invention referred to in the above declaration, being included in the complete specification filed in pursuance of the stated application.

   Dated this_____ day _____of 20_____

   Signature of the additional inventor(s)
   Name:

To,

[10][The Controller of Patents],
The Patent Office,
At _____

Note:-

- Repeat boxes in case of more than one entry.
- To be signed by the applicant(s) or by authorized registered patent agent otherwise where mentioned.
- Name of the inventor and applicant should be given in full, family name in the beginning.
- Complete address of the inventor should be given stating the postal index No./ code, state and country.
- Strike out the column which is/are not applicable.

FORM 6

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

CLAIM OR REQUEST REGARDING ANY CHANGE IN APPLICANT FOR PATENT

[Refer sections 20 (1), 20 (4) & 20 (5) and, rules 34 (1), 35 (1) & 36 (1)]

Repeat the columns (a) to (c) if there are more than one Applicant. Insert the name in full. The family or principal name in the beginning if the applicant is a natural person.

I/We _____
(a) _____
(b) _____
(c) _____

Complete address including postal index number/code and state and/or country.
_____
_____
_____

Nationality. _____

Hereby request that the application for patent No_____ dated made by _____ may proceed in my/our name and further request that direction of the Controller, if necessary be made in that effect
Reasons for making the above request are as follows :-
_____
_____
_____

(Original and certified copies of the documents shall accompany the claim or request. Consent by the legal representative of the deceased joint applicant shall be filed whenever required.)
I furnish the following document(s) in support of my above request –
(a) _____
(b) _____
(c) _____

My/our address for service in India is (complete address including postal index number/ code and state along with Telephone and Telefacsimile number(s).)
_____
_____

Dated this_____ day of_____ 20_____

Signature
(_____)
(to be signed by the applicant(s) or authorized registered patent agent.)

(_____)
(name of the natural person who has to sign)

To,
The Controller of Patents,
The Patent Office,
At _____

N.B.: This form is not applicable for mere change of name.

Note:-
(a) Strike out whichever is not applicable.
(b) For fee: See First Schedule.

FORM 7

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

NOTICE OF OPPOSITION
([11][See section 25(2)] and rule 55A)

I/We (state names, address and nationality) _____
_____
Hereby give notice of opposition to patent No. _____
granted on application No._____ made by
_____
_____
on the grounds (state the grounds taken, one after another)
_____
_____
_____
_____
My/our address for service in India is (complete address including postal index number code and state along with telephone and fax number)
_____
_____
_____

Signature_____
(To be signed by the opponent or by the authorised registered patent agent)

To,
The Controller of Patents,
The Patent Office,
At _____

Note: For fee: See First Schedule

_____

[12][FORM 7A

THE PATENTS ACT, 1970(39 OF 1970)
AND
THE PATENTS RULES, 2003

REPRESENTATION FOR OPPOSITION TO GRANT OF PATENT
[See Rule 55]

1. State names, address and nationality.
I/ We, _____
_____
Hereby give representation by way of opposition to the grant of patent in respect of application No._____made by_____ and published on
_____
2. State the grounds taken one after on the grounds_____
another. _____
_____
3. Complete address including postal _____
Index number/code and state along with telephone and fax number. _____
_____
My / Our address for service in India is _____
4. To be signed by the opponent or by his/her authorized registered patent agent.

Signature _____
5. Name and designation of the natural person who has signed.
(_____)

To
The Controller of Patents,
The Patent Office,
At_____]

FORM 8

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

REQUEST OR CLAIM REGARDING MENTION OF INVENTOR AS SUCH IN A PATENT

[See section 28(2), 28(3) & 28(7) and rules 66, 67 & 68]

I/We (state name, address and nationality of the person making this application)
_____
_____
_____
hereby state / claim that the following person(s) be mentioned as inventor(s) in the patent application No._____ dated _____
made by _____
_____
or hereby declare that (insert the name of the person mentioned as inventor)
_____
_____
ought not to have mentioned as inventor in the application for Patent No._____
dated _____ made by _____
_____
and I/We hereby apply for a certificate to that effect.

A statement setting out the circumstances under which this application is made is attached together with the copy / copies thereof as required under the Rules.

My / Our address for service in India is (complete address including postal index number/code and state along with telephone and fax number)
_____
_____
_____

Dated this _____ day of _____ 20_____

Signature _____
(to be signed by the applicant or his authorized registered patent agent)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At_____

Note: For fee, see First Schedule

FORM 9

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

REQUEST FOR PUBLICATION

[See section 11A(2) and rule 24A]

I/We (state name, address and nationality of applicant(s)) _____
_____
_____
hereby request for early publication of my/our[13] [Patent application No].____
dated _____ under section 11A(2) of the act.

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant or his authorized registered patent agent)
(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note: For fee, see First Schedule

FORM 10

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

APPLICATION FOR AMENDMENT OF PATENT

(See section 44 and rule75)

I/We (Repeat the columns (a) to (c) if, there are more than one applicant) _____

(a) (insert the name in full, Family or, principal name in the beginning if the applicant is a natural person)
_____
_____

(b) (insert the complete address including postal index number / code and state and/or country)
_____

_____
_____

(c) (insert the nationality) _____

hereby request that Patent No. _____ dated _____ granted to _____
_____
may be amended by substituting my/our name for the name grantee and in support to my/our request. I / We furnish the following documents:-
_____
_____
_____

My/Our address for service in India is (complete address including postal index number code and state along with telephone and fax number)
_____
_____
_____

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant(s) or his authorized registered patent agent)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note: For fee, see First Schedule

FORM 11

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

APPLICATION FOR DIRECTION OF THE CONTROLLER

[See section 51(1) & 51(2) and rules 76 & 77]

I / We, (state the name in full, address and nationality) _____
_____
_____
_____

hereby apply for the following direction in respect of patent no.

dated _____ grant to _____
_____

The reasons for making this application are as follows:
_____
_____
_____

My/Our address for service in India is (complete address including postal index number code and state along with telephone and fax number)
_____
_____
_____

Dated this _____ day _____ of 20 _____

Signature_____
(to be signed by the applicant(s) or his authorized registered patent agent)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note: For fee, see First Schedule

FORM 12

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

REQUEST FOR GRANT OF PATENT UNDER SECTION 26(1) & 52(2)

[See section 26(1) & 52(2) and rules 63A & 79]

I/We (Repeat the columns (a) to (c) if, there are more than one applicant) _____

(a) (insert the name in full, Family or, principal name in the beginning if the applicant is a natural person)
_____
_____
_____
_____

(b) (insert the complete address including postal index number / code and state and/or country)
_____
_____
_____

(c) (insert the nationality) _____

hereby declare :

(i) that I/we made opposition under section 25(3) before the controller or a petition under section 64 of the Act before the Appellate board or High Court of (name of the high court)
_____
and the details of the patent and the opposition for the petition are given below:-
Patent No._____ dated _____ Grantee / Patentee _____
_____
Opposition _____
Notice dated _____ or Petition No. _____ dated _____

(ii) that I/we have claimed to be the true and first inventor(s)/assignee(s)/legal representative(s) of (name, address and nationality of the true and first inventor) _____
_____
_____
the true and first inventor of the invention for which the said patent was granted.

(iii) that by an order in the said opposition or petition the patent was revoked/the complete specification of the patent was directed to be amended by exclusion of claims thereof.

(iv) that the Controller or Appellate Board or Court ordered to grant to me a patent in lieu of the said patent/part of the invention excluded by the amendment.

(v) that I/We submit a statement and certified copy of the order of the Controller or Appellate Board or Court in support of my application and request that a patent be granted to me in accordance with the order of the Appellate Board or Court.

My/Our address for service in India is (complete address including postal index number code and state along with telephone and fax number)
_____
_____
_____
_____

Dated this _____ day of _____ 20 _____

Signature_____)
(To be signed by the applicant(s) or his authorized registered patent agent)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
(a) Strike out whichever is not applicable
(b) For fee: see First Schedule

[14][FORM 13

THE PATENTS ACT, 1970
(39 of 1970)
AND
THE PATENTS RULES, 2003

APPLICATION FOR AMENDMENT OF THE APPLICATION FOR PATENT

COMPLETE SPECIFICATION/ANY DOCUMENT RELATED THERETO

[See section 57, sub-rule (1) of rule 81]

1. Name of the applicant(s).
I/We _____
_____
_____
Request leave to amend the application/any document related thereto/complete specification with respect to application for patent No_____ dated_____ as highlighted in the copy hereto annexed.
My/Our reason for making this request are as follows:-
_____
_____
_____
I/We declare that no action for infringement or for the revocation of the patent in question is pending before Appellate Bound or a Court.
I/We declare that the facts and matters stated herein are true to the best of my/our knowledge information and belief.
2. To be signed by the applicant(s) or patentee(s) or by his authorized registered patent agent
Dated this_____ day of_____20_____

Signature_____
3. Name of the natural person who has signed
(_____)

To
The Controller of Patents,
The Patent Office,
At _____

Note:- For fee: See First Schedule] :

FORM 14

THE PATENTS ACT, 1970
(39 of 1970)&
THE PATENT RULES, 2003

NOTICE OF OPPOSITION TO AMENDMENT/RESTORATION/ SURRENDER OF PATENT/GRANT OF COMPULSORY LICENCE OR REVISION OF TERMS THEREOF OR TO CORRECTION OF CLERICAL ERRORS

[Refer sections 57(4), 61(1), 63(3), 78(5) & 87(2) and rules 81(3)(b), 85(1), 87(2), 98(1), 101(3) & 124]

I/We (State the name, address and nationality.) _____
_____
_____
_____

hereby give notice of opposition:—
to the amendment of the application/specification with respect to application for Patent No._____ dated _____
or
To the application for restoration of Patent No._____ dated _____
or
To the offer to surrender the Patent No. _____ dated _____
or
For the grant of compulsory/licence, or revocation of Patent No. _____ dated _____
or
for the revision of the terms and conditions of licence in respect of Patent No._____ dated _____
or
For correction of a clerical error in Patent No. _____ dated _____ / Specification No. _____ dated _____ in respect of Patent No. _____ dated _____
or
Patent application No. _____ dated _____

The grounds in which the opposition is made are as follows:-
_____
_____
_____

My/Our address for service in India is (complete address including postal index number/ code and state along with telephone and fax number)
_____
_____

_____

Dated this _____ day of _____ 20_____

Signature_____
(to be signed by the opponent or his authorized registered patent agent)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
(a) Strike out whichever is not applicable
(b) For fee: see First Schedule

FORM 15

THE PATENTS ACT, 1970
(39 of 1970)&
THE PATENTS RULES, 2003

APPLICATION FOR THE RESTORATION OF PATENT

[See section 60 and rule 84]

I/We (insert the name, address, nationality of the applicant(s)
_____
_____
_____
_____

hereby apply for an order of the Controller for the restoration of Patent No _____ dated _____ granted to _____
_____

The circumstances which led to the failure to pay the renewal fee for the year _____ On or before _____ are as follows :
_____

I /We declare that I/We have not assigned the patent to any other person(s) and that the facts and matters stated herein are true to the best of my/our knowledge information and belief.

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant(s) or by his authorized registered patent agent)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note: For fee: see First Schedule

FORM 16

THE PATENTS ACT, 1970
39 of 1970 &
THE PATENTS RULES, 2003

APPLICATION FOR REGISTRATION OF TITLE/INTEREST IN A PATENT OR SHARE IN IT OR REGISTRATION OF ANY DOCUMENT PURPORTING TO AFFECT PROPRIETORSHIP OF THE PATENT
[See sections 69 (1) & 69 (2) and rules 90 (1) & 90 (2)]

I/We (Insert the name, address and nationality of the applicant(s))
_____
_____
_____
_____
hereby apply that my/our name(s) may be registered in the register of patent as a person entitled to the patent / a share in the patent / an interest in the patent details of which are specified below:
Patent No. _____ dated _____ Grantee _____
_____
Patentee _____ and
in proof thereof we transmit the accompanying. (a description of the nature of the document, giving the date and the names, address and nationality of the parties thereto)
_____
_____
with a certified copy thereof.
or
Transmit herewith an attested copy of (a description of the nature of the document, giving the date and the names, address and nationality of the parties thereto)
_____
_____
in respect of Patent No(s) _____ dated _____ granted is
_____
as well as the original document for verification and I/We hereby apply that a notification thereof may be entered in the register of patents.
My/Our address for service in India is (complete address including postal index number code and state along with telephone and fax number)

_____
_____
_____
Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant or his authorized registered patent agent)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
(a) Strike out whichever is not applicable
(b) For fee: see First Schedule

FORM 17

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

APPLICATION FOR COMPULSORY LICENCE
[See sections 84 (1), 91, 92(1) or 92A and rule 96]

I/We (Name, address and nationality of the applicant(s))
_____
_____
_____
_____

hereby apply for the grant of a compulsory license under Patent No. _____
dated_____ granted to _____
for which the patentee is _____
on the following grounds namely :-
_____
_____
_____
_____

I/We declare that the facts and matters stated herein are true to the best of my/our knowledge information and belief.
The details of documentary evidence in support of my/our interest and the grounds stated above are given below (certified copies of the documents are to be enclosed in

duplicate)

(a) _____

(b) _____

(c) _____

(d) _____

My/Our address for service in India is (complete address including postal index number/ code and state along with telephone and fax number)

_____

_____

_____

Dated this _____ day of _____ 20 _____

Signature_____

(to be signed by the applicant(s) or by his authorized registered patent agent)

(_____)

(name of the natural person who has signed)

To,

The Controller of Patents,
The Patent Office,
At _____

Note: For fee: see First Schedule

FORM 18

THE PATENTS ACT 1970
(39 of 970) &
THE PATENTS RULES, 2003

REQUEST/EXPRESS RFQUEST FOR EXAMINATION OF APPLICATION FOR PATENT

[See section 11B and rules 20 (4)(ii) & 24B(1)(i)]

(FOR OFFICE USE ONLY)

RQ. No: _____

Filing Date: _____

Amount of Fee Paid: _____

CBR No: _____

Signature: _____

1. APPLICANT(S)/OTHER INTERESTED PERSON

(a) Name: _____

_____

(b) Nationality: _____

(c) Address: _____

_____

_____

[15][(d) Date of publication of the application under section 11A: _____]

2. STATEMENT IN CASE OF REQUEST FOR EXAMINATION MADE BY THE APPLICANT(S)

I/we hereby request that my/our application for Patent No. _____ filed on _____ for the invention titled _____ _____ shall be examined under section 12 and 13 of the Act.

or

I / We hereby make an express request that my / our application for Patent No. _____ filed on _____ based on Patent Cooperation Treaty (PCT) application No _____ dated _____ made in country _____ shall be examined under section 12 and 13 of the Act, immediately without waiting for the expiry of 31 months as specified in rule 20 (4)(ii).

3. STATEMENT IN CASE OF REQUEST FOR EXAMINATION MADE BY ANY OTHER INTERESTED PERSON

I/we the interested person request for the examination of the application No. _____ dated _____ filed by the applicant _____titled _____ _____ under section 12 and 13 of the Act.

As an evidence of my/our interest in the application for patent following documents are submitted :-

(a) _____

(b) _____

(c) _____

4. ADDRESS FOR SERVICE: -

_____

_____

_____

Dated this _____ day of _____ 20 _____

Signature_____

(To be signed by the applicant(s) or by his authorized registered patent agent.)

Name of the signatory_____

To,

[1216][The Controller of Patents],
The Patent Office,
At _____

Note:
Strike out the column which is / are not applicable

For fee: See First Schedule

[17][FORM 18A

THE PATENTS ACT,1970
AND THE PATENT RULES,2003

REQUEST FOR EXPEDITED EXAMINATION OF APPLICATION FOR PATENT

[See section 11B and Rule 24C]

(FOR OFFICE USE ONLY)

RQ. No: _____

Filing Date: _____

Amount of Fee Paid: _____

CBR No: _____

Signature: _____

1. APPLICANT(s)
   (A) NAME
   (B) NATIONALITY
   (C) ADDRESS
2. I/We _____hereby request that my/our application for patent no._____ filed on_____ for_____ the_____ invention titled_____ shall be examined under sections 12 and 13 of the Act.

   or

   I/We _____ hereby request that my/our application for patent no. _____filed on _____for _____ the _____ invention titled _____ based on Patent Cooperation Treaty (PCT) application no. _____ dated _____ made in country _____ shall be examined under section 12 and 13 of the Act, immediately without waiting for the expiry of 31 months as specified in rule 20(4) (ii)

   or

   I/We hereby request that my/our request for examination bearing no. _____for application for patent no._____ filed on_____ for _____the _____invention titled _____ may be converted to a request for expedited examination of patent application under rule 24C and the application shall be examined under sections 12 and 13 of the Act.

[17a][3. The applicant(s) to indicate (by ticking the appropriate box) any of the grounds applicable for request for expedited examination:

- that India has been indicated as the competent International Searching Authority or elected as an
- International Preliminary Examining Authority in the corresponding international application; or
- that the applicant is a startup; or
- that the applicant is a small entity; or
- that the applicant is a natural person or in the case of joint applicants, all the applicants are natural persons, then applicant or at least one of the applicants is a female; or
- that the applicant is a department of the Government; or
- that the applicant is an institution established by a Central, Provincial or State Act, which is owned or controlled by the Government; or
- that the applicant is a Government company as defined in clause (45) of section 2 of the Companies Act, 2013 (18 of 2013); or
- that the applicant is an institution wholly or substantially financed by the Government; or
- that the application pertains to a sector which has been notified by the Central Government, on the basis of a request from the head of department of the Central Government; or
- that the applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office.

4. Documents to be mandatorily submitted as evidence of eligibility for availing expedited examination on the grounds:

a. that India has been indicated as the competent International Searching Authority in the corresponding international application:

- Relevant ISA number issued by ISA, India.

that India has been elected as an International Preliminary Examining Authority in the corresponding international application:

- Relevant IPEA number issued by IPEA, India.

b. that the applicant is a startup:

A. For an Indian applicant: The certificate of recognition as a startup from Department for Promotion of Industry and Internal Trade.

B. In case of a foreign entity: Any document as evidence of eligibility

c. that the applicant is a small entity:

A. For an Indian applicant: Evidence of registration under the Micro, Small and Medium Enterprises Act, 2006 (27 of 2006).

B. In case of a foreign entity: Any document as evidence of eligibility

d. that the applicant is a natural person or in the case of joint applicants, all the applicants are natural persons, then applicant or at least one of the applicants is a female:

A. In case of Indian applicant: Photo identity card of female applicant issued by competent authority as evidence of eligibility.

B. In case of a foreign applicant: Photo identity card of female applicant issued by competent authority as evidence of eligibility

e. Where the applicant is a department of the Government:

A. In case of Indian applicant: Any document as evidence of eligibility.

B. In case of a foreign applicant: Any document as evidence of eligibility.

f. that the applicant is an institution established by a Central, Provincial or State Act, which is owned or controlled by the Government:

A. In case of Indian applicant: Any document as evidence of eligibility.

B. In case of a foreign applicant: Any document as evidence of eligibility.

g. that the applicant is a Government company as defined in clause (45) of section 2 of the Companies Act, 2013 (18 of 2013):

A. In case of Indian applicant: Any document as evidence of eligibility.

B. In case of a foreign applicant: Any document as evidence of eligibility.

h. that the applicant is an institution wholly or substantially financed by the Government:

A. In case of Indian applicant: Any document as evidence of eligibility.

B. In case of a foreign applicant: Any document as evidence of eligibility.

i. that the application pertains to a sector which has been notified by the Central Government, on the basis of a request from the head of a department of the Central Government:

Notification from the Central Government and documents as maybe required by the Controller.

j. that the applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office:

Declarations and documents as maybe required by the Controller.]

ADDRESS FOR SERVICE INDIA:

_____

_____

_____

Dated this day of 20
Signature
Name of the signatory

To

The Controller of Patent
The Patent Office,
At _____-

Note:
To be signed by the applicant(s) or by his/their authorized registered patent agent
"Strike out the column(s) which is/are not applicable",

For fee: See First Schedule.]

FORM 19

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

APPLICATION FOR REVOCATION OF A PATENT FOR NON-WORKING

[See section 85(1) and rule 96]

I/We (Name, address and nationality of the applicant(s)). _____
_____
_____
_____
hereby apply for revocation of Patent No. _____ dated _____ granted to _____ for which the patentee / applicant for patent is _____
_____
_____
for the following reasons, namely:
(state the nature of the applicant's interest, the facts on which he relies and the grounds on which the application is made)
_____
_____
The details of documentary evidence in support of my/our interest and the reasons stated above are given below: (certified copies of all the documents are to be enclosed in duplicate)

(a) _____
(b) _____
(c) _____

I/We declare that the facts and matters stated herein are true to the best of my / our knowledge, information and belief.
My / Our address for service in India is: (complete address including postal index number/ code and state along with telephone and fax number(s))
_____
_____
_____

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant(s) or his authorized registered patent agent)
(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
(a) For fee: see First Schedule
(b) Strike out whichever is not applicable

FORM 20

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

APPLICATION FOR REVISION OF TERMS AND CONDITIONS OF LICENCE

[See sections 88(4) and rule 100]

I/We (Name, address and nationality of the applicant(s)
_____
_____
_____
hereby declare:-

(i) that Patent No._____ dated _____ was granted to _____
_____
for which the patentee is _____
_____

(ii) that I/We am/are holding license under the patent, granted by the Controller by an order dated _____.

(iii) that the terms and conditions settled by the Controller have proved to be more onerous than originally expected and we are unable to work the invention.

(iv) that the circumstances in which this application is made are set forth in the accompanying statement in duplicate.

I/We request the Controller to revise the terms and conditions of the licence.

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant or by his authorized registered patent agent)

(_____)

(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
(a) For fee: see First Schedule
(b) Strike out whichever is not applicable

FORM 21

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

REQUEST FOR TERMINATION OF COMPULSORY LICENCE

[See section 94 and rule 102 (1)]

I/We (Name, address and nationality of the applicant(s) _____
_____
_____
_____
_____
hereby apply for the termination of the compulsory licence granted to _____
_____
by the order of the Controller dated _____ under [18][Patent No.] _____ dated _____ granted to _____
_____ for which the patentee _____
_____
I/we declare that I am /We are patentee for the above mentioned patent.
I/we declare that I/we derive title / interest in the patent.
I/We make the above mentioned request for termination on the following grounds, namely :
_____
_____
_____

I/We declare that the facts and matters stated herein are true to the best of my/our knowledge, information and belief.
The details of documentary evidence in support of my/our interest and the grounds stated above are given below (certified copies of the documents are to be enclosed in duplicate):-

(a) _____
(b) _____

_____

(c) _____

My/Our address for service in India is (complete address including postal code and state along with telephone and fax number)

_____
_____
_____
_____

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant or his authorized registered patent agent)

(_____)
(name of the natural person who has signed)

To,

The Controller of Patents,
The Patent Office,
At _____

Note:

(a) For fee: see First Schedule
(b) Strike out whichever is not applicable

FORM 22

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

APPLICATION FOR REGISTRATION OF PATENT AGENT

[See rules 109(1) and 112]

I beg to apply for registration as a patent agent under the Patents Act, 1970.
A certificate of character (Certificate testifying to the character of the applicant should be from a person not related to and being a Gazetted Officer or any other person whom the Controller thinks fit.) from _____
_____
_____
is enclosed herewith.
I hereby declare that I am not subject to any of the disqualifications specified in rule 114 of the Patents Rules 2003 and that the information given below is true to the best of my knowledge and belief.

1. Name (Family of principal name in the beginning) _____
2. Address/place of residence: _____
   _____
   _____
3. Principal place of business: _____
   _____
   _____
4. Address of the branch office, if any _____
   _____
   _____
   _____
5. Father's Name _____
6. Nationality _____
7. Date and place of birth _____
   _____
8. Occupation _____
9. Particulars of qualification for registration a patent agent (either original certificates and other documents or copies thereof duly attested by the Gazetted Officer or any other person whom the Controller thinks fit must be sent with the application)
   (a) _____
   (b) _____
   (c) _____

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
(a) For fee: see First Schedule
(b) Attach two recent passport size photographs
(c) Provide specimen signature in separate sheet

FORM 23

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

APPLICATION FOR THE RESTORATION OF THE NAME IN THE REGISTER OF PATENT AGENTS

[See section 130 (2) and rule 117(1)]

I _____
hereby apply for the restoration of my name in the register of patent agent which was removed on _____ under section 130 or rule 116.
My name was originally entered in the register on _____ under _____ _____ No. _____

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
For fee: See First Schedule

FORM 24

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

APPLICATION FOR REVIEW/SETTING ASIDE CONTROLLER'S DECISION/ORDER

[See sections 77 (l)(f) & 77 (l)(g) and rules 130(1) & 130(2)]

In the matter of (state the number of patent or patent application number and the relevant proceeding) _____
_____
_____
_____
I/We (Name, address and nationality of the applicant(s)) _____
_____
_____
_____
_____
being the applicant(s)/opponent/party in the above matter hereby apply for the review/ setting aside of the Controller's decision/order dated the _____ _____ in the above matter.
The grounds for making the application are set forth in the accompanying statement submitted in duplicate.

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant(s) or his authorized registered patent agent)

(_____)
(name of the natural person who has signed)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
For fee: See First Schedule

FORM 25

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

[19][***] REQUEST FOR PERMISSION FOR MAKING PATENT APPLICATION OUTSIDE INDIA

[See section 39 and rule 71 (1)]

I am /We are in possession of an invention for (State the title of the invention.)
_____
_____
I/We have made an application for the grant of a patent for the said invention, its number being No. _____ of dated _____
or
I/We hereby attach the brief description of the invention.
I/We intend to make application(s) alone/jointly with (Name and address of the person(s).)
_____
_____
_____
_____
for the same/substantially same invention for patent in the following country/countries/ convention countries, namely:-
_____
_____
_____
_____
I/We declare that the rights in the application(s) has/have been assigned to (Name and address of the Assignee)
_____
_____
_____
I/We request that I/We may be granted permission to make application(s) for the said invention in the said country/countries. The reasons for making this application, are as follows:-
_____
_____
_____
The facts and matters stated above are true to the best of my/our knowledge, information and belief.

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the applicant(s) or authorized patent agent)

To,
The Controller of Patents,
The Patent Office,
At _____

[20][*Note:*
(a) Strike out whichever is not applicable
(b) For fee: See First Schedule]

FORM 26

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

FORM FOR AUTHORISATION OF A PATENT AGENT/OR ANY PERSON IN A MATTER OR PROCEEDING UNDER THE ACT

[See sections 127 & 132 and rule 135]

I/We (Insert name, address and nationality) _____
_____
_____
_____
hereby authorise (Insert the name, address and nationality of the person(s) to be authorised.)
_____
_____
_____
_____
To act on my/our behalf in connection with (State the particular matter or proceeding for which the authorization is made)
_____
_____
_____
_____
and request that all notices, requisitions and communication relating thereto may be sent to such person at the above address unless otherwise specified.
I/We hereby revoke all previous authorisation, if any made, in respect of same matter or proceeding.
I/We hereby assent to the action already taken by the said person in the above-matter.

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by the person(s) making authorization)

(_____)
(Name of the natural person who has signed along with designation and official seal, if any)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
To be stamped under the Indian Stamp Act, 1899 (2 of 1899).

FORM 27

THE PATENTS ACT, 1970
(39 of 1970) &
THE PATENTS RULES, 2003

STATEMENT REGARDING THE WORKING OF THE PATENTED INVENTION ON COMMERCIAL SCALE IN INDIA
[See section 146 (2) and rule 131 (1)]

In the matter of Patent No._____ of _____I/We (Insert name, address and nationality) _____
_____
_____
_____
_____

The patentee(s) or licensee(s) under Patent No. _____ hereby furnish the following statement regarding the working of the patented invention referred to above on a commercial scale in India for the year (state the year to which the statement relates) _____

(i) The patented invention (Give whatever details are):
[ ] Worked [ ] Not worked [Tick (✓) mark in the relevant box]
(a) If not worked: reasons for not working and steps being taken for working of the invention.
(b) If worked, quantum and value (in Rupees), of the patented product:
(i) Manufactured in India
(ii) imported from other countries, (give country wise details)

(ii) the licences and sub-licences granted during the year;

(iii) state whether public requirement has been met partly / adequately / to the fullest extent at reasonable price.

The facts and matters stated above are true to the best of my / our knowledge, information and belief.

Dated this _____ day of _____ 20 _____

Signature_____
(to be signed by person(s) giving the statement)

To,
The Controller of Patents,
The Patent Office,
At _____

Note:
Strike out whichever is not applicable

[21][FORM 28

THE PATENTS ACT, 1970
(39 of 1970)
AND
THE PATENTS RULES, 2003

TO BE SUBMITTED BY A SMALL ENTITY / STARTUP
[See rules 2 (fa), 2(fb) and 7)

1	Insert name, address and nationality	I/We, _____ _____ Applicant/patentee in respect of the patent application no. _____ or patent no._____ hereby declare that I/we am/are a small entity in accordance with rule 2(fa) or a startup in accordance with rule 2 (fb) and submit the following documents(s) as proof.
2	Documents to be submitted	
	i. For claiming the status of a small entity:	
	A. For an Indian applicant: Evidence of registration under the Micro, Small and Medium Enterprises Act, 2006 (27 of 2006).	
	B. In case of a foreign: Any other document.	
	ii. For claiming the status of a startup	
	A. For an Indian applicant: any document as evidence of eligibility, as defined in rule 2(fb)	
	B. In case of a foreign entity: Any other document.	
3	To be signed by the applicant(s) / patentee (s) / authorized registered patent agent.	The information provided herein is correct to the best of my/our knowledge and belief.

4	Name of the natural person who has signed. Designation and official seal, if any, of the person who has signed.]	Dated this_____ day of _____20__ Signature _____ (Name) _____ (Designation)_____
		To The Controller of Patents, The Patent Office, At _____

[22][FORM 29

THE PATENTS ACT, 1970
(39 of 1970)
AND
THE PATENTS RULES, 2003

REQUEST FOR WITHDRAWAL OF THE APPLICATION FOR PATENT
[See Section 11B(4) and rules 7(4A), 26]

1. Name of the applicant
I/ We, _____request that the application for patent numbered_____ dated _____ Filed by me/us, if applicable, having he request for examination / request for expedited examination numbered_____ dated _____ be treated as withdrawn under rule 7(4A) / 26.
2. To be signed by the applicant or his authorized registered patent agent
_____
_____
3. Name of the natural person who has signed]
_____
_____

Dated_____ day of _____

Signature
(_____)

(Name) _____
(Designation)_____

To
The Controller of Patents
Patent Office at_____

[23][FORM 30

THE PATENTS ACT, 1970
(39 of 1970)
AND
THE PATENTS RULES, 2003

TO BE USED WHEN NO OTHER FORM IS PRESCRIBED
[See sub-rule (2) of Rule 8)

1. Name of the Applicant/ Patentee/Other _____ _____	I/We, _____			
2. Complete address including postal index number/code and State along with e-mail ID, telephone, mobile and fax number.	House No. Street	… …	Telephone No. Mobile No.	… …
	City State Country	… … …	Fax No.	…
	Pin code	…	E-mail ID	…
3. Application No./Patent No.				
4. Relevant section/rules				
5. Purpose of request				
6. Details of request				
7. To be signed by applicant	Signature_____			
8. Name of the person Who has signed along with designation and official seal, if any.]	(_____)			
	To The Controller of Patents, The Patent Office, At _____			

[24][THE THIRD SCHEDULE

FORM OF PATENT

[See rule 74]

GOVERNMENT OF INDIA
THE PATENT OFFICE

Patent No _____
Application No _____
Date of filing _____
Patentee _____
Inventor(s) (Where applicable) _____
It is hereby certified that a patent has been granted to the patentee for an invention entitled _____ as disclosed in the above mentioned application for the term of 20 years from the _____ day of _____ 19/20 _____, in accordance with the provisions of the Patents Act, 1970.

Date of Grant _____ Controller of Patents

(Seal of the Office)

Note: The fees for renewal of this patent, if it is to be maintained, will fall due on _____ day of _____ 20 _____ and on the same day in every year thereafter.]

[25][THE FOURTH SCHEDULE

[See proviso to rule 136 (1)]

No. of entry	Matter in respect of which cost is to be awarded	Amount of fees (in rupees)		
		For natural person(s)	For other than natural person(s) either alone or jointly with natural person(s)	
			For small entity	For other except small entity
1.	For notice of opposition; under sections 25, 57, 60, 63, 78, 87(2) or 88(4).	2400	6000	12000
2.	For application for compulsory licence: under sections 84(1), 91(1) or 92(1).	1500	3000	6000
3.	For application for revision of terms and conditions of licence under section 88(4).	2400	6000	12000
4.	For notice of intention to attend the hearing under rule 62(2).	1500	3000	6000
5.	Stamp fee for power of attorney, where a patent agent or other person has been appointed or stamp fee in respect of relevant affidavits.	The amount actually paid	The amount actually paid	The amount actually paid
6.	For written statement under rule 57 or reply statement under rule 58 or for each affidavit, if relevant.	4000	4000	5000
7.	For each document or publication produced in the proceedings, if relevant.	1600	1600	2000
8.	For each unnecessary or irrelevant affidavit or citation.	1600	1600	2000
9.	For every day or part day of hearing before the Controller.]	4000	4000	5000]

[26][THE FIFTH SCHEDULE

[Refer rules 19(2), 19A(1)(b), 19B(5), 19B(12), 19H, 19K(5)]

Sl. No.	On what payable (Relevant provision of Patents Rules, 2003, if any)	Relevant Rule of regulations under the Treaty	For Natural Person	Other than Natural Person either alone or jointly with Natural Person
			(In Rupees)	(In Rupees)
1.	Search fee	Rule 16.1(a)	2,500	10,000
2.	Additional fee under rule 19B(5)	Rule 40.2	2,500	10,000
3.	Protest fee under rules 19B(5) and 19J(5)	Rules 40.2(e) and 68.3(e)	1,000	4,000
4.	Preliminary examination fee	Rule 58.1	3,000	12,000
5.	Additional fee under rule 19J(5)	Rule 68.3	3,000	12,000
6.	Preliminary examination fee, if the International Search Report was prepared by the Indian International Searching Authority		2,500	10,000
7.	Additional fee under rule 19J(5), if the international Search Report was prepared by the Indian International Searching Authority		2,500	10,000
8.	Handling fee to be paid to the IB	Rule 57	As specified in the Schedule of fee annexed to the regulations made under the Treaty	
9.	For every day or part day of hearing before the Controller.]	Rule 13ter.1(C), 13ter.2, 12.3(e), 12.4(e)	1,000	4,000
10.	Late payment fee	Rule 58bis.2, 16bis.2	In accordance with the regulations made under the Treaty	
11.	Copy of Results of Earlier Search and of Earlier Application	12bis.1(c)	1,000	4000]

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Cross References

Acts and the corresponding rules are cross-referenced

Color Coded

Bi-coloured print for easy identification

Wider Margin

For capturing notes

The dull boring Bare Act reinvented